

No. 3786

In the United States Circuit
Court of Appeals

FOR THE NINTH CIRCUIT

JOHN E. GILCHRIST,
Appellant.

vs.

F. B. MALLORY COMPANY,
Appellee.

On Patent 977,613
Dated December 6, 1910
for Logging Block

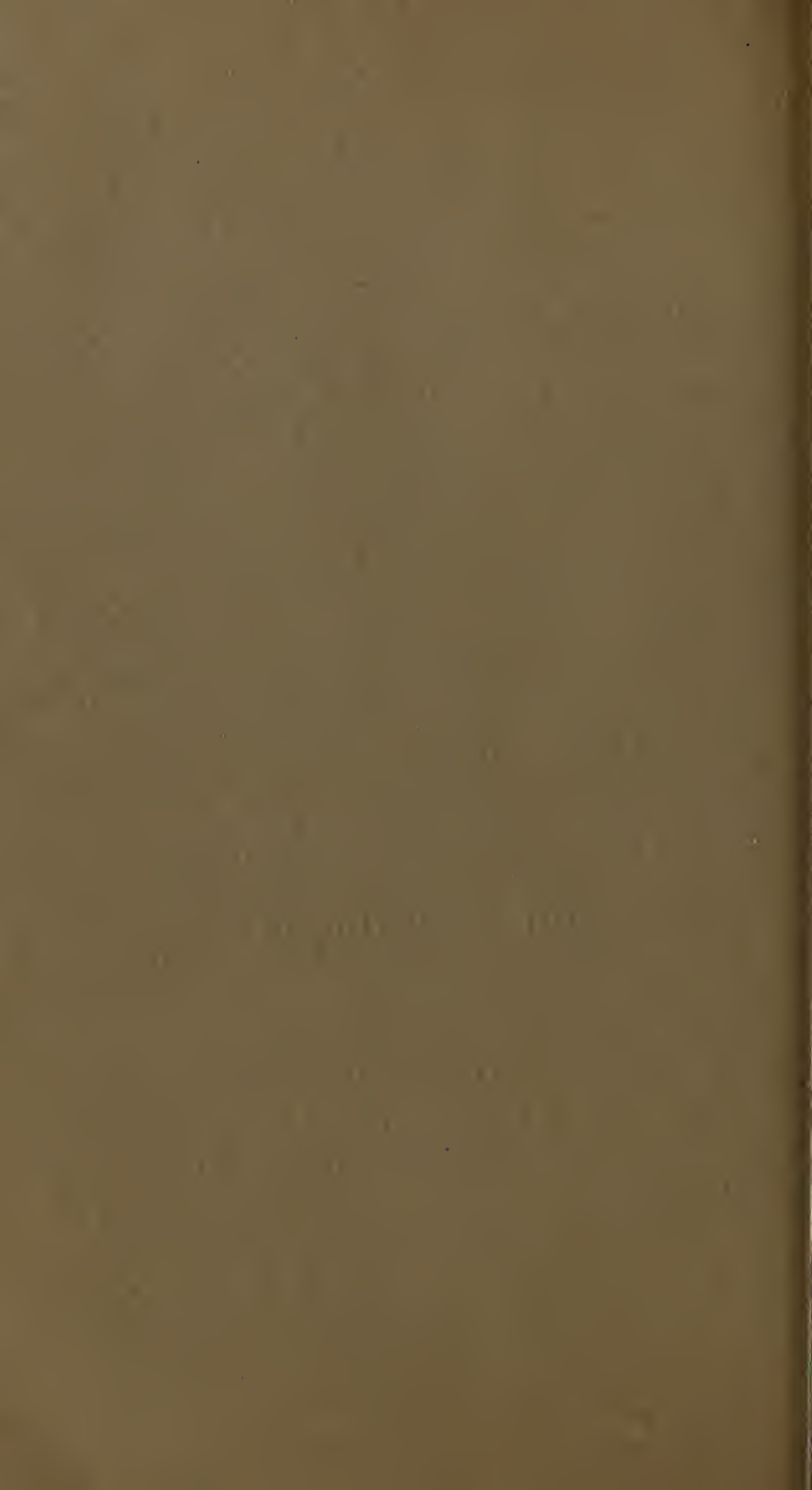
BRIEF FOR APPELLEE

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EXPLANATORY NOTE

Realizing that the Court will be familiar with many of the cases and legal propositions which go to make up this brief, I have felt it advisable to classify the cases under appropriate headings and make an index thereto so that the Court may readily turn to the authorities on any given subject. I have also arranged an alphabetical index showing where each of the cases cited or referred to may be found in this brief.

In the use of my own citations I have endeavored to select such quotations from the cases as will in themselves convey a fair statement of the facts upon which the rule of law is based. Where this could not conveniently be arranged I have given a short statement of the facts so that the value of the citation may be more readily determined.

I have also arranged an alphabetical index which will enable the Court to turn at will to the comments which I have made concerning any particular case cited by appellant.

Italics throughout this brief are mine and are used for the purpose of emphasis.

GENERAL INDEX

	Page
Analysis of Claims in Issue.....	8
Argument	193
Defendants Theory of the Case.....	15
Examination and Review of Appellant's Citations..	119
Morgan and Gilchrist Blocks Compared.....	207
Points and Authorities	23
Statement of Facts	1

TOPICAL INDEX TO POINTS AND AUTHORITIES

Adapting Machine to New Use.....	78
Aggregation is Not Invention.....	40
All of the Elements Need Not be Found in a Single Article	53
Borrowing Elements From Another Art.....	60
Claims Cannot Be Enlarged by Specifications....	24
Claims Measure the Invention	23
Combined Results May Be Aggregation.....	41
Dedication to and Rights of Public.....	108
Courts Should Protect Public Against Patent Monopoly	29
Each Claim is an Independent Patent.....	27
Each Element Considered Essential.....	28
Equivalency of Devices.....	81

Estoppel by Laches.....	116
Invention and Novelty are Questions of Fact....	23
Inventive Quality Would Not Save Gilchrist Patent	107
New Unitary Result	72
Not a New Machine.....	84
One Alleged New Element Would Not Save Complainant's Patent	61
One Integral Casting Forming Side and Oil Chamber	62
Patents Solve No Problem and Do Not Involve Invention	71
Presumption is a Mere Rule of Evidence and Cannot Usurp the Judgment of the Court.....	33
Presumption Destroyed by File Wrapper.....	31
Presumption of Validity.....	30
Prior Art Defined	104
Scope of Invention	113
Selected Elements	52
Superiority and Commercial Success do Not Prove Invention	36
That Which Would Infringe if Later, Anticipates if Earlier	80
Utility and Commercial Success.....	34
What Is a New Result.....	6.5, 6.6. 92

INDEX TO APPELLEE'S CASES

	Brief Page
Adams v. Bellarie Stamping Co.....	54
American Bell Tel. Co. v. National Tel. Mfg. Co. (C. C.).....	30
American Soda Fountain Co. v. Sample.....	32
Atlantic Works v. Brady.....	19
Australian Knitting Co. v. Gormly.....	66
Barb Wife Fence Patent, The.....	102
Bates v. Coe.....	61, 102
Battin v. Taggert.....	23
Blake v. Sperry	86
Boss Mfg. Co. v. Thomas.....	34
Boyer v. Roth, et al.....	50, 55
Brooks, v. Fiske.....	24
Brooks v. Jenkins	86
Bussey v. Excelsior Mfg. Co.....	49
Campbell v. Mangle	43
Carlton v. Bokee.....	29
Caster Co. v. Caster Co.....	74
Consolidated Elec. Mfg. Co. v. Holtzer.....	68, 70
Consolidated Bunging Apparatus Co. v. Metro- politan Brewing Co.	90
Continental Paper Bag Co. v. Easton P. B. Co...	23
Corn Planter Patent, The.....	27
Cutler Mail Chute Co. v. American Mailing Device Corporation	62
Dilg. et al, v. Borgfeldt & Co.....	78

Dodge Mfg. Co. v. Collins, et al.....	44, 103
Duer v. Corbin Cabinet Lock Co.....	35, 55, 107
Eames v. Worcester Institute.....	74
Edison v. Am. Mutoscope Co.....	91
Edwards v. Dayton Mfg. Co.....	37, 83
Elliott & Co. v. Youngstown Car Mfg. Co.....	32
Excelsior Needle Co. v. Morse-Keefer Cycle- Supply Co.	91
Evans v. Eaton	86, 90, 115
Farrill v. Railroad Co.....	23
Fay v. Cordesman	28
Ft. Pitt Supply Co. v. Ireland & Matthews Mfg. Co.	75
Fulton Co. v. Powers Regulator Co.....	25
Gallagher v. Cadwell	116
General Electric Co. v. Yost Mfg. Co.....	68, 70
Gordon v. Warder	80
Gould v. Cincinnati Shaper Co.....	74
Grant v. Walter	24, 80
Griest Mfg. Co. v. Parsons.....	44, 45, 104
Grinnell Washing Machine Co. v. Johnson.....	185
Hailes v. Van Wormer.....	41, 45, 54, 102
Heating Co. v. Burtis.....	80
Herman v. Youngstown Car Mfg. Co.....	74
Herzog v. Chas. Keller Co.....	62, 70
Hobbs v. Beach.....	61, 102
Hollister v. Benedict & Burnham Mfg Co.....	37
Hovey v. Stephens.....	86

Howard v. Detroit Stove Wks.....	68, 70, 86
Huebner Toledo Breweries Co. v. Matthew Gravity Carrier Co.	35, 37, 57
Idorne v. Winkle	91
Imperial Cap & Mach. Co. v. Crown Cork & Seal Co.	115
Jackson Skirt & Novelty Co. v. Rosenbaum....	75, 77
Jacobs Mfg. Co. v. T. R. Almond Mfg. Co.....	88
Keene v. New Idea Spreader Co.....	23, 34, 57, 74
Keystone Bridge Co. v. Iron Co.....	23
Knapp et al v. Morss.....	78, 80, 105
Lawson v. Metal Products Co.....	68, 70
Leeds & Catlin v. Victor Talking Machine Co....	27
Le Fever v. Remington.....	28
Loom Co. v. Higgins.....	77, 102
Lowell v. Lewis	86
Magowan v. N. Y. Belting & Packing Co.....	38
Massetth v. Larkin	28
McCarthy et al v. Lehigh Valley R. R. Co.....	28, 90
McClain v. Ortmyer	24, 37, 109, 115
Merrell v. Yeomans.....	24
Miller v. Brass Co.	27
Miner v. T. H. Simington Co.....	62
Mosler & Co., A. R. v. Lurie.....	117
National Hat Pouncing Machine Co. v. Heddon et al	35
National Hollow Brake-Beam v. Interchangeable Brake Beam	102

National Machine Corp. v. Benthall Mach. Co.	103, 115
Office Specialty Mfg. Co. v. Metallic Mfg. Co.	51
Olin v. Timpkin	65
Palmer v. Village of Corning	100
Parks v. Booth	61
Pappenhusen v. Fakke	23
Peters v. Mfg. Co.	80
Pickering v. McCullough	40, 54, 55, 102
Potts v. Creager	61
Railroad Co. v. Mellon	28
Railroad Supply Co. v. Elyria Iron Supply Co.	184
Reckendorfer v. Faber	47, 102
Republic Rubber Co. v. G. & J. Tire Co.	34
Riley v. Morse	24
Risdon Locomotive Works v. Medart	40
Robinson on Patents	21, 29, 85, 91
Robinson v. Tubular Woven Fabric Co.	30, 104
Royer v. Schultz Belting Co.	28
Russell v. Place	29
Ryan v. Hard	59
Scaife, Wm. B. & Sons, v. Falls City Woolen Mills Co.	31, 33
Seymour v. Osbourne	102
Sieber & Trussel Mfg. Co. v. Chicago Binder & File Co.	61
Smith v. Nichols	39, 84
Std. Caster Co. v. Caster Socket Co.	66, 68
Standard Tobacco Stemming Co. v. Tobacco Stemming Machine Co.	72

Stanley, etc. Co. v. Davis.....	86
Strauss v. Blumenthal	66
Streeter v. Davis	23
Sullivan v. Redfield	86
Tate Mfg. Co. v. Baltimore & Ohio R. R. Co.....	115
Thatcher Heating Co. v. Burtis.....	93, 102
Turner v. Lauter Piano Co.....	52
Union Edge Setter Co. v. Keath.....	36, 53
Union Paper Bag Mach. Co. v. Murphy.....	81, 85
U. S. Nickel Co. v. Calif. Electrical Works.....	27
Vacuum Cleaner Co. v. Innovation Elec. Co., Inc..	117
U. S. Repair Guaranty Co. v. Assyrian Asphalt Co.	90
Walker on Patents	19, 21, 25, 28, 40, 69, 91
Warren Co., J. J. v. Rosenblatt.....	33
Watson v. Stevens	64
West Coast Safety Faucet Co. v. Jackson Brew- ing Co.	53
Westinghouse Elec. Mfg. Co. v. Toledo P. C. & L. Ry.	32
Wheeler v. James	89
White v. Dunbar.....	90, 114, 115
Wright v. Yuengling	28, 93, 110
Yale Lock Co. v. Greenleaf.....	24
Zimmerman v. Advance Machinery Co.....	74

INDEX TO REVIEW OF APPELLANT'S CASES

	Brief Page
Auto Vacuum Freezer Co. v. Sexton Co.....	123
American v. Fiber	145
Atlantic Works v. Brady.....	119
Badische Anilin & Soda Fabrik v. Kalle & Co....	171
Barb Wire Patent	178
Beattie Mfg. Co. v. Smith.....	127
Burdett-Rowntree Mfg. Co. v. Standard Plunger Elevator Co.	130, 142
Carnegie Steel Co. v. Cambria Iron Co.....	177
Clark Thread Co. v. Willimantic Co.....	147
Clough v. Barker	181
Columbia Graphophone Co. v. Searchlight Horn Co.	124
Columbia Wire Rope Co. v. Kokomo.....	187
Cimotti v. American	167
Cohn v. U. S. Corset Co.....	177
Covert v. Covert.....	121
Diamond Patent Co. v. S. E. Carr Co.....	157
Diamond Rubber Co. v. Consolidated Tire Co....	190
Expanded Metal Co. v. Bradford.....	189
Gas Mach. Co. v. United Gas Co.....	142
General Electric Co. v. Wagner Electric Mfg. Co.	146
General Manifold & Printing Co. v. Simple Ac- count Sales Book Co.....	137
General Electric Co. v. Alice Chalmers.....	147

Gordon v. Warder	146
Gormully & Mfg. Co. v. Stanley Cycle Mfg. Co....	160
Goss Printing Press Co. v. Scott.....	121
Griswald v. Harker.....	159
Homer Brooke Glass Co. v. Hartford Co.....	123
Imhaeuser v. Buerk	158
International Mosleum Co. v. Seivert.....	131
International Telephone Mfg. Co. v. Kellogg.....	165
Irwin v. Hasselman	150
Johnson v. Railway Co.....	162
John Kitchen Jr. v. Levison.....	173
Keystone Mfg. Co. v. Adams.....	149, 188
Klein v. Russel	187
Krementz v. Cottle	167
Kryptok v. Stead Lens Co.....	169
Leed & Catlin Co. v. Victor Talking Mach. Co....	159
Lenle v. Dobson-Evand Co.....	135
Loom v. Higgins	169
Los Alamitos Sugar Co. v. Carroll.....	161
Lucas v. Miller.....	121
Loew Filter Co. v. German-American Filter Co....	172
McLean v. Fleming	125
Mendez v. Holt	126
Mfg. Co. v. Rathbone.....	120
Morton v. Llewellyn	148
National Hollow Brake Beam Co. v. Inter- changeable Brake Beam Co.....	151

National Cash Register Co. v. American Cash Register Co.	131, 188
National Mach. Corporation v. Benthall Mach. Co.	156
N. Y. Scaffolding Co. v. Whitney.....	140
Omher Fair Register Co. v. Omher et al..	132, 137, 138
Pelton v. Doble.....	128
Pickering v. McCullough.....	132
Railroad Supply Co. v. Hart Steel Co.....	139
Rajah Auto Supply Co. v. Belvidere Screw & Mach. Co.	125
Rubber Co. v. Goodyear.....	121
Seymour v. Osborne	176
Stebler v. Riverside Heights Orange Growers Ass.	160
Topliff v. Topliff	186
Underwood Typewriter Co. v. Elliott Fisher Co...	171
U. S. Fastener Co. v. Bradley.....	172
Van Dorn Iron Works Co. v. Matthews Bros. Co.	128
Victor Talking Machine Co. v. Cheney Talking Mach. Co.	124
Waterbury Buckle Co. v. Aston.....	168
Western Electric Co. v. Home Telephone Co.....	178
Willard v. Union Tool Co.....	127
Yestera v. Hardesty Mfg. Co.....	160

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BRIEF FOR APPELLEE

STATEMENT OF FACTS

This suit was based upon the alleged infringement of United States Letters Patent No. 977,613 issued to John E. Gilchrist December 6, 1910, and United States Letters Patent No. 1,063,528 issued to the same party on June 3, 1913, but as appellant has abandoned his appeal as to Patent No. 1,063,528, this brief will be confined to matters pertaining to said United States Letters Patent No. 977,613.

In the complaint originally filed it was alleged that claims 4 and 5 of this patent had been infringed, but by amendment just prior to trial the complaint included Claim 1.

The defendant set up most of the usual defenses which may be made in a suit of this kind, but a short classification of the defenses as considered in this brief is as follows:

1: Claims 1, 4 and 5 are invalid for lack of invention and want of patentable novelty.

2: Claims 4 and 5 respectively define mere unpatentable aggregations of elements, which defendant does not use and, therefore, does not infringe.

3: Estoppel.

The testimony and exhibits show that between the years 1902 and 1907 there came into general use in the Pacific Northwest, logging blocks having oil reservoirs in the form of elbows, elbow extension reservoirs and grease cup reservoirs. Each of these types of reservoirs communicated with an axial opening in the pin, which axial opening extended through the side wall of the pin. Said pins were terminally mounted in the sides of the blocks. Many of them were long bearing pins provided with shoulders and having ends threaded to engage the sides of the blocks in recessed portions thereof. These blocks were provided with sheaves journaled for rotation upon the pins and the sheaves of many of these blocks were provided with oppositely disposed bosses adapted to fit closely, but

anti-frictionally in the recesses of the sides. Most of the pulley blocks were provided with a top removably connecting the sides, said sides having lateral projections at their upper ends to which the top was adapted to fit and was attached by removable pins passing through the projections and lugs on the top and sides of the blocks.

The defendant's own catalog issued in 1907, and being defendant's Exhibit B, illustrated several of these pulley blocks. In the advertisement of many of these pulley blocks particular stress was laid upon the feature of its being a self-lubricating block, a long bearing block or a dirt proof block. In fact, most of these pulley blocks embodied all of the elements contained in Claims 1, 4 and 5 of the Gilchrist Patent No. 977,613, excepting that the oil reservoir was not integral with the side of the block. (R. 56 to 64; 'Trans. Mallory's Test., pp. 58 to 84; R. 87 to 89; 'Trans. Borquist's Test., pp. 130 to 134; R. 89 to 91 and 137; Geary's Test., pp. 137 to 142 and 287; R. 133 to 136; 'Taylor's Test., pp. 277 to 284; and R. 217; Younie's Test., pp. 482 to 483.)

The blocks made by Columbia Steel Works, also the Exhibits I, L, N and GG, and explained on pages 68 and 69 of the testimony (R. 59 to 63), embody these particular elements and features; and among a multitude of patents the following list will be sufficient for the purposes of this brief:

U. S. Patent	Defendant's Exhibit
520,973	E. M. Tousley, June 5, 1894.....RR
644,729	W. W. Bouse, March 6, 1900.....TT

699,518	E. B. Hammond, May 6, 1902....	UU
760,378	A. N. and C. B. Borquist.....	HH
765,475	J.E.Gilchrist (Pltff.), July 19, '04	WW
779,437	G. Nettle, January 10, 1905.....	YY
786,790	G. W. King et al, April 4, 1906...	3-A
806,562	A. Opsal, Dec. 5, 1905.....	3-B
847,955	J. N. Lindsay, March 19, 1907....	3-F
869,422	W. H. Corbett, Oct. 29, 1907.....	3-G
876,176	B. W. Hammond, January 7, 1908.	3-H
880,805	J. Mattson, March 3, 1908.....	3-I
942,274	E. Martin, Dec. 7, 1909.....	3-K

During the trial of the case it was admitted by complainant's expert that each of the elements found in Claims 1, 4 and 5 of complainant's patent were found in the exhibits and patents of the prior art introduced by defendant, except that it was sought to distinguish the oil reservoir of the Gilchrist block from that shown in the pulley blocks and publications of the prior art. (R. 217—pp. 482, 483 of transcript of testimony.) The controversy between witnesses and attorneys as to Patent No. 977,613 finally narrowed down to the single issue as to whether or not Gilchrist had displayed invention in providing the particular oil chamber or reservoir which he used. (R. 90—p. 139 of transcript of testimony.) However, a careful examination of the testimony and the exhibits discloses the fact that complainant's contention concerning the oil reservoir is based upon the complainant's blocks as actually manufactured rather than upon the claims as set forth in his patent.

For the purpose of meeting complainant's contention concerning the Gilchrist oil reservoir the defendant contended that the claims alone should be considered and that the claims themselves were so drawn as to be fully anticipated by earlier patents, among which were the following:

British Patents	Defendant's Exhibit
712 Morgan, Jan. 12, 1893.....	3-O
5,657 J. C. W. Kjelgard, March 13, 1896...	3-P
4,127 T. R. Dyne, Feb. 26, 1901.....	3-Q
U. S. Patent	Defendant's Exhibit
349,691 Butters, Sept. 28, 1886.....	4-C
513,067 Labadie, Jan. 16, 1894.....	QQ
780,280 H. Gilley, Jan. 17, 1906.....	ZZ
844,159 E. Ludford, Feb. 12, 1907.....	3-D

The defendant was the first one to push the skyline system of logging in the Pacific Northwest, and it was in connection with his efforts to establish the skyline system of logging that he developed his own line of large reservoir auto-lubricating blocks, containing a reservoir in each side of the block. His first skyline high lead block with auto-lubricating sides was made in the month of March, 1914, being about two years prior to the time that Gilchrist designed blocks for this purpose. (R. 231—pp. 511, 530 transcript of testimony.)

The design of this block was worked out by Mr. Mallory and Mr. Hirschbuhl during the month of September or October, 1913. (R. 95 to 98—p. 120, transcript of testimony.) Mr. Hirschbuhl, who took charge

of the mechanical part of designing this block, testified that it was the result of suggestions on his part and Mr. Mallory's part; that Mr. Mallory had requested that a block with oil reservoir sides be made up, and they figured out the design of the block without having any other block before them. Mr. Hirschbuhl further testified that he had no drawings and had never seen the Gilchrist self-oiling block before designing the Mallory block. (R. 79 to 81 and 92—pp. 106, 144, 145, 148, 149, 150 and 151, transcript of testimony.)

Shortly after Mallory put his auto-lubricating skyline high lead blocks upon the market, he heard indirectly that Gilchrist had indicated that they were an infringement of his patent and that he intended to allow Mallory to make enough of these blocks to make it worth while, and then sue him for infringement. Upon hearing this, the defendant immediately had a search made in Washington to determine whether or not his line of blocks was infringing any other line of blocks, and wrote to the complainant herein telling what he had heard and the opinion which he had received from his attorneys at Washington, D. C., and from his attorney in Portland, Oregon. After some correspondence on the subject it was indicated by complainant that the matter would have to rest until such time as he could be in Portland and take the matter up with the defendant. Complainant was thereafter furnished with certain reference patents, and no more was heard from him concerning infringement until just a short time prior to the bringing of this suit. (R. 54 and 65 to 70; Trans. of Test., pp. 73 to 80, 99 to 101 and 120.)

After this correspondence had passed between complainant and defendant, complainant placed upon the open market and displayed in his catalogs, blocks embodying the combination claimed in his patent No. 977,613, without marking thereon the patent date of December 6, 1910, but using only the patent date of his guard patent. (See transcript of testimony, pages 81 to 87, and defendant's Exhibits T. and U.) (R. 70 to 72.)

The defendant has never made a line of blocks in which the hub of the sheave was adapted to fit closely in annular recesses of the sides, and never made any attempt whatever to provide what is known as a dust-proof hub.

The file wrapper and contents of Gilchrist patent No. 977,613 show that this patent was granted just as originally applied for, and do not show that the examiner had considered a single patent of the prior art.

ANALYSIS OF CLAIMS IN ISSUE

For the convenience of the court, each of the claims in issue is hereinafter set forth in full and then analyzed by subdividing the same into the various elements which go to make up the combination of the claim. All of these elements have been numbered so that they may be referred to in the brief by number, and the reference numerals used in the drawings and specifications, which designate the particular elements, have been placed after the respective elements so that the court may readily identify each element in the patent drawings.

CLAIM NO. 1, PATENT NO. 977,613:

A pulley block consisting of sides, one of which is provided with an interior oil chamber having an inlet adjacent the top of the block; a bearing pin terminally mounted in the sides and having an axial opening communicating with the chamber and extended through the side wall of the pin; and a sheave journaled for rotation upon the pin between the sides.

Analysis of Claim No. 1:

Elements:

1. Sides (Ref. Nos. 1 & 2)
2. An interior oil chamber in one of the sides. (Ref. No. 4)
 - (a) An inlet to said chamber adjacent the top of the block. (Ref. No. 5)

3. A bearing pin. (Ref. No. 24)
 - (a) terminally mounted in the sides. (Ref. Nos. 18 & 19)
 - (b) and having an axial opening communicating with the chamber (2), (Ref. No. 27)
 - (c) and extending through the side wall of the pin. (Ref. No. 28)
4. A sheave journaled for rotation upon the pin between the sides. (Ref. No. 20)

CLAIM NO. 4, PATENT NO. 977,613:

A pulley block consisting of parallel sides having annular recesses in their adjacent faces, one of the sides being provided with an interior oil chamber having an inlet adjacent the top of the block; a bearing pin terminally threaded to engage the sides in the recessed portions thereof, the pin having an axial opening communicating with the chamber and extended through the side wall of the pin; a sheave journaled for rotation upon the pin and having oppositely disposed bosses adapted to fit closely but anti-frictionally in the recesses, the pin having shoulders to engage the sides to prevent the same from binding upon the sheave; and a top removably connecting the sides above the sheave.

Analysis of Claim No. 4:

Elements:

1. Parallel sides (Ref. Nos. 1 & 2)
 - (a) having annular recesses in their adjacent faces. (Ref. No. 17)

2. An interior oil chamber, provided in one side.
(Ref. No. 4)
 - (a) having an inlet adjacent to the top of the block.
(Ref. No. 5)
3. A bearing pin.
(Ref. No. 24)
 - (a) terminally threaded to engage the sides in the recessed portions thereof.
(Ref. Nos. 18 & 19)
 - (b) the pin having an axial opening communicating with the chamber.
(Ref. No. 27)
 - (c) and extended through the side wall of the pin.
(Ref. No. 28)
4. A sheave journaled for rotation upon the pin.
(Ref. No. 20)
5. Oppositely disposed bosses upon the sheave adapted to fit closely, but anti-frictionally in the recesses (1a).
(Ref. No. 21)
6. The pin having shoulders to engage the sides
(1) to prevent the same from binding upon the sheave.
(Ref. No. 26)
7. A top removably connecting the sides above the sheave.
(Ref. No. 8)

CLAIM NO. 5, PATENT NO. 977,613:

A pulley block consisting of parallel sides, one of which is provided with an interior oil chamber having an inlet adjacent the top of the block; there being a threaded opening in the wall of said side

communicating with the chamber adjacent the bottom thereof, and an oppositely disposed threaded opening in the other of said sides; a bearing pin terminally threaded to engage the threaded openings, the pin having an axial opening communicating with the chamber and extended through the side wall of the pin; a sheave journaled for rotation upon the pin; the sides having lateral projections at their upper ends; a top having spaced lugs between which the projections of the sides are adapted to fit; and removable means for uniting the projections with the lugs.

Analysis of Claim No. 5:

Elements:

1. Parallel sides. (Ref. Nos. 1 & 2)
2. An interior oil chamber in one of said sides. (Ref. No. 4)
 - (a) having an inlet adjacent to the top of the block. (Ref. No. 5)
3. A threaded opening in the wall of said side. (Ref. No. 18)
 - (a) communicating with the chamber (4) adjacent the bottom thereof.
4. An oppositely disposed threaded opening in the other of said sides. (Ref. No. 19)
5. A bearing pin. (Ref. No. 24)
 - (a) terminally threaded (25) to engage the threaded openings. Ref. Nos. 18 & 19)
 - (b) the pin having an axial opening communicating with the chamber. (Ref. No. 27)

- (c) and extended through the side wall of the pin. (Ref. No. 20)
- 6. A sheave journaled for rotation upon the pin. (Ref. No. 20)
- 7. Lateral projections upon the sides at their upper ends. (Ref. No. 6)
- 8. A top. (Ref. No. 8).
 - (a) having spaced lugs between which the projections (7) are adapted to fit. (Ref. No. 7)
- 9. Removable means for uniting the projections with the lugs. (Ref. No. 22)

By examination of the foregoing claims as analyzed, it will be observed that some of the elements are subdivided into subordinate or qualifying elements which limit and restrict the elements so qualified, and thereby prevent the claims from the broad construction or interpretation to which they would be entitled if not so limited.

For example, the element "2" of Claim 1, Patent No. 977,613, does not cover broadly an oil chamber in one of the sides, but restricts it to a chamber having an inlet adjacent to the top of the block. Likewise, with element "3" of said claim, a bearing pin in its broad sense was confessedly old, and each of the qualifying elements "3-a", "3-b" and "3-c" must be considered as an essential element of the combination, the elimination of which would avoid an infringement of the combination claim.

By comparison of the claims as so analyzed and by the process of elimination of like elements in the various claims, one can readily see what there may be in one claim to distinguish it from the others. By a like comparison and application of the claims as analyzed to the devices which are found in the prior art, one can also readily ascertain whether or not there is anything in the claims which is not found in the prior art, and determine whether or not any of the elements function in any different manner than what is shown by the prior art, or whether the combinations disclose any new mode of operation.

For example, in comparing Claims 1 and 4 of Patent No. 977,613, we find Claim 4 to be almost a repetition of Claim 1, disclosing the same mode of operation, and distinguished or differentiated from Claim 1 only by further restricting the same and narrowing the construction thereof by adding the qualifying elements "1-a", "5", "6", and "7". Upon further consideration of these elements it will appear that element "6" of Claim 4 defines only an additional and wholly unnecessary specific limitation of element "3" of the claim. Element "7" of Claim 4 is only a positive enumeration (with a limitation) of means of suspension—"a top"—which, being essential to every form of "pulley block" is no less included in Claim 1 by necessary implication than it is by positive language in Claim 4.

It follows then that the only material differentiation between the subject matter defined in Claim 1 and that defined in Claim 4 is set forth in element "1-a", to-wit: "Annular recesses" in the adjacent faces

of the block sides, together with the complimentary element "5", to-wit: "Oppositely disposed bosses upon the sheave adapted to fit closely, but anti-frictionally in the recesses '1-a'".

Having then arrived at the conclusion that the only question left to be decided in Claim 4 after disposition of Claim 1 is whether the addition of the annular recesses in the faces of adjacent block sides and oppositely disposed bosses upon the sheave to fit closely but anti-frictionally in the recesses, is patentable independently of Claim 1. We can then look to the prior art for the determination of this question, and also to defendant's device to determine whether or not he infringes the same.

By a similar method of comparison and elimination the court may with exactitude, directness and certainty, arrive at the very issues to be decided.

On pages 111 and 112 of this brief will be found seven additional claims, lettered from "A" to "G," which have been drawn for the purpose of showing what a narrow construction would necessarily have to be placed upon the claims, even if no consideration whatever were to be given to the prior state of the art.

The claims so drawn are considered in connection with the subject "Dedication to and Rights of the Public," beginning at page 108 of this brief. It is felt that by becoming familiar with the claims in issue as analyzed, by realizing the numerous other claims that could have been drawn, and keeping in mind the prior state of the art, there will be less trouble in making the application of the law as set forth in the cases cited.

DEFENDANT'S THEORY OF THE CASE.

Before examining in detail the cases and authorities, and before taking up the general argument of the case, it is deemed advisable to give a brief statement of the defendant's theory of the case.

While the patent sued upon indicates that the patentee claims to be the inventor of a new and useful machine, termed a "pulley block," it is the contention of the defendant, that in view of the prior art that complainant's patent does not describe a machine having any new mode of operation.

The court will take judicial knowledge of the fact that the primary elements of the simple machine termed a "pulley block" in their essential combinations are old in the prior art.

It has been verified by the exhibits and by the testimony of both complainants and defendants' witnesses that each of the elements of the various combinations can be found in the prior art performing the same function as it performs in the device described in complainant's patent. For example, complainant does not contend that there is any different law of operation or mode of operation in the lubricating device as disclosed in Patent No. 977,613, from that which is found in the British patent to Morgan, defendant's Exhibit BB; but it is contended by complainant that the oil reservoir provided in a one-piece casting which forms one of the sides is a distinctive and better reservoir than the one disclosed in the Morgan patent.

If it should be conceded that complainant is correct in this assumption, the Gilchrist device would merely be an improvement of the Morgan device and would not constitute a new or distinctive machine by reason of the fact that there would be no change in the mode of operation.

For example, it is perfectly apparent upon the face of Claim 1 that the patentee is seeking to protect the given means of lubricating a pulley block. There is nothing else in this claim concerning which the court will not take judicial knowledge of the fact that it was old in the prior art. It is apparent that the primary purpose of the oil reservoir in both the Gilchrist device and the Morgan device is to contain a given quantity of lubricant. It is also apparent that the oil is fed from this reservoir, through the axial opening of the pin and extension of this opening to the side of the pin, upon the bearing surfaces by the law of gravity, and capillary attraction from rotation of the sheave, exactly the same in each of these devices. This being true, the Gilchrist device could not be a new machine, but merely an improved machine or pulley block; and it remains only to determine whether or not, in view of the prior art, any improvement is disclosed, and if disclosed, whether or not that improvement amounts to invention.

It is the contention of defendant that a different rule is applicable to determine what is invention when it involves the improvement of a machine from that which determines invention in a new machine or in an article of manufacture. For example, a new ma-

chine may be the result of invention where it embodies a new mode of operation. An article of manufacture may be the subject of invention when it discloses a superiority in the article itself or in the cheapness of its manufacture which is the result of something more than ordinary mechanical skill. But an improvement in a machine by the improvement of one or more of its elements without changing its mode of operation cannot amount to invention, if the particular element as so improved can be found in the prior art, or if the elements added to the combination can be found in the prior art performing the same function; and if the change or modification in any one of the elements of the combination discloses nothing more than what would amount to mechanical skill on the part of a mechanic skilled in the art and having before him all similar devices and like elements of the prior art, the same would not amount to invention.

It makes no difference how much superior the improved machine may be to any found in the prior art, nor what may have been its commercial success. If it does not pass the test of invention as above outlined it cannot furnish the basis for a valid patent. It is the contention of defendant that neither of the patents sued upon passes the test for invention, but even if it should be considered that the claims described patentable combinations the narrow construction which would need to be placed upon them would relieve the defendant from the charge of infringement.

In substantiation of the foregoing theory, there will now be given a few legal references before taking up in detail the points and authorities and the general argument of the case.

It should be continually borne in mind that the mere fact that a device is new, or that there is a new arrangement of elements, does not necessarily mean that there is invention, and that it is only the *inventor* who is referred to in various statutes and cases as being entitled to protection. United States patents are granted under power conferred by the Constitution upon Congress, "to promote the progress of science and the useful arts," and Congress has no power to grant a patent to any one but an inventor.

U. S. Constitution, Art. 1, Sec. 8, Clause 8.

By act of Congress, a patent may be obtained under the conditions named in the act, by "any person who has *invented or discovered* any *new* and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof,"

R. S. Sec. 4886.

The act further prescribes, as will be subsequently emphasized, that every patentee shall file a description of his invention or discovery, "and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

R. S. Sec. 4888.

The word "discovery" does not have, either in the Constitution or the statute, its broadest signification. In those documents it means nothing less than invention.

Walker on Patents, Fifth Ed., Sec. 2.

That the subject matter of every patent must be the creation of nothing less than invention appears from the statute itself, and is recognized by all the courts.

Thompson v. Boissilier, 114 U. S. 11;

Pierce v. Mulford, 102 U. S. 112.

In the case of *Atlantic Works v. Brady*, 107 U. S. 192, Justice Bradley sets forth some of the distinctions between invention and natural advancement and mechanical skill, in the following forceful and instructive language:

"The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in its principle and injurious in its consequences. The design of the patent

laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

A statement to like effect was made by Judge Phillips in the case of *Tiemann v. Kratz*, 85 Fed. 439.

Indeed, nearly a hundred cases involving that rule have now been adjudicated.

Walker on Patents, Fifth Edition, Page 27.

Cases collected in note 18 on said page.

"Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selecting

and combining them; mechanical skill in applying them to practical results; none of these are creation. None of these enter into the inventive art."

Robinson on Patents, Vol. 1, page 117.

Walker on Patents (Fifth Edition) lays down the following rules supporting them by authorities:

Sec. 30. "It is not invention to so enlarge and strengthen a machine that it will operate on larger materials than before." (Compare, plaintiffs' contention of added strength gained by making his oil reservoir in one piece).

Sec. 31. "It is not invention to change the size or degree of a thing, or of any feature or function of a machine or manufacture."

Sec. 32. "Aggregation is not invention."

It is often repeated that patents are entitled to liberal consideration, but always liberality is due only to actual inventors. "*Such inventors*," as Justice Bradley states above, "are worthy of all favor." It is in every instance "*the right of the inventor*" (*Tarrill v. Railway Co.*, 1 Wall. 491); "*the just claims of the inventor*" (*Rubber Co. v. Goodyear*, 9 Wall, 788); "*actual invention*" (*McClain v. Artmayer*, 141 U. S. 425); "to secure to inventors a monopoly of what they have actually invented or discovered" (*Topliff v. Topliff*, 145 U. S. 171), and not a mere as-

seration of right that is entitled to the favor of the courts.

The most which could be said for the Gilchrist device would be that wise judgment had been used in combining elements found in or selected from other devices without in any way changing the function which any of these elements performed, either separately or in other combinations. Under the points and authorities hereinafter given it will be found this would not amount to invention.

There was no task left for Gilchrist to solve. A side with an interior oil chamber in one piece is not what the claims cover and, therefore, cannot be the foundation of the patent. Neither the claims nor the specification refer to this feature as the invention and the Court cannot reconstruct the claims.

The making of a side with an interior oil chamber cast in one piece was old and therefore could not be the subject of invention.

Even if no such side could be found in the prior art, the making in one piece of that which had previously been made in several pieces could not amount to invention.

Claim 1 as drawn is anticipated by the Morgan patent and therefore void.

A new and useful result within the meaning of the patent law is more than the mere bringing together of elements in a new and workable combination.

POINTS AND AUTHORITIES

INVENTION AND NOVELTY ARE QUESTIONS OF FACT.

The question of invention is always a question of fact and not a question of law.

Pappenhusen v. Fakke, 5 Blatch. 49;

Streeter v. Davis, 16 F. R. 564;

Keene v. New Idea Spreader Co., 231 F. R. 701.

But these questions of fact are to be determined by means of the rules of law.

Walker on Patents (Fifth Ed.), p. 59.

Questions of novelty are also questions of fact.

Battin v. Taggert, 17 How. 74;

Farrill v. Railroad Co., 1 Wall. 491.

THE CLAIMS MEASURE THE INVENTION

“As patents are procured ex parte, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or if broader, they must be held to have surrendered the surplus to the public.”

Keystone Bridge Co. v. Iron Co., 95 U. S. 278.

See also:

Continental Paper Bag Co. v. Easton P. B. Co.,
210 U. S. 405.

As has been previously noted by Sec. 4888 of the Revised Statutes, the claims of a patent are made an indispensable part of every application for patent.

The Court is doubtless familiar with the law on this subject, but it is deemed in order to present the following propositions of law: All claims are required to be definite "so that the public may know what they are prohibited from doing during the existence of the patent, and what they are to have at the end of the term as a consideration for the grant."

Brooks v. Fiske, 15 How. 212, 215.

"It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand and correctly describe, just what he has invented and for what he claims a patent."

Merrell v. Yeomans, 94 U. S. 573.

The invention patented is the invention set forth in the claims and that only.

Riley v. Morse, 15 How. 62;

Grant v. Walter, 148 U. S. 554;

McClain v. Ortmyer, 141 U. S. 424;

Yale Lock Co. v. Greenleaf, 117 U. S. 555.

CLAIMS CANNOT BE ENLARGED BY SPECIFICATIONS.

"(1) Strictly speaking, infringement of a patent is an erroneous phrase; what is infringed is a claim,

which is the definition of invention, and it is the claim which is the cause of action.

“One may appropriate many of the ideas or concepts suggested by the specification and drawing, but it is the claim that measures both the patented invention and the infringement thereof. This rule obtains whether the patent be spoken of as great or small, primary or secondary.”

(Citing Walker on Patents, 5th Ed., 186.)

“(2) A patentee may describe something that he does not claim, or claim that which he does not describe; his grant of privilege is construed to cover only that which is both described and claimed, no matter how broad the claim-language may be. * * * Description may limit a claim, which must always be read in the light of the prior art; but it can never expand it. So that a patent (i. e., a claim) can never be given a construction broader than its terms in order to cover something which might have been claimed but was not.

“(3) The drawings may help out an ambiguous description, but never can they supply the entire absence of any description of the feature of the invention.”

Fulton Co. v. Powers Regulator Co., 263 Fed. 578, page 580.

The case of Fulton Co. v. Powers Regulator Co., *supra*, pertains to a water heating apparatus in which one of the elements was a thermo-sensitive bulb con-

taining a trap. The functional difference between the plaintiff's apparatus as described and defendant's No. 8 was the prolongation of the tube, pipe or conduit inside the bulb with the crooked end at the bottom thereof. The language of the claim is "A conduit opening into said vessel." The specifications nowhere state whether the tube is long or short. Conduits had long been used in connection with similar apparatus and it would be necessary to construe the plaintiff's apparatus as embodying a long and crooked conduit in order to avoid anticipation from the prior art. In view of this situation the Court found that there was no infringement for the reason that while the claims could be read so as to include defendant's device, they could not so be read without also reading in the devices of the prior art.

"There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that, if we once began to include elements not mentioned in the claim, in order to limit such claim, and

Continued page 28

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27

"Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or certain device, or part of the machine, this is an implied declaration, as conclusive, so far as the patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. So far as the patent is concerned, the remaining parts are old or common and public."

The Corn Planter Patent, 23 Wall. 181.

The claiming of a specific device and an omission to claim other devices apparent on the face of the description is the dedication of the latter to the public, unless saved by re-issue of the patent.

Miller v. Brass Co., 104 U. S. 350.

EACH CLAIM IS AN INDEPENDENT PATENT.

Each claim is an independent patent.

U. S. Nickel Co. v. Calif. Electrical Works,
25 Fed. 475.

Considered as and setting forth an independent invention.

Leeds & Catlin v. Victor Talking Machine Co.,
213 U. S. 301.

Continued page 28

Order of pages 27 and 28 should be reversed
28

avoid a defense of anticipation, we would never know where to stop."

McCarthy *et al* v. LeHigh Valley R. R. Co.,
160 U. S. 110;

Railroad Co. v. Mellon, 104 U. S. 112, 118;

5th Ed. Walker on Patents, p. 235, Sec. 181.

EACH ELEMENT CONSIDERED ESSENTIAL

Inasmuch as the claims measure the invention, each element is a necessary part of the same and where a combination has been patented, and in the patent is described a claim as consisting of certain elements, each of such elements is thereby made an essential feature of the combination, whether necessary to the performance of its function or not, and cannot be repudiated by the patentee.

Royer v. Schultz Belting Co., 28 Fed. 850;

Fay v. Cordesman, 109 U. S. 408.

If, therefore, a patentee inserts an unessential feature in his claim, he cannot afterwards deny its materiality.

LeFever v. Remington, 13 Fed. 86.

Wright v. Yuengling, 155 U. S. 47, 52.

Where a claim ascribes a function to any of the things which it specifies, that ascription is a limitation of that claim.

Masseth v. Larkin, 111 Fed. 409.

Continued 27

And each claim is judged by itself and stands or falls as though it were the only one included in the patent.

Robinson on Patents, Sec. 972, Vol. 3, p. 166.

Russell v. Place, 94 U. S. 606.

COURTS SHOULD PROTECT PUBLIC AGAINST PATENT MONOPOLY.

“(2) The present hearing illustrates even more fully than the former hearing the necessity of requiring a patentee to reasonably limit his claims, so that they shall embody and specify elements essential to his actual improvement in the art. The right of a patentee to exclude others from the use of old and familiar mechanical combinations and structures must be carefully restricted. The duty rests upon the courts to guard the rights of the public against that form of unjust monopoly which may result from sustaining highly abstract claims. The language of the Supreme Court in *Carlton v. Bokee*, 17 Wall. 463, 471, 21 L. Ed., 517, should always be in mind:

“‘We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry. * * *’

“An attempt to save such claims by a beneficent interpretation is not only contrary to well-established

patent law, but a practical mistake. Patent claims are advisedly made by skilled solicitors, and if they choose to claim abstractions or high generalizations they must stand by them.

“As was said in *American Bell Tel. Co. v. National Tel. Mfg. Co.* (C. C.), 109 Fed. 1043:

“‘The patent statutes require the patentee himself to claim and define his invention, so that the public may know its rights, and so that there shall not be imposed upon the courts the burden of constructing upon a hearing new claims from the interpretations that experts may place upon language of the most sweeping and general character.’”

“(3) What is prior art is a matter that cannot be determined arbitrarily, nor merely by a restriction of the claim to a special use.

“If the thing is old, and is applied to perform its old functions, it remains in the prior art, and cannot be made novel, in the sense of the patent law, merely because used in new surroundings that do not affect its character or mode of operation.”

Robinson v. Tubular Woven Fabric Co., 248 Fed. 526, 541, 542.

PRESUMPTION OF VALIDITY.

“The Patent Office being charged by law with the duty and being given the power to pass upon all applications for patents, the courts always *prima facie*

presume that its action in granting a patent is correct. But this presumption has not been treated by the courts as conclusive, and the reports are full of cases in which the presumption was overcome and the patents held invalid. It is by no means certain that this has not been the result in a majority of cases which have reached the Supreme Court. The reason must be that in many essential respects the hearing in the Patent Office is to a degree *ex parte*, and there must be a natural and altogether proper disposition there to give the applicant the benefit of all serious doubts."

Wm. B. Scaife & Sons Co. v. Falls City Woolen Mills Co., 194 Fed. 139, 145.

PRESUMPTION DESTROYED BY FILE WRAPPERS.

The file wrappers and contents of the Gilchrist patents, in view of the prior art, destroyed ~~the~~ the *prima facie* presumption of invention.

The fact that the British patent of Morgan, defendant's Exhibit 3-0, was not cited or referred to in the file wrapper of Gilchrist patent No. 977,613, overcomes and destroys any *prima facie* presumption which might otherwise be indulged in to establish novelty or invention.

The language of the Court as hereafter quoted applies with emphasis to this case:

"We do not agree with the contention that the file wrapper discloses the patent to have been granted as

first applied for, without any references, adds any force to the presumption of novelty arising from the grant. On the contrary, we think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the examiner to, or consideration of, the 'Clark' patents. It does not seem likely that an expert examiner would pass them by, without notice or consideration, if they had been called to his attention. We feel compelled, therefore, to the conclusion that the first and fifth claims of the patent in suit are invalid for want of patentable novelty."

American Soda Fountain Co. v. Sample, 130
Fed. 145, 149.

"It should be noted that it appears from the record that neither Wightman nor the Potter patent was cited to the examiner in the patent office and were overlooked by him. This circumstance affects the presumption in favor of the validity of the patent from its issuance."

Westinghouse Elec. Mfg. Co. v. Toledo P. C. &
L. Ry., 172 Fed. 371, 392.

"Nor is the ordinary presumption to be indulged in favor of the patent, because of the action of the patent office in allowing it; the Urie, Schwartz, and Suter patents, as it appears, not having been referred to, as they have been here."

Elliott & Co. v. Youngstown Car Mfg. Co., 181
Fed. 345, 349.

"In this case some of the most significant patents in the patent office apparently were not cited or referred to in the consideration of the petition for the patent in suit. This circumstance alone goes far to overcome the presumption of validity."

Wm. B. Scaife & Sons Co. v. Falls City Woolen Mills Co., 194 Fed. 139, 145.

THE PRESUMPTION IS A MERE RULE OF EVIDENCE AND CANNOT USURP THE JUDGMENT OF THE COURT.

"The presumption referred to is something defined to mean that the patent itself is *prima facie* evidence of novelty and of invention, but that presumption is probably a mere rule of evidence, which casts the burden of proof upon the alleged infringer. This presumption cannot usurp the province of the court to declare what constitutes novelty. The courts should give due consideration to the action of the patent office, but should not permit that action to control its deliberate judgment when it is manifest that there is no invention."

J. J. Warren Co. v. Rosenblatt, 80 Fed. 540, 543.

"The patent office, however, has generally issued a patent to any one who produced a device not before known, unless it was considered reasonably clear that such device did not involve invention. Therefore, in finding a remedy for the evils above stated, the courts

have held invalid a large percentage of litigated patents."

Boss Mfg. Co. v. Thomas, 182 Fed. 805, 816.

UTILITY AND COMMERCIAL SUCCESS.

"It is shown that large sales have been made of the manure spreaders upon which the patented structure in question has been used, and it is insisted that this fact in connection with the presumption arising from the issue of letters patent, ought to sustain the patent. True, in cases of doubtful validity, commercial success of the patented device is helpful, but such a fact cannot aid patented claims which are, as here, clearly lacking in the necessary quality of invention." (Citing numerous cases.)

Keene et al v. New Idea Spreader Co., 231 Fed. 701, 710.

"The utility of a device and commercial success in exploiting it cannot be used to resolve the doubt as well as to create it, else every useful and successful thing would be patentable."

Republic Rubber Co. v. G. & J. Tire Co., 212 Fed. 170, 172.

"It is true that the Taylor machine seems to be capable of doing more work and at less expense for labor and pouncing material, than the prior devices,

which it appears to have largely supplanted; but this consideration, while persuasive, is by no means decisive, and is only available to turn the scale in case of grave doubt respecting the validity of invention."

National Hat Pouncing Machine Co. v. Heddon et al, 148 U. S. 482.

"It is true the Orum lock seems to have gained an immediate popularity, to have met with large and increasing sales, and to have had the usual effect of successful patents in stimulating the activity of business competitors to produce an equally useful and popular device. Were the question of patentability one of doubt, this might suffice to turn the scale in favor of the patentee, but there are so many other considerations than that of novelty entering into a question of this kind that the popularity of the article becomes an unsafe criterion."

Duer v. Corbin Cabinet Lock Co., 149 U. S. 216. (Near end of decision.)

"It may further be conceded that appellant's carriers are better than the Alvey carriers or any other of the prior art; this, too, is unavailing. It is met by the old rule that mere carrying forward of the original idea, a change in form, an improvement in degree, without substantial change in either means or result, is not invention."

Huebner Toledo Breweries Co. v. Matthew Gravity Carrier Co., 253 Fed. 435.

**SUPERIORITY OF ARTICLE AND COMMERCIAL SUCCESS DO
NOT PROVE INVENTION.**

“It may be true that Helms was the first to use a burnishing tool having a guard, in connection with a finger rest, and that his machine is probably superior to machine devices of like design, but as all of these elements were old and no new function is formed by the combination, it is a case of a mere aggregation which it is well stated is not patentable.”

Union Edge Setter Co. v. Keath, 139 U. S. 530.

“This is what we ascertain to be the precise idea embodied in the invention described and claimed in the patent, and which, although we find to be new in the sense that it had not been anticipated by any previous invention, of which it could therefore be declared to be an infringement, yet is not such an improvement as is entitled to be regarded in the sense of the patent laws as an invention.

“In reaching this conclusion we have allowed its due weight to the presumption in favor of the validity of the patent arising from the action of the Patent Office in granting it; and we have not been unmindful of the fact, abundantly proven, and indeed not denied, that the adoption of the present taxpaid stamp, in lieu of that previously in use by the Internal Revenue Bureau, has proven its superior utility in the prevention of frauds upon the revenue. The testimony on

that point of the Commissioner of Internal Revenue from his official reports is quite conclusive."

Hollister v. Benedict & Burnham Manufacturing Co., 113 U. S. 59, 70.

"(3) Upon careful consideration of the prior art and giving due weight to well established utility of plaintiff's device and its highly favorable commercial reception, we are unable to find in it room for invention. The most which, to our minds, can be said is that the inventor has, in the exercise of a high degree of mechanical skill, selected and put together the most desirable parts of different devices in the same art, making a new structure, *doubtless better* than any which preceded it, *but in which each part operates in substantially the same way* as it did in the old and effects substantially the same result. This is not invention." (Citing cases.)

Edwards v. Dayton Mfg. Co., 257 Fed. 980, 983.

See also Huebner Toledo Breweries Co. v. Matthew Gravity Carrier Co., 253 Fed. 435, under preceding heading.

See also following quotations from McClain v. Ortmeier, 141 U. S. 419:

"The principle announced in Vance v. Campbell, 1 Black 427, that where a patentee declares upon a combination of elements which he asserts constitute the novelty of his invention, he cannot in his proofs abandon a part of such combination and maintain

his claim to the rest, is applicable to a case of this kind where a patentee has claimed more than is necessary to the successful working of his device." (Page 425.)

"Counsel for plaintiff in the case under consideration has argued most earnestly that the only practical test of invention is the effect of the device upon the useful arts—in other words, utility is the sole test of invention, and, inferentially at least, that the utility of a device is conclusively proven by the extent to which it has gone into general use. He cited in this connection certain English cases which go far to support this contention. *These cases, however, must not be construed in such way as to control the language of our statutes, which limits the benefits of patent laws to things which are new as well as usefull.*" (Page 427.)

"If the generality of sales were made the test of patentability, it would result that a person, by securing a patent upon some trifling variation from previous known methods, might by energy in pushing sales, or by superiority in finish, or decorating his goods, drive competitors out of the market and secure a practical monopoly without in fact having made the slightest contribution of value to the useful arts." (Page 428.)

"While this court has held in a number of cases even so late as *Magowan v. N. Y. Belting & Packing Co.*, Ante, 332, decided at the present term, that in a doubtful case, the fact that a patented article has gone into general use is evidence of its utility, it is

not conclusive even of that—much less of its patentable novelty.” (Page 429.)

“But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. *These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use.* In neither case can there ^{be} by an invasion of such domain and an appropriation of anything found there. In one case everything belongs to the prior patentee, in the other, to the public at large.

The question before us must be considered in the light of these rules. All the particulars claimed by the complainant, if conceded to be his, are within the category of *degree*. Many textile fabrics, especially those of cotton and wool, are constantly improved. Sometimes the improvement is due to the skill of the workmen, and sometimes to the perfection of the machinery employed. The results are higher finish, greater beauty of surface, and increased commercial value. A patent for the better fabric in such cases would, we apprehend, be unprecedented. The patent in the present case rests upon no other or better foundation.” Decree affirmed.

Smith v. Nichols, 21 Wall. 112, 119.

“In short, this is a patent only for superior workmanship, and within all the authorities is invalid. This court has repeatedly stated that all improvement is not invention. If a certain device differs from what precedes it only in superiority of finish, or in greater accuracy of detail, it is but the carrying forward of an old idea, and does not amount to invention. Thus, if it had been customary to make an article of unpolished metal, it does not involve invention to polish it. If a telescope had been made with a certain degree of power, it involves no invention to make one which differs from the other only in its having greater power. If boards had heretofore been planed by hand, a board better planed by machinery would not be patentable, although in all these cases the machinery itself may be patentable.”

Risdon Locomotive Works v. Medart, 158 U. S. 68.

AGGREGATION IS NOT INVENTION.

Walker on Patents, 5th Ed., Sec. 32.

It is the contention of defendant that complainant's patents describe and claim a mere aggregation of old elements, all of which elements are found in the prior art performing the same functions which they perform in the Gilchrist devices.

As questions of invention and novelty are questions of fact to be decided by the Court under fixed rules of law, and, as the law is well settled that mere ag-

gregation is not invention, the question of aggregation also becomes a question of fact to be decided by the Court under fixed rules of law, based upon what may be found in the prior art in the form of actual operative devices or descriptions in previous patents and publications.

There are hereinafter set forth statements and quotations taken from cases heretofore decided, from which it may be seen how some of our ablest patent jurists have applied these rules of law in deciding the questions of fact which they had under consideration.

COMBINED RESULTS MAY BE AGGREGATION.

“It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination, and not a mere aggregate of several results each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention.”

Hailes v. Van Wormer, 20 Wall. 353, 368.

In the following case the court had under consideration a patented flume-gate. The evidence as to the prior art showed the use of two forms of gates, both manufactured of galvanized iron. One of the prior gates differed from that of the patent only in the fact that the plate edges which held the slide against the projecting edge of the tube were bent and flattened instead of being inbent and curved so as to present a resilient pressure against the slide. This gate, known as the "Ford gate" was satisfactory on the whole, although inferior to the appellant's gate, and the court stated that had this gate been the only one of the prior art it would have been disposed to say that the appellant's device was patentable, as showing invention and improvement on the prior art.

"Now, what the appellant has done is to take the best features of those two forms of gates in prior use and combine them in one. We agree with the court below that this is not invention.

"Counsel for the appellant, in view of the fact that the Ford gate and the other gates of the prior art were in common use side by side for more than ten years before the date of the appellant's invention, inquires why, if the step taken by the appellant was an obvious one it was not taken by some mechanic during all that long period of time. The answer seems to be that the Ford gate was reasonably satisfactory. According to the testimony, it is still satisfactory. It is displaced by the appellant's gate only in cases where the purchaser desires to secure a bet-

ter made gate, and perhaps a better gate, at a higher price than the Ford gate.”

Campbell v. Mangle (9th Cir.), 194 Fed. 110, 112.

In the case of Self-Sealing Can Co. v. Hacker, 136 Fed. 418, 420, the court had under consideration a patented self-sealing can. It was found that covers similar to those used were described in the Norton patent and that a similar mechanism on the can was found in the Bently patent, but the connecting mechanism was different in the Norton patent and the top was different in the Bently device, in that the same was made of wood and the opening was made of a different shape, but by selecting elements from each of these other patents or devices a combination similar to that in the patent under consideration could be obtained.

At page 420 is found the following language:

“The Norton can top, patented June 21, 1881, is similar in construction to that of defendant. In this patent, however, a wooden top was used.

“The Bently top, however, is the same kind of mechanism as that of plaintiff, but the opening in the can was different and the flange extended upwards instead of downward.

“So that we have in the Bently can top and the Norton can opening the same combination found in the Spencer patent. Merely bringing old devices in juxtaposition, and there allowing each to work out its

own effect, without the production of something novel, is not invention." (Citing *Hailes v. Van Wormer*).

"The effect of this use of old devices in the construction of the McNeal split wood pulley was to strengthen it, and thus add to its durability; but it did not produce a new result or effect."

Dodge Mfg. Co. v. Collins, et al, 106 Fed. 935, 938.

"Each element of the claim in suit was old in this very art, and has been used to perform the same function assigned to it in Johnson's present device. This ruffler introduces no new mode of operation, produces ruffles no better and no faster, and does not afford the user (though it may to the manufacturer) any advantages over others. The novelty consisted in selecting and rearranging old elements to produce a machine new in form, but old in function, and therefore an old machine."

"'It is not invention to combine old devices into a new article without producing any new mode of operation.'"

Cheapness of the article was urged.

"But the patent is for improvements in a machine which is a combination of mechanical elements adapted to receive and apply motion to the production of a mechanical result, and the patent would as certainly be infringed by a ruffler of which the parts were forged or cast or machined as by one made of stamp-

ings. The consideration of cheapness therefore lies in the process, and not in the product.”

Griest Mfg. Co. v. Parsons, 125 Fed. 116, 119.

Walker, under the head of Aggregation, refers to *Hailes v. Van Wormer* in the following language:

“In *Hailes v. Van Wormer* the patents passed upon, covered certain self-feeding coal stoves. These stoves were better than any which preceded them, because they contained more good things than were ever before assembled in that kind of heater. All of the things so assembled were old. The superiority of the patented stoves arose from the fact that sundry good features, theretofore scattered through several, were in them gathered into one such article of manufacture. The things so united did not, however, perform any joint function, but each did only what it had formerly done in former stoves. The Supreme Court held the whole to be a mere aggregation of devices, and not to be invention.”

It may be added by way of further explanation of the foregoing case that some of the elements of the claim pertain to the means and manner of controlling the smoke and draft; other elements pertain to the shape of the fire box, grates and magazines; while still others pertain to the use of mica, through which the flames or burning could be observed.

On page 374 of the reported case is found the following apt language concerning the attempt to include the mica or illumination openings as an element of the combination:

“We observe that its first claim was for a combination of the illumination openings, flame-expansion chamber, coal-supply reservoir, fire-pot, descending-flue and draft-flue, substantially in the manner and for the purpose described. In the main this is the same combination as that claimed in the reissued patent we have had under consideration. The only change is the addition of illumination openings. These were a well-known device applied to stoves long before either of the patents were granted. They perform no peculiar office in the new combination. They have no possible relation to it. They do not affect, in the slightest degree, the results of that combination, whatever they may be. It is impossible to regard the mere addition of such openings to a stove containing the improvements described in the reissued patent, as the formation of a new patentable combination. It is not invention.”

In the case of *Pickering v. McCullough*, reported in 104 U. S. 310, the court had under consideration whether or not the combination of a forming rib to shape or form the inside of a piece of crucible or pottery in combination with a mould and revolving disk for holding in place and forming the outside of the article, was patentable. The prior art disclosed that one Salvétat had previously described or used a rib for forming the inside of a piece of crucible or pottery in connection with a revolving table or potter's wheel, in connection with which it was necessary to partially present and support the ball or article of

pottery under the action of the rib by the workman using his hands. The rib described as used by Salvetat was so guided as to cause it to approach the axis of the pot where it was necessary to do so in order to prevent injury to the pot.

The prior art also disclosed a mould for manufacturing certain articles of pottery by means of a device which moulded the outside of the article and held it in place under the action of the rib which shaped the interior of the crucible; but in this combination the rib could not be guided towards the center and it was therefore impossible to make a pot or crucible which would be larger in its central portion than at the top thereof, as the rib would destroy and break the top upon removing the same.

On page 317 of the reported case the court uses the following language:

“The alleged invention then consists merely in supplying to the apparatus described by Salvetat a mould for supporting the ball and give shape externally to the crucible. We are clearly of the opinion that this is not patentable. It comes plainly within the rule as stated by Mr. Justice Strong in *Hailes v. Van Wormer*.”

The court then approves the foregoing quotation from *Hailes v. Van Wormer*, and continues with the following language:

“‘The combination, to be patentable,’ said Mr. Justice Hunt, in *Reckendorfer v. Faber* (92 U. S. 347, 357), ‘must produce a different force or effect,

or result, in the combined forces or processes, from that given by their separate parts. 'There must be a new result produced by their union; if not so, it is only an aggregation of separate elements.'

"In Nimmo's apparatus, it is perfectly clear that all the elements of the combination are old, and that each operates only in the old way. Beyond the separate and well-known results produced by them severally, no one of them contributes to the combined result any new feature; no one of them adds to the combination anything more than its separate independent effect; no one of them gives any additional efficiency to the others, or changes in any way the mode or result of its action. In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention, seized each of every part, "*per my et per tout*," and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. Otherwise it is only a mechanical juxtaposition, and not a vital union.

"In the case of this apparatus the mould was known, and a rib or former was known, and their use in combination was known. Salvétat described a rib, so arranged that, after it had performed its function in shaping the interior of the vessel, it could be with-

drawn, through the top of the vessel, so as not to produce injury by striking against its side. 'This rib Nimmo substituted for the old one in the same combination. And this is the whole of the invention. Upon the principle stated, there is no invention in it.'

In the case of *Bussey v. Excelsior Manufacturing Co.*, 110 U. S. 131, the court had under consideration the patentability of combining a portable reservoir with an escape-pipe or flue forming a part of the reservoir, a warming-closet below a base-pan, and a damper. On page 146 the court uses the following language:

"A detachable base-pan existed before, and hearths and ash-pans existed attached by lugs and hooks in the same way as the defendant's base-pan. A portable reservoir was old, with an escape-pipe or flue forming a part of the reservoir. A damper for the middle flue was old. A warming-closet below a base-pan and that below a reservoir were old. In view of the state of the art there was no invention, in claim 1 of the patent, in using to attach the base-pan an old mode used in attaching other projecting parts of the stove. Claim 2 is merely for an aggregation of parts, and not for a patentable combination, there being no patentable relation between a portable reservoir with a flue in its rear side and the existence or portability of a base-pan beneath it. In claim 3 there is merely an aggregation of parts, there being no patentable relation between a damper for the middle flue of a

three-flue stove, and the existence or portability of a base-pan or the existence of a warming-closet."

In the case of *Boyer v. Roth, et al*, 132 U. S. 201, the court had under consideration the question of invention in a combination claim covering the drum and shifting device of a rawhide fulling machine used to twist leather. The new element in the combination was that of a shifting device which would automatically cause the drum to turn a given number of revolutions in one direction and then reverse and turn a like number of revolutions in the other direction. It appears that the drum was previously operated in the same manner for the treatment of rawhide, except that there was no automatic shifting device upon the same. By reason of not having an automatic shifting device the leather would sometimes be twisted too long in one direction before reversal of the machinery for twisting it in the other direction. The combination consists of attaching to this rawhide fulling machine an automatic shifting device, the same as had been previously used for operating a washing machine.

Near the end of the last paragraph of the opinion is found the following language:

"There is no patentable combination of the automatic shifting device with the drum of the fulling machine. It is a mere aggregation of parts. The shifting device operates automatically to reverse the action of the fulling machine, in precisely the same way that it operates when applied to any other ma-

chine; and, the shifting device being old, the application to the fulling machine did not require the exercise of invention."

In the case of *Office Specialty Mfg. Co. v. Metallic Mfg. Co.*, 174 U. S. 492, 43 Law. Ed. 1058, the court had under consideration the patentability of a book shelf, which combined a recessed portion in the front thereof, for grasping the books without interference with the rolls, and rolls at the sides and backs thereof, upon which the books could roll in place, similar to such as are now in general use in recorders' offices. The court held that the employment of semi-cylindrical hand holds or recesses for more readily grasping the books is such a familiar device in upright partitions for holding books that the court might properly take judicial knowledge of their long use. On page 498 is the following language:

"Putting Hoffman's patent in its most favorable light, it is very little, if anything, more than an aggregation of prior well known devices, each constituent of which aggregation performs its own appropriate function in the old way. Where a combination of old devices produces a new device, such combination is doubtless patentable, but where the combination is not one of new elements, but of old elements, and no new function is evolved from such combination, it falls within the rulings of this court in *Hailes v. Van Wormer*. (Also various other cases cited.) Hoffman may have succeeded in producing a shelf more convenient and more saleable than any which preceded it, but he has done it principally, if not wholly, by the exercise of mechanical skill."

SELECTED ELEMENTS.

In the case of *Turner v. Lauter Piano Co.*, 248 Fed. 930, the court had under consideration the question of patentability of the reinforcement of concrete. The reinforcement was effected by first placing perpendicular columns and then arranging rods so they would extend laterally in all directions from each column and would be near the upper surface of the slab or floor at the points over the column extending down so as to be near the lower edge of the floor or slab in between the columns. It was found that various means for reinforcing concrete had previously been used. Among others, one Turner had provided a means, using ordinary hog wire in extending from column to column. In summing up the situation the court came to the conclusion that the complainant had selected the best of known elements in their combination and had thereby produced a better product than had been priorly produced. Paragraph 2 of the syllabus very clearly sets forth what is thereafter stated in the latter part of the decision. This paragraph of the syllabus reads as follows:

“The union of selected elements from various sources in a patented structure may be an improvement upon anything the prior art contains; but if, in combining them, no novel idea is developed there is no patentable invention, however great the improvement may be.”

“To sustain a patent on a combination of old devices, it is well settled that a new result must be ob-

tained which is due to the joint and co-operating action of all the old elements. Either this must be accomplished, or a new machine of distinguished character and function must be constructed.'” (Citing numerous cases.)

West Coast Safety Faucet Co. v. Jackson Brewing Co., (Ninth Circuit.) 117 Fed. 295, 298.

In the foregoing case the court had under consideration the combination of a screw-valve provided with steep threads with that of a thick washer between the faucet and its seat, concerning which the court said:

“Neither of these elements is new and no invention was required to bring them into play in the combination.”

“Undoubtedly the result is a more perfect machine, but is simply more perfect because of the cooperation of the great number of elements, and not because of any new function performed by the combination.”

Union Edge Setter Co.v. Keath, 139 U. S. 530.
(Next to last paragraph of opinion.)

ALL OF THE ELEMENTS NEED NOT BE FOUND IN A SINGLE ARTICLE.

To defeat a combination claim upon the ground that it is a mere aggregation of old elements, it is not necessary to find all of these old elements in a single machine, device, patent or publication. On the con-

trary, even though it may be necessary to search various articles, devices and publications of the prior art in order to find all of the elements, if they may thus be found, performing the same function which they perform in the combination claim, the claim will be invalid by reason of being a mere aggregation.

In the case of *Adams v. Bellarie Stamping Co.*, 141 U. S. 539, the appellant contended that the lower court had erred in refusing to instruct the jury that the finding of each element in some older patent would not necessarily defeat the combination patent. In the last two paragraphs of the opinion is found the following language:

“We do not perceive that in the ruling of the court any substantial error was committed. The elements combined to form the alleged invention merely constituted an aggregation of old devices, each working out its own effect, without producing anything novel, and such an assemblage or bringing together of old devices, without securing some new and useful result as the combined product of the combination,—something more than a mere aggregation of old results,—does not constitute a patentable invention. *Hailes v. Van Wormer*, 20 Wall. 353; *Pickering v. McCullough*, 104 U. S. 310. The court did not, therefore, err in refusing the instruction requested, that before the patent could be held invalid by reason of a prior patent it was not sufficient to find one of the elements in one patent, and second in another, and third in another. If the patent were for a combination of new or old elements, producing a new result, such instruction

might have been correct; but as it was merely a new aggregation of old elements, in which each element performed its old function, and no new result was produced by their combination, the instruction was not applicable, and was properly refused.

“Nor, under the circumstances, did the court err in declining to instruct the jury that the fact that the Irwin lantern had practically superseded all others was strong evidence of its novelty.”

In the case of *Hailes v. Van Wormer* heretofore referred to and so often cited by the courts, the various elements which went to make up the combination claim were scattered throughout the stove industry, some element being selected from one device, some from another, and others from still other devices.

In the case of *Pickering v. McCullough* heretofore referred to, the patentee had brought together elements selected from two different devices.

In the case of *Boyer v. Roth et al*, 132 U. S. 201, heretofore referred to, the patentee had brought together elements selected from the fulling machines, and others which he had selected from a washing machine.

In the case of *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, in the third paragraph of the decision the court uses the following language:

“All that he claims as invention is found in one or more of the prior patents.”

“Par. 5. But it is said that defendant has failed to show any single patent or prior publication which contains all the elements of any of the contested claims, and that ‘the question of anticipation’ cannot be determined upon a showing from the history of the art that one of the elements may be found here and another there and so on throughout the entire number. Clearly the facts of the present case do not admit of, much less require resort to such a course here; too many parts of the present structure are found, as we have seen, in a single prior patent, not to speak of their repetition in several earlier patents. It is true, however, that the method suggested by counsel might not of itself justify condemning a patent; it is equally plain that the suggestion is not an answer to the question that must be left here; it overlooks the evidential tendency of the prior art in a given case either to establish or negative the presence of invention. It scarcely need to be said that courts may and do look into the prior art for the purpose of ascertaining whether the elements of a claim are new or old and, if old, whether through the means of comparison so afforded, the skill of a mechanic, or indeed the faculty of the inventor, was required to organize the elements of the claim and to adapt them so as to accomplish the result attained. It is not perceived, nor do counsel suggest, what better source of information, what means more calculated to lead the mind to a right conclusion, can be found than in the prior art. True, prior art becomes at times a source of confusion and even abuse. Still, to insist that claims disclose invention or discovery where their substantial equivalency in elements, in mode

of operation and results, plainly appear in two or more earlier patents or publications, though not all in one patent or publication, is to ignore the very terms of the patent act. Above all, counsel's theory is opposed to settled course of judicial decision." (Citing numerous U. S. and Fed. cases.)

Keene v. New Idea Spreader Co., 231 Fed. 701, 708.

The case of Huebner-Toledo Breweries Co. v. Matthews Gravity Carrier Co., reported in 253 Fed. at page 435, is a good illustration of the distinction which should be constantly kept in mind between the mere advancements of the art and actual invention.

In this case the patent under consideration was for a gravity carrier, consisting of side rails parallel to each other, having rolls between the rails and at right angles thereto made of hollow metal tubing. At each end of this tubing was a cone upon a rod which extended longitudinally through the center or axis of the roll and the center or axis of the cone. A cup bearing or track was provided at each end of the roll so as to form a race in which balls were placed so that the rolls had ball bearings similar to those found in the ordinary bicycle.

In tracing the development of the prior art the court found that each of the elements of the patent carrier could be found in some other article performing a similar function, for example, the ball bearing was referred to as performing the same function that it performed in the bearing of the bicycle.

On page 446 is found the following language:

“(1) It must, of course, be conceded that patentable novelty may exist in a combination of old elements; but here the combination claims in suit are lacking in the usual and essential tests of invention. No new function of elements or new method of operation is evolved, and the result achieved is exactly the same as the old one. The settled rule under such facts is that to adapt an old and familiar device to another structure equally old and well known is not to exercise the inventive faculty; it is to apply the skill of the mechanic. (Citing numerous cases.) Page 447.

“(3) It is said appellee's carrier is not anticipated by any single patent; but it is not necessary to show complete anticipation in a single patent. The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new machine, but in which each part operates in the same way as it operated before and effects the same result, cannot be invention; such combinations are in the nature of things the evolutions of the mechanic's aptitude rather than the creations of the inventor's faculty. (Citing numerous cases.)

“(4) Assuming, as counsel claim, that large sales have been made of the carriers in issue, still commercial success is never a safe criterion, except in cases of doubtful validity of the patent; such success cannot aid claims that are clearly without patentable novelty.” (Citing numerous cases.)

In the case of *Ryan v. Hard*, 145 U. S. 241, the court had under consideration a patent bed bottom. The material described by the patentee as being ~~owned~~^{used} in connection with this bottom was a woven wire fabric. The prior art disclosed that woven wire fabric had been previously used, but not in this particular combination, but that canvas had been used in the same combination in which the patentee used his woven wire fabric. On page 246, the court uses the following language:

"Is there patentable novelty in this change? It is thought not. If the patentees had been the first to introduce woven wire into the art, there would be more difficulty in reaching this conclusion, but they were not. All that they did was to suspend a fabric well known as a bed bottom in substantially the same manner that other fabrics used for that purpose had been suspended. If the patentees, instead of using woven wire had used some other woven fabric—woven twine or tape, for example—if their claims had included carpet or rubber cloth instead of woven wire, it will hardly be contended that they would be entitled to take rank as inventors. Why, then, should the use of woven wire give them this distinction? Its peculiar advantages above referred to as a material for beds were not discovered by them. The idea of swinging a bed bottom was not theirs. They have substituted one well known material for another, and nothing more."

BORROWING ELEMENTS FROM ANOTHER ART.

The Morgan block, British patent No. 712, defendant's Exhibits 3-0 and BB, the Labadie patent, defendant's Exhibits QQ, CC and DD, and the Ludford patent, defendant's Exhibits EE, FF and 3-D, are certainly a part of the prior art; but even if it should be conceded that they were merely from a related art, they destroy the validity of complainant's patent No. 977,613, as it would not constitute an exercise of the inventive faculty to improve the Morgan block combination by borrowing the idea of an interior oil reservoir in an integral side from the Labadie Butters and Ludford blocks, pp. 44, 164 and 104 Transcript of Exhibits.

"There would be no doubt of patentability, in my opinion, if the device as an entirety were new. Both claims in suit are for a combination in end plates and locking device, and, though both are old, the patent would be good like thousands of other similar combinations, if the combination itself were new. There is undoubtedly an improved result, but the combination shows improvements only, and not invention, for the following reason: With a number of existing combinations of end plates and locking devices operating by forcing a stud into a slot, the patentees adopted an improved locking device from the related art of automatically locking boxes, shipping cases, etc. The precise lock is found in the Lehy patent, with the T-slot, beveled lug, smaller shank portion, push button, and all. The sole difference is that the patentees have

not invented a new combination of old devices, but have merely improved an old combination. All the cases cited by complainant's counsel, as I read them, related to new combinations. This seems true of *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *Imhaeuser v. Buerk*, 101 U. S. 647, 25 L. Ed. 945; *Parks v. Booth*, 102 U. S. 96, 26 L. Ed. 54; *Potts v. Creager*, 155 U. S. 597, 15 Sup. Ct. 194, 39 L. E. 275, and *Hobbs v. Beach*, 108 U. S. 383, 21 Sup. Ct. 409, 45 L. Ed. 586. In the last case the Supreme Court went as far as possible in sustaining a combination having one element borrowed from another art, but the earlier machines did not as here possess an inferior or less complete method for doing the same work. The machine itself was sufficiently novel to satisfy the rule that a patentable combination of old things must itself possess novelty."

*Siebor & Trussel Mfg. Co. v. Chicago Binder
& File Co.*, 177 Fed. 439, 441.

THE ONE ALLEGED NEW ELEMENT WOULD NOT SAVE COMPLAINANT'S PATENT.

Defendant strenuously contends that there is nothing new from a patentable standpoint in the side provided with an oil reservoir described in complainant's patent. But even if it should be conceded that the same is a new element, it would not require the exercise of the inventive faculty, in view of the prior state of the art, to embody it in the combination described in complainant's patent.

"It is urged that one cannot justly treat a combination patent by treating its elements as though separate. To this I agree, but I know no other way of determining the validity of a combination patent than to see how far the prior art shows all the elements in combination. If it shows all but one, and the necessary step does not involve invention, the combination itself is void. That seems to me to be the case here."

Herzog v. Charles Keller & Co., 234 Fed. 86, 87.

Quoted and approved in Cutler Mail Chute Co. v. American Mailing Device Corporation, 247 Fed. 508, 514.

"Nor was the case bettered by substituting one new element, itself showing no invention, in an apparatus otherwise old, and calling it a combination."

Miner v. T. H. Symington Co., 247 Fed. 515, 521.

See Aeolian Co. v. Wanamaker, 234 Fed. 90, 91.

ONE INTEGRAL CASTING FORMING SIDE AND OIL CHAMBER

Defendant's Exhibits 4-C, 3-D, QQ and ZZ show that there was nothing new in providing a side in one integral casting containing an interior oil reservoir; but even if it should be conceded that complainant was the first to devise a one-piece reservoir block side, this would not constitute invention.

As early as 1893, in the case of Howard et al, v. Detriot Stove Works, 150 U. S. 164, the Supreme Court of the United States laid down the rule that making in one piece what had previously been made in several pieces did not constitute invention. Near the end of the decision the following language is used:

“At the date of this invention it was common to make wood burning grates partly open and partly closed with teeth at their ends, which serve exactly the same purpose as the teeth, D, of the patent. These grates are all used in cooking stoves and are rectangular in form, while the Beckwith patent is circular in shape; but it cannot be maintained that there is any element of invention in making the grate fit the particular fire box of the stove to be constructed. To accomplish that end mechanical skill alone is necessary, and it does not call for the exercise of inventive talent.”

Further on the court uses the following language:

“As to the third patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together; nor to make the shape of the grate correspond with that of the fire pot.”

In the case of Consolidated Electric Manufacturing Co. v. Holtzer, 67 Fed. 907, hereinabove referred to, the court had under consideration a claim covering

“An electric battery, and negative electroid, including cup, cover and lip, *cast solid*, with an opening

in the cover of the positive * * *. The only advance alleged to be covered by either claim is in the fact that the cover, cup, and lip are cast solid, instead of being made of several parts soldered together, or otherwise secured to each other. There is no question on the score of utility, and a cup cast solid and lip was novel in connection with an electric battery. Therefore, the only issue is whether the device in suit contains invention, within the meaning of the statutes touching patents for mechanical devices.

“The right to improve on prior devices by making solid castings in lieu of constructions of attached parts is so universal in the arts as to have become a common one, so that the burden rests upon any one who sets up this improvement in any particular instance as patentable, to show especial reasons to support his claim. Livermore, the complainant’s expert, states that he does not know that any one of the features of complainant’s device was of ‘substantial novelty,’ but that, so far as he knew, a battery containing all of these features was new. This covers only the matter of mere novelty; and so much as this may be said of any combination in any of the arts in which, for the first time, two or more parts are cast as one. Complainant relies upon the rule applied by this court in *Watson v. Stevens*, 2 C. C. A. 500, 51 Fed, 760, 761, and claims that prior workers in this art had sought to devise means for avoiding the necessity of joints between the negative electroid and the cover or lip, but had never succeeded. We fail to find any evidence of this in the record. *He also claims that the Holtzer*

battery speedily superseded all others of its general type, which claim is sustained by the proofs. But all such considerations are applied with caution to a very limited class of cases, otherwise doubtful, as is made clear in Watson v. Stevens, and in the opinions of the Supreme Court therein cited, and in cases decided by that court since Watson v. Stevens, of which the latest is Olin v. Timpkin, 155 U. S. 141, 155."

Again on page 909 we find:

"In the suit at bar, there are not facts enough, of the character applied in these cases, to justify this court in giving complainant a monopoly in this particular art of the privilege of replacing jointed parts by solid castings,—a privilege so common and so constantly exercised in all other arts. But it is said a new result has been accomplished. This is a proposition which sometimes throws light on questions of this character, sometimes does not, and occasionally so appeals to the imagination as to be misleading. Every novelty, in some sense, brings a new result; but whether the new result is such, within the meaning of the decisions, is a very different question. These words are very far from furnishing a universal solvent. Sometimes the character of the new result is such as appeals directly to the trained mind as well as to the ordinary one. But usually the novelty of the result is only one fact to be weighed in the mass with others. In the case at bar it is of an unimportant character, in one aspect urged by the complainant, and, in the other aspect urged by him, is so common and universal as not to be of any

weight. The patent, in its specifications, looks only to the results of 'fewer parts and more simple construction,' and of producing an electroid 'very strong and durable,' which may be 'handled without fear of separation.' These are not new results, but are the ordinary consequences of dispensing with joints by casting solid, well known in all arts."

In the case of *Strauss v. Blumenthal*, 108 Fed. 841, the patentee had improved a harmonica, or mouth organ, making in one piece or integral the corrugated covering device, which was formerly made in two pieces. It was held that this did not constitute invention.

In the case of *Standard Caster Co. v. Caster Socket Co.*, 113 Fed. 162, 164, the court decided that the making of a caster socket with a spring integral with one half the socket did not constitute invention, as the prior art disclosed a socket having a spring attached thereto with rivets.

In the case of *Australian Knitting Co. v. Gormly*, 138 Fed. 92, 107, the court had under consideration a combination claim for a knitting machine. In the knitting machines disclosed by the prior art different patterns could be obtained by wholly or partially filling in the spaces between some of the blades, and it had been the custom partly or wholly to fill in these spaces by running a solder or lead. The patentee in the case under consideration provided blades with integral pro-

jections upon their sides which would serve the purpose of partially or wholly filling in the spaces as desired, which blades could be so arranged as to meet the requirements of the pattern to be made. The court held that the making of the blade integral with the filler to take the place of the soldering or riveting of projections thereon did not amount to invention.

“The court below reached the conclusion that ‘complainant’s device consists merely in making in one piece that which was formerly in two parts and performs no new function;’ and that ‘the production of a seamless insulating lining having a shoulder intermediate its length required nothing more than the knowledge of the trained engineer or workman.’ The correctness of this conclusion is challenged on the following grounds: ‘The fact that Palmer’s lining is made in one piece is only incidental. The important fact is that Painter’s lining is made without open seams or breaks exposing the metallic shell to electrical contact from the inside, * * * the important thing being the continuity of the insulating barrier,’ which introduced ‘a new construction, involving a new function,’ dependent upon ‘the discovery that a thin sheet-like tube of insulating fiber could be subjected to this character of compression,’ etc., and that this was not obvious, but ‘involved the exercise of the inventive faculty.’ ”

On page 570 is found the following language:

“The single question herein is whether this new construction ‘involved the exercise of the inventive faculty.’ The prior art shows and the patent admits that

such a lining in two pieces was old. That it does not involve invention merely to make such a lining in one piece is well settled." (Citing *Howard v. Detroit Stove Works* and *Standard Caster & Wheel Co. v. Caster Socket Co.*, 113 Fed. 162.) "*Nor would the mere fact that the one piece device was cheaper or more durable constitute invention when such result was merely such ordinary consequences of dispensing with joints as would naturally be anticipated by the workman.*" (Citing *Consolidated Electric Mfg. Co. v. Holtzer*, 67 Fed. 907, and *Standard Caster & Wheel Co. v. Caster & Socket Co.*, *Supra.*)

General Electric Co. v. Yost Mfg. Co., 139 Fed. 568, 569, 570.

In the case of *Lawson v. Metal Products Co.*, 209 Fed. 51, the court had under consideration the following claim:

"(3) The improved gem setting herein described consists of a body portion having an internal seat adapted to receive a gem, an integral flange extending from the top outline of said seat, and ornamental structures extending integrally from the base of said portion and from the outer surface thereof and in a plane substantially parallel to the plane passing through said seat, substantially as and for the purpose set forth.

"The specification says as follows:

" 'My invention relates to an improvement in jewel settings, and has for its object the making of various connections and ornaments integral with the box setting or gem setting now in common use.' So far as

this common use is concerned it is only necessary to refer to the patent issued to Geo. Wm. Dover, No. 795.109, of July 18, 1905, which contains everything claimed by the patentee here, excepting what is covered by the words in Claim 3 as follows: 'And ornamental structures extending integrally from the base of said body portion and from the outer surface thereof and in a plane substantially parallel to the plane passing through said seat.' The District Court dismissed the bill for want of patentability, without reference to the question of infringement, basing the want of patentability upon the Dover patent. * * *

"The learned judge of the District Court evidently thought that the Dover patent showed a construction which did not completely anticipate the patent in suit because *it did not cover ornamental extensions which were integral with the box settings*. That was the way he described the addition made by the patent in suit to the prior art. If there was no such addition, then the Dover device was properly an anticipation. If he was in error about this, then we must apply the rule well explained as follows:

"Walker on Patents, 4th Ed., 1904, Sec. 599, explained with reference to cases in which the court will take judicial notice of the matter of patentability. The propositions stated by Mr. Walker are very carefully guarded and properly limited. We think this case comes within those propositions with all their limitations. The alleged invention comes down to a mere matter of building solid what was formerly soldered together."

The court then goes on to quote the language hereinabove quoted from the case of Consolidated Electric Mfg. Co. v. Holtzer, *Supra* and reviews various other cases in which the same conclusion was reached.

In the case of Herzog v. Chas. Keller Co., 234 Fed. 86, the court had under consideration the patentability of a one-piece button. At page 87 is found a review of some of the cases hereinbefore cited, in the following language:

“(3) The only possible invention involved in the patent is to make out of one piece Henerlau’s or Ball’s button. In view of Hill’s patent for a one-piece button, this can hardly be regarded as invention; indeed, it would scarcely have been invention even if Hill had not shown a one-piece button. Howard v. Detroit Stove Works, 150 U. S. 164, 14 Sup. Ct. 68, 37 L. Ed. 1039; General Electric v. Yost, 139 Fed. 568, 71 C. C. A. 552; Lawson v. Metal Products Co., 209 Fed. 51, 126 C. C. A. 193. I do not mean that these cases decided that it is never invention to consolidate into one piece what has formerly been composed of three pieces. This may at times result in a consolidation of functions. *The case must, however, be very rare in which the bare idea involves invention to consolidate several members into one.* To overcome difficulties of manufacture involved in such a change may involve the very highest invention; but since the patent does not concern such difficulties, it must rest solely upon the idea of the integrity of the button.”

THE PATENTS SOLVE NO PROBLEM AND DO NOT INVOLVE
INVENTION

The only specific problems which the specifications of patent No. 977,613 indicate that the patentee was seeking to solve were:

“Providing a pulley (*sic*) which will contain a considerable quantity of lubricant, and feed the same, automatically and slowly, upon the bearing pin of the pulley.” (Lines 24 to 28, page 1 of specification.)
and

“To provide a pulley, (*sic*) the bearing pin of which is adequately protected against dirt and dust.” (Lines 33 to 35, page 1 of specifications.)

The first of these problems had been solved by Labadie, defendant's Exhibits CC and DD; Ludford, defendant's Exhibits EE and FF, and Morgan, defendant's Exhibit BB, and both the first and second of these problems had been solved by practically all logging supply houses in the Pacific Northwest. (See Columbia Steel Co.'s blocks, defendant's Exhibits I and GG, elbow and elbow extension blocks, defendant's Exhibits C and D.) (See also Hammond patent No. 876,176, defendant's Exhibit 3-H.)

At no place in the specification is it indicated that the patentee was seeking to provide a pulley block better able to withstand the strains and knocks of usage.

“Unless Hutcheson in adapting Cochran's roll separating means, has solved some real problem or has contributed some new and useful thing to the art, he

has not made an advance which entitles him to a patent. After careful study of the record, we are satisfied that whatever merit may be contained in Hutcheson's idea of a true rectilinear path, it does not involve invention."

Standard Tobacco Stemming Co. v. Tobacco Stemming Machine Co., 247 Fed. 112,116.

See last paragraph p. 74, also pp. 95 to 100 of this brief.

A NEW UNITARY RESULT

What constitutes a new unitary result which may furnish the foundation for a valid patent is well defined by the courts in the following quotations:

"The feature relied upon as differentiating the patent in suit from the prior art, and as constituting invention, is the unitary nature of the mechanism, in that it has only a single means of attachment to the tank, which means of attachment carries both elements of the operating mechanism, including the integral sleeve. As stated in the patent specification, 'both the center of the operating shaft 13 and also the center on which the valve operating lever 9 is fulcrumed are carried on' one fitting; viz. the plate 3 on the inner side of the tank-wall; whereas, as also said in the specification, 'with all prior valve mechanism the tank or wall had to have separately attached thereto at least two centers, sometimes more.' This construction makes the device more readily and accurately attachable, in that it dispenses with the necessity of positioning the fulcrum pin and the actuating lever 13 relatively to

each other (thus removing danger from unskilled or careless workmanship), and requires but one hole in the tank wall; it being practically necessary in the case of porcelain and enameled iron tanks to have the holes made at the factory. The unitary construction of course also makes the fixture more readily detachable, less liable to get out of order, and apparently less expensive. *The question is: Does this unitary construction alone amount to invention? It is clear that the operation of the device is precisely the same in all respects whether the pin 8, on which the lever 9 is fulcrumed, is an integral part of the plate 3 or whether it is inserted from the outside through the tank wall and directly secured thereto, instead of being indirectly so secured, by being part of the otherwise secured plate 3.* in the former case the device of the patent would plainly lack invention.

“This unitary construction of a flush-valve mechanism of the inner wall of the tank was apparently new, although White had in 1889 (Patent No. 398,681) shown a construction whereby the valve-operating lever and the hand-actuated lever (which had a cam connection) are both fulcrumed upon an integral bracket upon the upper edge of the tank, presumably of the elevated type. White’s mechanism was of the chain type, and his lever oscillated in but one direction.

“Neither of the references cited by defendant show anticipation. But the question we are dealing with is not one of anticipation, but of invention; and upon the question whether the device of the patent involves more

than the skill of the mechanic, neither White nor the reference to the lock and latch art are wholly irrelevant.

“(2-3) All elements of the prior art have a bearing upon the question whether there is invention in the device under consideration (*Zimmerman v. Advance Machinery Co.*, 232 Fed. 866,—C. C. A.—decided by this court april 10th last); and *it is not necessary to a finding of lack of invention that every element be found in one embodiment of the prior art* (*Keene v. New Idea Spreader Co.*, 231 Fed. 701,—C. C. A.—decided by this court March 17th, 1916.) *It is not invention merely to combine into one unitary structure mechanism formerly made in separate pieces, so long as each element operates in the same way to produce the same result.* *Caster Co. v. Caster Co.* (C. C. A. 6,) 113 Fed. 162, 168, 51 C. C. A. 109; *Eames v. Worcester Institute* (C. C. A. 6) 123 Fed. 67, 73, 60 C. C. A. 37, and cases cited; *Herman v. Youngstown Car Mfg. Co.* (C. C. A. 6) 191 Fed. 579, 586, 112 C. C. A. 185; *Gould v. Cincinnati Shaper Co.* (C. C. A. 6) 194 Fed. 680, 685, 115 C. C. A. 74. And while that proposition is not conclusive of the problem here, it is not without pertinency, for here the relative arrangement of the several parts of the valve-operating mechanism is the same, and each performs its mechanical functions in precisely the same way as if they were mounted separately instead of as parts of a unitary construction—and this without addition or adaption.

“The device of the patent in suit is not a new machine. The only problem solved is one of convenience and usefulness, resulting only from the unitary mount-

ing. It fairly expresses the applicant's advance to say that they assembled upon one supporting frame the same operating parts which had before been carried upon separate supporting members, and that these parts accomplished the same operative result in the same essential inter-relation, after the reassembling as before."

Ft. Pitt Supply Co. v. Ireland & Matthews Mfg. Co., 232 Fed. 873, 875.

"The appellant's contention, however, is that the six mechanical features called for by its patent have therein a special and peculiar relation to each other, which is essential to the adjustment of the skirt to large and small figures, without destroying the fit, and are so combined as to act and react on each other for the purpose of producing the desired results, thus constituting a true combination of mutually co-active parts; and that, when so combined, they serve to secure several advantages, which are thus recapitulated in the appellants brief:

"(1): Holding the skirt in place;

"(2): Causing it to conform to the figure and yield readily to the different motions of the wearer;

"(3): Adapting it to be adjusted to different sized figures;

"(4): Providing registry between the placket of the under and outer garment;

"(5): Concealing the fastening devices;

“(6): Preventing the fastening devices from coming in contact with the garment;

“(7): Adapting it to be employed in connection with all changing styles and fashions.

“Clearly, however, as appears both from the structure of the patent itself and the several advantages thus enumerated, the effect of its several mechanical features is not to secure one new unitary result or advantage by the reaction of their several functions, but rather to secure, through the several mechanical features, acting largely independently of each other, various results and advantages, relating in the main, to entirely separate and independent matters, and resulting from the assemblage of these various mechanical features in one structure in the form of an aggregation rather than a combination. Thus, without analyzing in detail the functions of these several mechanical features, it may be said, by way of illustration, that the three wings projecting from the back width under the flap of the placket obviously have no function in either holding the skirt in place, causing it to conform to the motions of the body, adjusting it to differently sized figures, concealing the fastening devices, or preventing wear and tear therefrom, but relate, at the most to the prevention of exposure through the placket opening and to the fit and appearance of the flap over the placket opening; in other words, that these three wings underlying the flap do not in any manner co-act with the other mechanical features of the plaintiff's structure in producing the other results and advantages which they independently obtain.

"Since, therefore, the assemblage in this patent of the old elements from the garment making art does not produce a new unitary organization due to the joint and co-operating action of the old elements, but constitutes, in its essential features, a mere aggregation of old elements, in which, in the main, each performs its own appropriate function in substantially the old way, the result must, under the well established rule, be held to constitute a mere aggregation of elements and not a patentable combination." (Citing numerous cases.)

Jackson Skirt & Novelty Co. v. Rosenbaum, 225
Fed. 531, 533.

"But it is urged on behalf of the appellee that the Hall patent differs from all previous devices in presenting a structure which, as an entirety, is radially expansible in all directions from a common center, so as to preserve the symmetry of the form, whatever its diameter may be, and by the combination of the patent a new and useful result is thus obtained, which involvss patentable novelty. In support of the validity of the patent, the principle stated in Loom Co. v. Higgins, 105 U. S. 591 is invoked. In that case it was laid down by the court as a general rule, though not an invariable one, 'that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention.' But we do not consider the Hall patent as coming within the principle there laid down, for the reason that the standard, the double braces, sliding blocks on the standard, and the rests to hold the

blocks, as well as the ribs, which constitute the combination of the second claim, were not only found in prior devices, but they separately, and in combination with such devices, performed the same function, and operated in substantially the same way, as in the Hall patent. *The combination of old elements which perform no new results, does not involve patentable novelty.*" (Citing numerous cases.)

Knapp et al v. Morss, 150 U. S. 228, Sixth paragraph from end of opinion, Page 84 of Vol. 14, Natl. Rep. System.

ADAPTING MACHINE TO NEW USE

The Morgan patent, defendant's Exhibit BB, describes a pulley block which could be used in logging operations without any change in construction, but if it should be considered that it would make it a more practical block to cast in one integral piece the side containing the oil reservoir such a change would not amount to invention, as it does not involve the inventive faculty to adapt a machine to a particular use.

In the case of Dilg et al v. Borgfeldt & Co., 189 Fed. 588, the court had under consideration the patentability of a cutlery polishing machine. On page 590 of the reported case is found the following language:

"Examining the prior art, we find that the field was quite crowded when the patentees came into it. Earlier patents disclose cutlery polishing and grinding devices having mechanism for moving one polishing or grind-

ing wheel toward the other; and, although all the elements of the claim may not be found in any one patent, it is clear that they are to be found in different patents. No single patent may anticipate, but they all have a bearing upon the question whether invention or mechanical skill was involved or required."

In referring to the change from a grinding machine to a polishing machine made by the claimants in lowering an operating shaft so that it would be out of the way of the tools, the court uses the following language beginning near the bottom of page 590:

"But in using the machine for polishing, the knife would necessarily be lowered between the bumping rolls and the drive-shaft might be in the way. In our opinion, especially in view of the prior patent, it required no more than mechanical skill to obviate the difficulty by locating the driving-shaft below the plane of the wheel-shaft and thus putting it out of the way.

"While we have no doubt that the complainant's machine has been commercially successful, we are by no means satisfied that there was a period of groping and that the complainant succeeded where others failed. Even if such were the case it would not be sufficient to show invention here.

"We also recognize the complainant's contention that although every element of the combination may be old, yet the combination itself may be patentable. But a combination is not patentable unless it shows invention, and in view of the cutlery grinding and polishing machines of the prior art, we find no invention in the present case."

**THAT WHICH WOULD INFRINGE IF LATER,
ANTICIPATES IF EARLIER.**

“There is another test as to the validity of the second claim: If Balch, Everett, Wilson or Ferris patents, or even the umbrella, were subsequent in date to that of the Hall patent, they would constitute infringement thereof, for the rule is well settled that ‘that which infringes if later would anticipate if earlier.’” (Citing *Peters v. Mfg. Co.*, 129 U. S. 530, 537; *Heating Co. v. Burdis*, 121 U. S. 286, 295; *Grant v. Walter*, 148 U. S. 554; *Gordon v. Warder*, 150 U. S. 47.)

Knapp et al v. Morss, 150 U. S. 228.

In the foregoing case the court had under consideration improvements “in dress forms in which the rods are connected near their top and bottom extremities to braces or stretchers, which extend obliquely from the ribs to the standard and are there concentrated, and hinged on small movable collars which encircle the standard.” By changing the position of the movable collars the form would be expanded or contracted to the desired position in a manner similar to that in which an umbrella is opened or closed.

If the Supreme Court of the United States considered an umbrella as an anticipation to an invention for a dress form, it certainly must be conceded that any of the pulley blocks or patents for pulley blocks which have been referred to by the defendant in this case should be considered as a part of the prior art. If there

be no novelty in the expansion means of a dress form by reasons of the umbrella, there certainly would be no novelty, and it would not involve invention, to select the integral side of the Ludford pulley block and adapt it for use on the Morgan block.

EQUIVALENCY OF DEVICES.

By applying the rule "The Claim Measures the Invention," the Morgan block, defendant's Exhibit BB, is a letter-perfect anticipation of Claim 1 of complainant's patent No. 977,613. Each of the other claims in issue in this case are likewise anticipated by both patents and devices of the prior art. But even if the complainant should not be limited to the language of his claims and should be permitted the broadest construction which could be placed upon the article as actually manufactured, he would still encounter the rule of law concerning equivalents, which would destroy the validity of his patents, for in the patent law the equivalent of an element or device is the same as the thing itself, and that which would infringe if later anticipates if earlier.

In the case of *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 120, the court had under consideration the question of the infringement of a patent for a paper bag machine. In one of the machines the paper was cut by a knife having five planes so arranged as to automatically rise and fall upon the paper, cutting the same; while in the other machine a knife with a serrated edge was attached to the bed of the

machine on line with the feed rolls, so that the paper would pass over it freely, and the paper was cut by means of a straight piece of metal made to revolve with a shaft in such a way as to strike the paper and throw it sharply down on the serrated knife, whereby the paper would be severed as effectually as by the cutter of the other machine. On page 125 of the reported case is found the following language:

“Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that *one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same results, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.*

“Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, *as it is necessary in every such investigation to look at the mode of operation or the way that the device works* and at the result, as well as at the means by which the result is attained.

"Inquiries of this kind are found attended with difficulties; but if such attention is given to such portions of a given device as really does the work, so as not to give undue importance to other parts of the same which are only used as a convenient mode of constructing the entire device, the difficulty attending the investigation will be greatly diminished, if not entirely overcome."

"(3) Upon careful consideration of the prior art and giving due weight to well established utility of plaintiff's device and its highly favorable commercial reception, we are unable to find in it room for invention. The most which, to our minds, can be said is that the inventor has, in the exercise of a high degree of mechanical skill, selected and put together the most desirable parts of different devices in the same art, making a new structure, doubtless better than any which preceded it, but in which each part operates in substantially the same way as it did in the old and effects substantially the same result. 'This is not invention.' (Citing cases.)

Edwards v. Dayton Mfg. Co., 257 Fed. 980, 983.

"A patentable invention is a mental result. It must be new and shown to be of practical utility. Everything within the domain of the conception belongs to him who conceived it. The machine, process, or product is but its material reflex and embodiment. A new idea may be ingrafted upon an old invention, be distinct from the conception which preceded it, and be an improvement. In such case it is patentable. The prior patentee cannot use it without the consent of the im-

prover, and the latter cannot use the original invention without the consent of the former. But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use. In neither case can there be an invasion of such domain and an appropriation of anything found there. In one case everything belongs to the prior patentee, in the other, to the public at large."

Smith v. Nichols, 21 Wall. 112, 118.

NOT A NEW MACHINE.

The Century Dictionary 1889, defines the word "pulley" to mean:

"(1a) Properly, a simple machine consisting of a wheel having a grooved rim for carrying a rope or other line, and turning in a frame which, when movable, is termed a *pulley-block*."

The foregoing definition serves to establish the meaning of the term "pulley-block" as early as the year 1889, although the thing and its name are both of ancient origin.

It might, therefore, be accepted to establish the fact that a pulley-block is a machine; but the patent law makes distinction between a "machine" and an "improvement thereof."

In the eye of the patent law, a machine "is an artificial organism, governed by a permanent artificial rule of action." (Robinson on Patents, Vol. 1, Sec. 173.)

"The unity of a machine also resides in the same rule of action. Whether composed of a single organism or of several subordinate organisms, as a machine it is a unit, and is destroyed whenever any change, addition, or withdrawal of its elements results in the alteration of its structural law. While this law remains undisturbed, any such change, addition or subtraction is at the most an improvement on the old machine, however marked may be the effect produced upon its shape or usefulness." (Ib. Sec. 179.)

"Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way that the device works and at the result, as well as at the means by which the result is attained."

Union Paper Bag Machine Co. v. Murphy, 97
U. S. 120, 24 L. Ed. 936.

The mode of operation of the pulley block described in the Gilchrist patent is exactly the same as the mode of operation of the Morgan pulley block. The result accomplished by the operation thereof is the same in all pulley blocks, namely: that of carrying and guiding a rope or cable.

The result being the same and the mode of opera-

tion of the pulley blocks described in the Gilchrist patents being the same as the mode of operation in the Morgan pulley block and other auto-lubricating pulley blocks, the machine cannot be a new machine, no matter how great an improvement or advancement may have been made in the construction of the same.

The patentee has claimed a new machine, but in view of the prior art he has not described a new machine and his claims are therefore defective, if not absolutely void. (R. S. Sec. 4888.)

If a patentee applies for a patent upon an improvement in an existing machine, he must distinguish the new from the old, and confine his patent to such parts only as are new, for if both are mixed up together and a patent is taken for the whole, it is void.

Lowell v. Lewis, Fed. Case 8568;

Sullivan v. Redfield, Fed. Case 13597;

Blake v. Sperry, Fed. Case 1503;

Brooks v. Jenkins, Fed. Case 1953;

Hovey v. Stephens, Fed. Case 6746;

Stanley, etc. Co. v. Davis, 22 Fed. Case 1054.

In the case of *Evans v. Eaton*, 7 Wheat. 356, 5 L. Ed. 472, the plaintiff brought an action for an infringement of a patent alleged to be: First, for the whole of the machine employed in the manufacture of flour, called the hopper-boy. Second, for an improvement on the hopper-boy. The defendant alleged

that the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent of the hopper-boy as patented, and that his patent for an improvement was bad because the nature and extent of the improvement was not stated in his specifications, and if it had been, still the patent comprehends the whole machine, and is therefore too broad. The lower court interpreted the law as requiring the patentee to specifically point out his improvements if the patent was not for a new machine embodying a new mode of operation.

Beginning on page 434 (491), Justice Story, in delivering the opinion of the court, uses the following language:

“Nothing can be more direct than the very words of the act. The specification must describe the invention in ‘such full, clear and distinct terms as to distinguish the same from all other makes before known.’ How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends, which describes the machine fully and accurately as a whole, mixing up the new and the old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own. It seems to us perfectly clear such a specification is indispensable. We do not say that the party is bound to describe the old machine, but we are of the opinion that he ought to describe what his own improvement is, and to limit his patent to such im-

provement. But the law is sufficiently complied with in relation to the other points by distinguishing in full, clear and exact terms the nature and extent of his improvement only.

"We do not consider that the opinion of the Circuit Court differs, in any material respect from this exposition of the patent act on this point; and if the plaintiff's patent is to be considered as a patent for an improvement upon existing hopper-boy it is defective in not specifying that improvement, and therefore the plaintiff ought not to recover."

In the case of *Jacobs Mfg. Co. v. T. R. Almond Mfg. Co.*, 177 Fed. 935, the court had under consideration the claim for a patent upon a drill chuck which had proved itself of considerable utility and was earnestly sought upon the market. On page 936 the court uses the following language:

"The specification does not indicate how much is new or what is the improvement on the old art. The claims would indicate that the entire device was the product of Jacobs. It is fairly obnoxious to the criticism expressed of a similar obscure and misleading patent in *Evans v. Eaton*, 7 Wheat. 356, 5 L. Ed. 472. But passing that technical objection we have the question: Is it invention entitling a person to the monopoly of a patent to add teeth and a key with cogs to effect motion to the operating sleeve of a drill-chuck when such device for imparting motion is well known in many arts, and in this very art had been applied to move the operating parts of chucks

of another type (as in Whiton and Washburn)? We are clearly of the opinion that it is not and do not find the circumstance that the improvement has had large sales persuasive to the contrary. The toothed key is, no doubt, bought because it is more useful and convenient than the fingers or a spanner; but utility alone is not enough to establish invention."

In the case of *Wheeler v. James*, 189 Fed. 898, the court had under consideration a claim to a carburetor wherein the patentee had not properly described his invention. On page 901 the court uses the following language:

"If he had claimed a combination of old parts in such a way that a new method was involved, then he might claim the method as a result of the use of those or any equivalent parts. But Schebler does not seek to do this. He has tried to claim as invention the general idea of a carbureter of any type (although his type was plainly taught in his earlier patent) with the ideas presented by Krebs and Pidgeon (to say nothing of Dawson and Krastin), and to protect this wide basic proposition by adding interchangeability. Did he thereby get a valid patent even for the idea of interchangeability? It seems impossible to so hold. The details of the drawings and specifications are not even alleged to be invented by him. He has stated them as premises, and they might have been invented by anyone. He then claims, not these parts or their method of use or their combination, but, on the other

hand, general ideas which were unpatentable, and claims which would be infringed by many devices patented long before. Apparently such claims should have been refused by the patent office. He should have been compelled to state what he described, and what he really seems to have invented and intended. He cannot now be heard to say that his broad claims are really limited and explained by the drawings and specifications which are not by reference or description made a part thereof."

Again on page 902:

"The scope of a claim is set forth in *White v. Dunbar*, 119 U. S. 51, 7 Sup. Ct. 72, 30 L. Ed. 303, in which it is held that the context—i. e., the specifications—'may be resorted to for better understanding the meaning of the claim, but not for the purpose of changing it and making it different from what it is.' This patent is not like those in *McCarty v. Railroad Co.*, 160 U. S. 110, 16 Sup. Ct. 240, 40 L. Ed. 358, or *U. S. Repair and Guaranty Co. v. Assyrian Asphalt Co.*, 183 U. S. 591, where the claims were narrower than the specifications, and an attempt was made to show that the patentee had really invented everything covered by the specifications. In these cases the court held that infringement of the claims could not be found because of infringement of the ideas which they had been intended to cover. The case of *Evans v. Eaton*, 7 Wheat. 356, 5 L. Ed. 472, is more nearly in point. As, also, *Consolidated Bunting Apparatus Co. v. Metropolitan Brewing Co.*, 60

Fed. 93; *Excelsior Needle Co. v. Morse-Keefer Cycle-Supply Co.*, 101 Fed. 448, 41 C. C. A. 448, and *Edison v. American Mutoscope Co.*, 114 Fed. 926. In these cases it was held that a patentee could not after using broad claims show that a narrower construction was meant or could be surmised from the specifications, nor could the court work out the real invention so as to define the inventor's meaning as he should have stated it. See, also, Walker on Patents, p. 170, par. 181, and 2 Robinson on Patents, pp. 139, 140.

"A reissue would seem to be necessary before Schebler can prove infringement of any valid claim, and, as the case stands, the defendants should have decrees."

In the case of *Idorne v. Winkle*, Fed. Case 10,432, Vol. 18, Fed. Cases, page 581, Judge Story, in charging the jury as to the law of the case concerning the distinction between a patent for a machine and an improvement of a machine, used the following language:

"The original inventor of a machine is exclusively entitled to a patent for it. If another person invent an improvement on such machine, he can entitle himself to a patent for such improvement only, and does not thereby acquire a right to patent and use the original machine; and if he does procure a patent for the whole of such a machine with the improvement, and not for the improvement only, his patent is too broad, and therefore void * * * *"

To illustrate these positions, suppose a watch was first invented by a person, so as to mark the hours only, and another person added the work to mark the minutes, and a third the seconds; each of them using the same combinations and mode of operation to mark the hours as the first. In such a case the inventor of the second hand could not have entitled himself to a patent improving the invention of the others. Each inventor would undoubtedly be entitled to his own invention and no more. In the machines before the court there are three great stages in the operation, each producing a given and distinct effect; first the cutting of the wire for the nail; second the gripping of the nail; third the heading of the nail. If one person had invented the cutting, a second the gripping and a third the heading, it is clear that neither could entitle himself to a patent for the whole of the machine, which improved the invention of the other two, and by the same mode of operation produced the same effect, and, if he did, his patent would be void. (Page 582).

WHAT IS A NEW RESULT.

A new result within the meaning of the patent law in referring to a combination patent made up by the bringing together of old elements requires that there must be some change of function by the co-action of these elements, by which some of the elements perform some function which they have never performed before in the prior art. This rule is well laid down in the last paragraph of the opinion in the case of *Wright v.*

Yuengling, 155 U. S. 47, 39 L. Ed. 64, which reads as follows:

“Wright’s only invention, then, was in the combination of the cylindrical guide with the trough shown in the Farrar patent. Did this accomplish a new and valuable result it is quite possible that a patent therefore might have been sustained, but we do not find this to be the case. The cylindrical guide performs the same functions as in the prior patents; the trough, in which the connecting rod works in the Farrar patent, is practically the same as in the Wright patent; and the combination is a mere aggregation of their respective functions. If the combination of the trough and cylindrical guide of the Wright patent gives greater lightness and strength to the frame than the combination of the trough and the flat guides of the Farrar patent, it is a mere difference in degree, a carrying forward of an old idea, a result, perhaps, somewhat more perfect than had theretofore been attained, but not rising to the dignity of invention. We have repeatedly held patents of this description to be invalid.”

(For other cases see Points and Authorities under heading “A New Unitary Result.”)

What constitutes a new result within the meaning of the patent law is well illustrated by the case of *Thatcher Heating Co. v. Burtis*, 121 U. S. 293, 30 L. Ed. 942.

In this case the court had under consideration a combination patent for an improvement of a fireplace heater. The case is so similar in several of its features

to the one now under consideration by the Court that I feel the following quotation therefrom may be of interest to the Court:

"I have so combined three elements or features as to produce an important result. These features are as follows: First, a cylinder or body of the heater projecting outward from the frame or mantel; second, a feeder or fuel magazine within the cylinder; and, thirdly, an opening through which the said magazine can be fed from above. While fireplace stoves or heaters with protuberant cylinders and feeders or magazines were known prior to the date of my invention, I am not aware that the above combination of three features above referred to—namely, a top-feeding arrangement, a protuberant cylinder permitting such an arrangement, and a magazine within the cylinder—has ever been known or used prior to my invention of the same. It has been the practice to so construct base-burning fireplace stoves or heaters that the fuel had to be introduced into the feeder or magazine through a doorway in front; hence the magazine was of a very limited capacity. By so arranging the feed-hole, however, that the fuel can be introduced into the magazine from above, the capacity of the magazine is increased—a result which I especially aimed at in adopting the first part of my invention, namely, the above-mentioned combination, and in the production of my top-feeding, base-burning fireplace stove. The second part of my invention consists in extending the feeder or magazine to the feed-hole of fireplace stoves. This not only increases the capacity of the magazine to some extent,

but an uninterrupted passage or guide is afforded for the introduction of fuel into the magazine through the opening in the outer casing. The capacity of the magazine is still further increased, in the present instance, by carrying the feeder up above the top of the heater, by placing thereon a movable section, o, furnished with a cover, O¹, which has to be lifted off when coal has to be introduced into the magazine.

“The first and second claims, which are alone involved in this controversy, are as follows: ‘(1) A base-burning, fireplace stove, in which are combined the following elements, namely, a cylinder or body projecting outward from the mantel or frame, a fuel magazine or feeder within the cylinder, and an opening through which the said magazine can be fed from above. (2) A fireplace stove or heater, in which the magazine is extended to the feed-opening of the outer casing.’

“The case turned in the circuit court on the question of the validity of the patent on the ground of want of novelty in the invention in view of the state of the art at its date. In passing upon this question on final hearing, Judge Wallace, in his opinion, stated the grounds of his decree dismissing the bill, as follows: ‘It is conceded that these claims are to be construed broadly, so as to cover the combination of a fireplace heater having a body projecting outwards from the mantel or frame, and a furnace-like portion in the chimney behind the mantel with a fuel receptacle within the cylinder of the heater, which will preserve a supply of unignited coal while the heater is in operation,

and an opening through which the magazine can be fed from above, the magazine extending to this opening. Inasmuch as the heater was old, and the fuel receptacle with the described opening was old when located within an ordinary coal stove, what Thatcher accomplished was merely the advantageous location of the fuel receptacle within the fireplace heater. As the complainant's expert, Mr. Brevoort, states: 'The problem Thatcher had before him was to place the fuel magazine within the Bibb & Auger heater.' It must be conceded that it was not obvious that such a fuel magazine could be advantageously employed in such a heater. Attempts had been made by others to do the same thing without satisfactory result, but Thatcher's organization was a success, and immediately commended itself to the public. But Thatcher's broad claims cannot be sustained. There may have been patentable novelty in the means he employed to adjust the parts in the new organization, but there was none in merely bringing those parts together. They did not perform any new function in the new arrangement. The fuel magazine does just the same work in the new structure it did in the ordinary coal stove. All the other parts of the fireplace heater operate precisely as they would if the ordinary fuel-pot were used instead of the substituted magazine. The parts do not cooperate to produce any result. By their aggregation the new structure contains all the advantages which resided before separately in several structures.' "

It is interesting to note the similarity of the contention of the patentee in the foregoing case with that

urged by counsel for complainant in this case to sustain their theory that the Gilchrist combination produces a new result. The likeness is so striking that there is herewith quoted the following extract:

"Third, that the parts of the combination stated in the claims did not constitute a mere aggregation, but co-operated to produce a new result. This new result, it is claimed, consisted in securing in fireplace heaters a uniform and steady heat, that could be regulated for their own purposes by the occupants of the upper rooms heated by means of furnace registers, at the same time furnishing heat for the room in which it was situated by means of a heater that did not require frequent attention. The result of the contention on these points, as claimed, is that the fireplace heater of the patent, containing a magazine extending to the outer casing of the heater, capable of holding a supply of unignited coal, and feeding the same to the fire, was patentable as a new article of manufacture.

"Mr. Brevoort, the principal expert on behalf of the appellants, states the case on their part in his testimony as follows: 'The problem which Thatcher had before him was to place the magazine of his patent within the Bibb & Auger fireplace heater, or, rather, his invention may be said to have consisted in the conception of the idea of taking out the fuel chamber or pot of the Bibb & Auger device, and substituting therefor a magazine of the kind shown in the Thatcher patent; the execution of which conception, if successful, had for its object to confer upon

the fireplace heater the regularity and steadiness of action which alone could be secured by the use of a magazine standing ready always to automatically feed the fire whenever it may become necessary. Now, it was not at all an obvious thing that this large mass of unignited coal could be put within the comparatively limited compass necessary for the ordinary fireplace heater in place of the incandescent coal contained in the pot or fuel chamber of the Bibb & Auger heater, and still leave a heater which would be successful. Indeed, one of the defendants' witnesses in this case placed a magazine in a fireplace heater, tried it, and abandoned it as useless and as a positive injury, rather than, as future experiments have shown, a great benefit to the structure. Another witness seems to have introduced a magazine into one of his fireplace heaters at about the date of Thatcher's patent. This witness says that he did not think it was important, but says that, had he known anything of its importance, he would have got a patent for it. These two witnesses clearly show that the putting of a magazine into a fireplace heater was not obviously a good method of improving the old Bibb & Auger heater, and that even after a magazine had been introduced, that its utility was not manifest without experiment and careful trial, and this testimony is given by men who apparently were thoroughly skilled in the art, and had had much and long experience in the fireplace heater business. A consideration of the old Nott structure, if it ever existed, as testified to, would have deterred rather than encouraged any one from introducing such a fuel

receptacle as was there shown into a fireplace heater which was required to heat rooms above and below simultaneously. For the reasons above given, I think that it required invention to introduce a magazine extending to the top or outer casing of the stove into a fireplace heater, having a protuberant front for heating the room in which the heater stood, and a furnace-like back for heating the air for the rooms above. Most assuredly, the parts referred to in the first and second claims of the Thatcher patent coact, when in action, in the production of the result desired. The protuberant body heats the lower room. The mantel or frame separates one portion of the heater from the other, so that the protuberant body may perform its function while the furnace-like back may perform its function. The fuel magazine holds the fuel in readiness to supply the fire which is to heat both back and front alike with steadiness and uniformity, the magazine being fed through a hole in the outer casing directly, thus obviating the opening of any doors into the combustion chamber when the fire is to be fed, and the consequent cooling off of the heater by admitting fresh air into the device above the grate. By the bringing together of these parts and their joint action, one with the other, a fireplace heater is formed having advantages over any heater that went before, and which form of heater has gone so extensively and largely into use that it has practically superseded all other forms, as I am informed.' ”

The court then went on to say that the foregoing statement would need to be considered in connection with the well established and admitted facts in respect to the prior art, and after referring to the fact that the fuel magazine when thus transferred was still a fuel magazine, the same as in a stove, performing the same function, the court then used the following language:

"It is true that such a fireplace heater, by reason of the fuel magazine, was a better heater than before, just as the outstanding stove, with its similar fuel magazine, was a better heater than a similar stove without such a fuel magazine. But the improvement in the fireplace heater was the result merely of the single change produced by the introduction of the fuel magazine, but one element in the combination. The new and improved result in the utility of a fireplace heater cannot be said to be due to anything in the combination of the elements which compose it, in any other sense than that it arises from bringing together old and well-known separate elements, which, when thus brought together, operate separately, each in its own old way. *There is no specific quality of the result which cannot be definitely assigned to the independent action of a single element. There is therefore no patentable novelty in the aggregation of the several elements, considered in itself.*

* * * *

The case of *Palmer v. Village of Corning*, 156 U. S. 381, goes into the question as to what consti-

tutes a new and useful result within the meaning of the patent law.

In this case the court had under consideration a combination claim for a grating or covering to a sewer inlet consisting of a grate elevated above the catch basin of a sewer and resting upon a ring or support placed below the top of the basin by means of pins which thus lift up the grating, between which pins spaces were left to allow the water to pass through under the grating. The new result claimed for this combination and of so elevating the grate being, it was claimed, to keep the openings free from debris which would otherwise accumulate on or against it by reason of the leaves and small twigs passing through the spaces beneath the grating; but the court declared the same not to be a patentable combination and referred to the same in the following language:

"The mere use of a ring of iron on which to rest such a grating is obviously nothing more than a mechanical arrangement, which involves no element of invention; and the same is the case with the use of pins or legs for the purpose of holding up a sewer grate. And it is equally clear that the leaving of open spaces between the pins and the elevating of the grate above the ring, thereby giving greater facility for the flow of water, is invention in no sense of the word. But, although no one of these elements of the contrivance involves invention, it is insisted that, taken all together, they constitute a 'combination,' and that it is this combination which is covered by the letters patent. If a combination of unpatentable elements, as

such, produces new and useful results, there can be no doubt that the combination is patentable. But there are certain conditions constituting the essential nature of a combination under the patent law, which we think are not met in this case."

The court then quotes with approval from *Hailes v. Van Wormer*, 20 Wall. 353; *Reckendorfer v. Faber*, 92 U. S. 347; *Pickering v. McCullough*, 104 U. S. 310; *Heating Co. v. Burtis*, 121 U. S. 286, 7 Sup. Ct. 1034.

The case is a very instructive one, in that it selects appropriate language from each of the cases therein referred to. The issues in many of these cases bear a striking resemblance to those which the Court now has under consideration.

* * * *

"(3) It is insisted by complainant that a new combination of old things may be patentable, and in support thereof cites the cases of *Loom Co. v. Higgins*, 105 U. S. 580, 26 L. Ed. 1177; *Seymour v. Osbourne*, 11 Wall. 516, 20 L. Ed. 33; 'The Barb Wire Fence Patent,' 143 U. S. 275, 12 Sup. Ct. 443, 36 L. Ed. 154; *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *Hobbs v. Beach*, 180 U. S. 383, 21 Sup. Ct. 409, 45 L. Ed. 586; *National Hollow Brake-Beam v. Interchangeable Brake Beam*, 106 Fed. 693, 45 C. C. A. 544.

"This rule is well-established, but in the case upon which it relies the combination is new, and the result

of the combination of the old elements is also new. In the case at bar there is no co-operation between the elements; the throats having their sides meeting at an angle. A protected point is disclosed in Hazelton's patents, and is therefore not new. Wedge-shaped throats are disclosed in the Hazelton patent, No. 253,554, and the Scott patent, No. 125,338, is also old. There being no co-operation between these functions, we have the result that each must act in the old way; the joint product being the aggregation of the old result, which, under the rule, is not patentable."

National Machine Corporation v. Benthall Machine Co., 241 Fed. 72, 78.

* * * *

"The effect of this use of old devices in the construction of the McNeal split wood pulley was to strengthen it, and thus add to its durability; but it did not produce a new result or effect."

Dodge Mfg. Co. v. Collins, et al, 106 Fed. 935, 938.

* * * *

"Each element of the claim in suit was old in this very art, and had been used to perform the same function assigned to it in Johnson's present device. This ruffler introduces no new mode of operation, produces ruffles no better and no faster, and does not afford the user (though it may to the manufac-

turer) and advantages over others. The novelty consisted in selecting and rearranging old elements to produce a machine new in form, but old in function, and therefore an old machine."

"'It is not invention to combine old devices into a new article without producing any new mode of operation.'"

Cheapness of the article was urged.

"But the patent is for improvements in a machine which is a combination of mechanical elements adapted to receive and apply motion to the production of a mechanical result, and the patent would as certainly be infringed by a ruffler of which the parts were forged or cast or machined as by one made of stampings. The consideration of cheapness therefore lies in the process, and not in the product."

Griest Mfg. Co. v. Parsons, 125 Fed. 116, 119.

PRIOR ART DEFINED.

"(3) What is prior art is a matter that cannot be determined arbitrarily, nor merely by a restriction of the claim to a special use.

"If the thing is old, and is applied to perform its old functions, it remains in the prior art, and cannot be made novel, in the sense of the patent law, merely because used in new surroundings that do not affect its character or mode of operation."

Robinson v. Tubular Woven Fabric Co., 248 Fed. 526, 542.

In the case of *Knapp et al v. Morss*, 150 U. S. 288, the umbrella was considered as a part of the prior art and operated to defeat the validity of a patent issued for a dress form in which rods or ribs were connected near the top and bottom extremities to braces or stretchers which extended obliquely from the ribs to the standard and were there concentrated and hinged on small movable collars which encircled the standard, by the raising or lowering of which the form would be caused to expand or contract.

In construing and passing upon the question of the validity of patent claims, the courts have always held that the question of invention would depend upon the state of the art at the time of the alleged invention. A review of the quotations and authorities found under the headings,

“Aggregation is not Invention”

“Combined Results may be Aggregation”

“Selected Elements”

“All of the Elements need not be Found in a Single Article”

“Borrowing Elements from Another Art”

“A New Unitary Result” and

“What Constitutes a New Result”

will make it clear that the “state of the prior art” means the state of the art as to each of the elements of a combination claim both separately and in all combinations in which they may be found, and does not mean that the court should consider only similari-

ties of unitary devices embodying the complete combination.

All prior patents are a part of the prior art.

In order to obtain a valid patent, the patentee must come within the terms of Section 4886, U. S. Revised Statutes, which reads as follows:

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.”

There can be no foundation for a patent beyond the limitations of the foregoing statute. By application of this statute and the rules of law set forth in the cases under the headings heretofore referred to, all of the patents, publications and pulley block exhibits introduced by the defendant become a part of the prior art and completely destroy the validity of the claims of the patents sued upon.

INVENTIVE QUALITY WOULD NOT SAVE GILCHRIST
PATENT:

As has been indicated under the preceding title, the complainant, Gilchrist, is conclusively presumed to have had knowledge of all that the prior state of art would disclose.

It is undoubtedly true that many a patentee has exercised the inventive faculty and is entitled to credit as a true inventor, and still may have no right to a patent for what he has created.

Unfortunately, the complainant in this case did not go upon the witness stand and the defendant was deprived of the opportunity of examining him for the purpose of determining whether or not he ever exercised the faculties of the true inventor, or had merely appropriated the ideas of another; but it makes little difference which may be the true state of facts, as in either case, he would not be the first inventor and would therefore have no right to a patent.

The law on this subject is well set forth by the court in the case of *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216. In the third paragraph from the end of the decision, we find the following language:

"All that he claims as invention is found in one or more of the prior patents. * * *

"In view of the fact that Mr. Orum had no actual knowledge of the Gory patent, he may rightfully claim the quality of invention in the conception of his own device; but as he is deemed, in a legal point

of view, to have had this and all other prior patents before him, his title to invention rests upon modifications of these too trivial to be the subject of serious consideration. His 'radically new idea of making the mortise as deep as the width of the projecting selvedge, and of cutting out the selvedge at its ends,' as claimed by his counsel, was such as would have occurred at once to an ordinarily intelligent mechanic, who had the previous devices before him. * * * * "

At the time Gilchrist conceived the idea of making his auto-lubricating block, cast sides had been made in all shapes and designs and had become popular with the public. It certainly would not have required the exercise of the inventive faculty to have changed the Morgan block side to a side cast in one integral piece, even though a block side with interior oil chamber cast in one side had not previously been known. But for the purpose of this case Gilchrist is conclusively presumed to have had before him not only the Morgan block, but also the Ludford, Butters, Gilley, and Labadie blocks, as well as all others of the prior art.

DEDICATION TO AND RIGHTS OF THE PUBLIC.

It has heretofore been pointed out that the claims measure the invention and cannot be enlarged by the specifications and that each element of a claim is considered as an essential part thereof. It is also well established that all claims must be construed in view of the prior state of the art.

With these well established rules in mind it becomes interesting to examine the claims of the Gilchrist patents with the view of trying to find something in them upon which a valid patent could be based.

In making this examination the following rules should be constantly kept in mind:

“While the patentee may have been unfortunate in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, we are not at liberty, without running counter to the entire current of authority in this court, to construe such claims to include more than the language fairly imports. Nothing is better settled in the law of patents than that the patentee may claim the whole, or only a part of his invention, and that if he only describes and claims a part, he is presumed to have abandoned the residue to the public. The object of the patent law in requiring the patentee to ‘particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery,’ is not only to secure to him all to which he is entitled, but to appraise the public of what is still open to them. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it.”

McClain v. Ortmeier, 141 U. S. 419, 423.

* * * *

“Now, while this semi-circular connecting piece may be an immaterial feature of the Wright Inven-

tion and the purpose for which it is employed accomplished, though less perfectly, by the extension of the guiding cylinder in the manner indicated in defendant's device, yet the patentee, having described it in the specification and declared it to be a special feature of his invention and having made it an element of these two claims, is not now at liberty to say that it is immaterial or that a device which dispenses with it is an infringement, though it accomplishes the same purpose in perhaps an equally effective manner."

Wright v. Yuengling, 155 U. S. 47, 52; 39 Law. Ed. 64.

Inasmuch as all which has not been claimed is dedicated to the public, there are hereinafter set forth several claims which could have been drawn upon the device described, had the complainant been the first inventor of a pulley block.

None of the claims hereinafter set forth embody the same combination which is set forth in any of the claims of the Gilchrist patent, and they could have been valid claims had he been the first inventor of a pulley block. Numerous other claims could also have been made, had the complainant Gilchrist been the first inventor of a pulley block.

An examination of the claims hereinafter set forth, all of which must be considered as dedicated to the public, shows to what narrow limits the complainant's patent would have been confined without any consideration whatever of the prior state of the art. When the prior state of the art is also taken into

consideration, it will be found that there was no task left for the complainant to solve, and, by reason thereof, that his claims cannot be the basis of a valid patent.

CLAIM A.

A pulley block consisting of the combination of sides, a bearing-pin terminally mounted therein, and a sheave journaled on the pin.

The above claim defines the combination of three elements essential to every pulley block which any tyro in the art knows to be old, and which the rule of law confirms to be old.

CLAIM B.

A pulley block consisting of the combination of sides, a bearing pin terminally mounted therein, and a sheave journaled between the sides on the pin.

CLAIM C.

A pulley block consisting of the combination with sides, a bearing pin terminally mounted therein, and a sheave journaled on the pin between the sides, of an oil chamber communicating with the bearings for the sheave upon the pin.

CLAIM D.

A pulley block consisting of the combination with sides, a bearing pin terminally mounted therein, and a sheave journaled on the pin between the sides, of an interior oil chamber in one of the sides communicating with the bearings for the sheave upon the pin.

CLAIM E.

A pulley block consisting of the combination with sides, a bearing pin terminally mounted therein, and a sheave journaled on the pin between the sides, of an oil chamber communicating through an axial opening provided in the pin with the bearings for the sheave upon the pin.

CLAIM F.

A pulley block consisting of the combination with sides, a bearing pin terminally mounted therein, and a sheave journaled on the pin between the sides, of an oil chamber communicating through an axial opening provided in the pin with the bearing for the sheave upon the pin, said axial opening extending through the side wall of the pin.

CLAIM G.

A pulley block consisting of the combination with sides, a bearing pin terminally mounted therein, and a sheave journaled on the pin between the sides, of an interior oil chamber in one of the sides communicating with the bearings for the sheave upon the pin, having an inlet adjacent to the top of the block.

Claim 1 of patent No. 977,613 is merely an aggregation of the several limitations of above claims E, F and G into one enumeration, without any new result.

Add to the foregoing claims all the elements, combinations and modes of operation which are disclosed

by defendant's exhibits in this case and it will be found that the Gilchrist claims do not disclose a single new element, do not disclose any new combination of elements and do not disclose any new mode of operation. On the contrary, each of the elements of the Gilchrist claims can be found, both separately and in combinations, performing the same function which it performs in the Gilchrist claims.

SCOPE OF INVENTION NOT DEFINED.

As to patent No. 977,613, the complainant's claim to invention was finally narrowed down to the single conception of embodying in his device a block side containing an oil chamber cast in one integral piece. But this one idea cannot be found in either the language of the claims or the specifications. On the contrary, complainant has specifically stated that "it is the object of this invention to provide a pulley which will contain a considerable quantity of lubricant, and feed the same, automatically and slowly, upon the bearing of the pin" (Specification, page 1, lines 24-28), and, "another object of the invention is to provide a pulley, the bearing pin of which is adequately protected against dirt and dust" (Specifications, page 1, lines 33-35).

"Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from what its words express. The claim is a statutory requirement,

prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

White v. Dunbar, 119 U. S. 51.

Complainant's patent describes his invention as that of "a new Pulley-Block," which would be a new and useful machine, the newness of which, under the specification and claims, would consist in its being a pulley block or machine provided with a considerable quantity of lubricant which would feed automatically and slowly upon the bearing pin of the pulley and the bearing pin of which would be adequately protected against dirt and dust.

The evidence is overwhelming to show that he made no such invention. The conception of the broad idea of self-lubrication was old, and the conception of the broad idea of adequately protecting the bearing pin against dirt and dust was also old, and within the language above quoted, the patentee cannot now treat his claims as a nose of wax which may be turned and twisted in any direction by merely referring to the specification, or by changing it to what may now be found necessary in order to give it validity.

As is very well stated in the quotation hereinafter given, the rights of the public are involved:

"(7) The evidence in this case clearly shows that Benthall was persistent in his contention that in order

to properly stem peanuts it was necessary that the sides of the teeth should 'meet at an acute angle,' and there is nothing to indicate that it was his purpose to carry his claim beyond what he contended at the time. Where one seeks a patent by which he is to secure a monopoly of the use of the machine proposed to be patented, such applicant is required to describe specifically and with great care the nature of his invention. Otherwise the patent could be construed from time to time by enlarging its scope so as to meet any exigencies that might arise. One who seeks a patent must necessarily do so with the understanding that he is dealing with the public at large. In other words, he is entering a realm wherein the rights of the public are involved, and it is upon this theory that he is required to clearly define the scope of his invention."

National Machine Corporation v. Benthall Machine Co., 241 Fed. 82, 87.

The cases of *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, 30, L. Ed. 303; *Evans v. Eaton*, 7 Wheat. 365, 5 L. Ed. 472; *McClain v. Ortmyer*, 141 U. S. 419; *Imperial Cap & Machine Co. v. Crown Cork & Seal Co.*, 139 Fed. 312, and *Tate Manufacturing Co. v. Baltimore & Ohio Railroad Co.*, 229 Fed. 141, are reviewed in the above case.

Complainant has not disclosed any new mode of operation, therefore cannot be the inventor of a new machine. He has not made any claim to an improvement by making the side in an integral casting. He

cannot claim the broad principal of lubrication and protection of the bearing pin against dust, and has not pointed out wherein he has made any improvement over the prior art. Within the plain language of the statute R. S., Sec. 4888, and the rules of law as laid down in the foregoing cases complainant has not properly defined the scope of his patented invention and his claims must be declared invalid as he cannot call upon the court to reconstruct his claims for him.

ESTOPPEL BY LACHES.

In referring to the question of estoppel by laches, the Supreme Court of the United States in the case of *Gallagher v. Cadwell*, 145 U. S. 638, 36 L. Ed. 738, 740, uses the following language:

“The cases are many in which this defense has been invoked and considered. It is true, that by reason of their differences of fact no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in conditions or relations during this period of delay, it would be an injustice to the latter to permit him to now assert them.”

“The defense of laches is not tested by time alone. Lapse of time may be well explained; but, on the other hand, even a comparatively short time may constitute laches, when the conduct of the slothful is such as to induce others to expend money and take the risks of enterprise.”

A. R. Mosler & Co. v. Lurie, 200 Fed. Rep. 433.

The question of estoppel by laches is one which rests within the sound discretion of the court, and there are so many cases in which this question has been involved, each of which turns on its particular state of facts, that it would serve little purpose to cite these cases to the court.

However, the case of Vacuum Cleaner Co. v. Innovation Electric Co. Inc., 234 Fed. 942, has this question for consideration under circumstances which are so similar to the circumstances of the present case that I feel justified in calling this case to the Court's attention as a precedent or rule which might be applied here. Beginning with paragraph (3) on page 947 and continuing to page 949, it will be found that the circumstances were very similar to those which the Court now has to deal with.

In the foregoing case a letter was sent by the plaintiff November 1, 1910, notifying the defendant of its infringement of the patent. On November 12, 1910, defendant's attorney replied, stating in effect that he advised his client that it was not infringing any of the claims of the patent. On November 14,

plaintiff's counsel asked for detailed information. On November 17 the requested information was given. On May 26, 1911, plaintiff's counsel was written to again by counsel for defendant calling attention to the previous letters. In April, 1914, the president of the defendant company called upon the managing director of the plaintiff concerning threatening letters which plaintiff had sent to defendant's customers, and requested that he tell whether or not he considered that defendant infringed; he was answered by the manager that he would give the matter to their attorneys and have them write. On April 18, 1914, defendant received a letter from the plaintiff stating it would be some days before they could write the defendant anything definite on account of plaintiff's lawyers being busy in court. Nothing further was heard from the plaintiff until October 11, 1915, when defendant received a letter directing its attention to the infringement and stating that plaintiff would expect an accounting.

Throughout this period defendant was showing its machines at public exhibitions and was notoriously carrying on its business. For some reason plaintiff concluded not to sue defendant until after September 30, 1915. Under this state of facts, although the court found that the patent had been infringed, no accounting was allowed against the defendant.

In the matter now before the Court, there is the additional circumstance which was undisputed by any of complainant's witnesses, that the complainant had stated that he was going to wait until it was worth

while before he brought an infringement suit against the defendant. (R. 54, 65 to 70).

EXAMINATION AND REVIEW OF APPELLANT'S POINTS AND AUTHORITY.

On page 9 of appellant's brief it is stated that oral recollections cannot prevail against reasonable inferences from conduct, and in substantiation of this proposition there is cited the case of *Atlantic Works v. Brady*, 107 U. S. 192. Appellee will gladly accept the rules for construction as laid down in the case of *Atlantic Works v. Brady* and will be glad to have the court bear in mind the natural tendency which the patentee in this case has displayed, "*to watch the advancing wave of improvement and gather its foam in the form of patented monopolies,*" with the hope that he may thereby "*lay a heavy tax*" upon the logging supply industry of the Pacific Northwest. The fact that appellant desired to gather in some of this "foam" is clearly indicated from the testimony of Robert Gillespie to the effect that Gilchrist had not taken up with Mallory the alleged infringement of his patent, and intended to wait until Mallory had put out enough blocks to make it worth while to bring suit against him. (R. 54).

This testimony with the correspondence which passed between Gilchrist and Mallory (R. 65-70), taken in conjunction with the broad and unwarranted claims by which Gilchrist attempted to appropriate to himself not merely an improvement, but a pretended new pulley block, would make it entirely proper for the

Court to draw reasonable inferences of the patentee's attempt "to gather where he had not sown" and would justify the Court in adjudging the appellant as estopped from making any claim for damages or for an accounting even if it should find invention.

As to the question of design being important to appellee, I feel that it will be but necessary to call the Court's attention to the exhibits in this case to show that it apparently became very important to the appellant.

Appellant had nothing but a cumbersome, one sided block until after appellee came out with his sky line auto lubricating block in 1914 with the reservoir on each side and following the general design of his previous block, after which, as is shown by the exhibits in this case, appellant changed his original construction, did away with the reservoir covering the entire side of the block and adopted a design more in keeping with that put on the market by the appellee.

The statement quoted from the decision of Judge Blodget in the case of Manufacturing Company v. Rathbone, 26 Fed. 262, is a mere comment of the court as to what is a common thing and can in no way be considered as the judicial interpretation of any kind of a right. There is nothing in this case which in any particular throws any light upon the Gilchrist-Mallory case. There has been no subsequent judicial comment concerning this case other than

a mere reference to the case by the same Judge in an opinion rendered in an action against another defendant involving the infringement of the same patent, and reference to it.

In the case of *Covert v. Covert*, 106 Fed. 187, at page 183, in which last mentioned case the theory of the tendency of a person to belittle the device alleged to have been appropriated was not allowed to prevent the court from declaring the patent under consideration void by reason of public use more than two years prior to the application for the patent.

The quotation from the opinion of Justice Swayne in the case of *Rubber Co. v. Goodyear*, 9 Wall. 793, is likewise a mere statement concerning certain human tendencies which throws no light upon the present controversy. The statement should be considered in conjunction with quotations from Justice Bradley in the case of *Atlantic Works v. Brady*, 107 U. S. 192 and quoted on page of this brief.

The utility of the Gilchrist block is not denied and there is, therefore, no occasion of comment on the quotation from *Lucas v. Miller*, 2 R. P. C., 155-160.

The quotation from the opinion of Judge Buffington in the case of *Goss Printing Press Co. v. Scott*, 108 Fed. 253-258, is of little value in connection with the consideration of this case by reason of the fact that the question of utility has not been questioned. However, this case is of some value in pointing out the distinction between combination and aggregation.

As to one of patents under consideration, the Court used the following language, beginning near the bottom of page 259:

“Granted the change consisted in banking one press upon another, yet the two, when so combined, and in their new relation, so co-acted as to dispense with the angle-bars, with a web-deflected course, and made possible a straight-line duplex press. A single straight-line press in itself was no novelty, so far as the straight-line printing of an individual web is concerned; but, when the product of two such presses were united, it was only through angle-bar agency. Firm’s device, by placing the two in new relations, eliminated the angle-bar, did away with the tangent-turning webs, and thus secured valuable results. *The test in such cases is not whether duplication exists, but whether duplication produces, not mere duplication of product or function, but a new unitary, additional result, and not the mere aggregate of prior, separate mechanism.*

By applying this same test to the other patents under consideration in this particular case, the Court decided each of the other patents invalid because it found as to the other patents that while there were new mechanical modifications and changes and the bringing together of parts of the prior art in a different manner from which they had previously been brought together, there was no such co-action of parts in a unitary device as to sustain the validity of the patent.

The quotation from the decision of Judge Coxe in the case of *Auto Vacuum Freezer Co. v. Sexton Co.*, 239 Fed. 898-901, is inapplicable to the present controversy in that the Gilchrist device has not inaugurated any new industry and is in no sense a pioneer patent.

This case is cited in the case of *Homer Brooke Glass Co. v. Hartford Co.*, 262 Fed. 427, where at page 430, near the bottom of the page, the Court uses the following language:

"It is always necessary, even after granting the widest range of equivalents, to find as a matter of fact that what the defendant has done is the invention of the plaintiff 'substantially as described.' The range of decision, the limits imposed by law on the triers of the facts, are indicated by the word 'substantially'; an infringer may easily substantially imitate a big thing—i. e., a deeply rooted and widespread inventive thought; whereas, without 'Chinese copying,' imitation of a little thing is oftentimes difficult."

"(2) But, whether the invention is large or small, primary or trivial, it remains true that, when a claim is clear and distinct, the patentee cannot go beyond the words thereof for the purpose of establishing infringement; the specification may be referred to for the purpose of limiting, but not of expanding, a claim, and the range of equivalents is measured by what is described and claimed." (Citing several cases).

The attempt of the appellant on page 12 of this brief to have the Court believe that Hirshbuhl might be talking about a Gilchrist block side is wholly unwarranted in face of Hirshbuhls' positive testimony that he had never seen a Gilchrist block and thought they were designing the first oil reservoir block and that he had reference to block side 106, which was then in evidence in this case, being one of the Malory block sides, and in view of the further fact that the Gilchrist block as shown by exhibits did not have these ribs. (R. 95-96).

In the case of Victor Talking Machine Co. v. Cheney Talking Machine Co., 275 Fed. 444-447, quoted from at page 14 in appellants brief, both plaintiff and defendant consented to dismissal without prejudice and upon the express condition that the testimony taken up to the time of dismissal might thereafter be used by either party. Certainly the defendant in this case was charged with notice of the fact that plaintiff might thereafter prosecute his claim for infringement.

In the case of Columbia Graphophone Company v. Searchlight Horn Co., 236 Fed. 135, it was shown that the complainant was without funds to prosecute the infringement cases at an earlier date, and defendant's position was in no way changed. He had merely sold horns on commission which would yield him a just profit, even after paying a royalty thereon.

In the case of *Rajah Auto Supply Co. v. Belvidere Screw & Machine Co.*, 275 Fed. 761, appellant has quoted from page 764.

In this case plaintiff had prosecuted to success his patent infringement case against one including the defendant, of the decision and warning them against further infringement, to which the defendants answered that they had discontinued the manufacture of the article as previously agreed to by conversations. The matter was next taken up concerning the manufacture of another design of spark plug, which they claimed to be manufactured under another patent, after which a second warning letter was sent to them and they replied that they had discontinued the making of that article shortly after hearing from them. The only other evidence of estoppel or latches is that defendant's article, which it is now claimed infringes, was claimed to have gone in extensive use, but it was not clearly shown that the plug which they complained of was in extensive use or that the production covered such a period of time as urged and it was held that the defendant had failed to maintain his defense in this respect.

The case of *McLean v. Fleming*, 96 U. S. 245, was a trademark case, in which it was shown that the plaintiff had been selling pills under the name used and in boxes or packages of a distinctive label or wrapper for a period of forty-five years. The defendant put out pills under the same name, adopting labels and wrappers, resembling those of complainant. He was

notified to desist from so putting his goods upon the market, and while there was considerable delay after notice before complainant brought his suit, the court found as a matter of fact that the defendant was deliberately attempting to palm off his goods as the goods of the complainant and consequently granted an injunction against such use of name and labels. However, by reason of the delay in bringing suit after knowledge of the use of the name by the defendant, the court refused to allow the plaintiff an accounting. While this is a case which has been cited numerous times to the effect that an injunction might sometimes be granted, even when the facts are such as to cause the court to refuse an accounting, it certainly does not fit the facts as they exist in this controversy.

In the case of *Menendez v. Holt*, 128 U. S. 514, 32 L. Ed. 526 in the next to the last paragraph of the opinion after reciting that the right to injunction will not usually be lost by delay, although accounting may, the court uses the following language:

“At the same time, as it is in the exercise of discretionary jurisdiction that the doctrine of reasonable diligence is applied, and those who seek equity must do it, the court might hesitate as to the measure of relief, where the use, by others, for a long period, under assumed permission of the owner, had largely enhanced the reputation of a particular brand.”

Compare this statement of the court with the actions of Gilchrist in deliberately planning to allow the

defendant, Mallory, and other manufacturers to proceed with the manufacture and sale of the articles to such an extent as to make it worth while for him to bring an action for infringement and accounting, knowing that the defendant, Mallory, would be able to create a market for this particular device, which the complainant, Gilchirst, might not have been able to have created.

In the case of *Beattie Mfg. Co. v. Smith*, 275 Fed. 164, at page 172, the court merely goes to the extent of saying: "Mere latches, unaccompanied by circumstances which amount to an equitable estoppel, will not shut out a party from all relief in a court of equity."

The case of *Willard v. Union Tool Co.*, 253 Fed. 48, from which counsel has selected a quotation from page 53, pertains to the construction of a patent covering a combination of certain features of a boring device for holding the same in position for a designated purpose, in which device slips or wedges were removed from the opening to allow the substitution of the drive bushing or nut and were placed in position for the purpose of holding the pipe in a desired position. The removing or placing of these wedges or slips was performed by hand and when removed they were entirely separate from the machine and the court held that there was no true combination in that a combination in mechanism must consist of distinct mechanical parts having some relation to each other and each having some function in the organism.

The court held that the elements were not contained in a unitary structure, that the device for holding the

pipe in position was a detached instrument which was no part of the machine or manufactures and that the manuel use of a tool or non-attachable device could not be made an element of a combination claim. The patent as to such claim was determined to be invalid.

This case is cited in the case of VanDorn Iron Works Co. v. Matthews Bros. Co., 260 Fed. 400 at page 406, being a decision of the Circuit Court of Appeals for the Sixth Circuit, in which case the court had under consideration patents covering mail boxes of the type now in general use, consisting of U shaped angle irons which served as corners to which the sides of the sheet metal were riveted, said angle irons being extended down so as to form legs.

The court held that the use of angle irons was old in the prior art and that inasmuch as mail boxes had previously been made with receptacles for letters and papers which were placed upon bases or legs, the mere employment of angle irons in continuous pieces forming corners and also legs to the box and the particular formation of these boxes constituted nothing further than mechanical adaption of so many materials and methods and did not rise to the dignity of invention.

Pelton Water Wheel Co. v. Doble, 190 Fed. 760.

When we come to examine this case, we find that the court had under consideration a combination patent for controlling the water supply to a water wheel. The patentee had combined a curved nozzle with a

pivot jet in line with the line of discharge to the supply pipe, effecting a double curve in the pipe or nozzle at this point so as to do away with the tendency to push the nozzle upward by the water going through the curve. The curve in the pipe or nozzle was necessary in order to enable the placing of the pivot jet in the nozzle so that the rear of the pivot could extend through the side of the nozzle, and thereby be controlled.

The trouble with placing a pivot in previous nozzles had been that the curve in the pipe or nozzle acted as a resistance to the water on one side, and thereby had a tendency to force the nozzle in a position opposite that in which it was curved. Complainant overcame this difficulty by a double curve of the pipe or nozzle, the nozzle first being curved in one direction and then an equal curve in the opposite direction, so that the tendency to push the nozzle in one direction would be overcome by the tendency of the second curve to push the nozzle in the other direction. Defendant contended that there was nothing new, by reason of the fact that water to two turbine water wheels by means of one pipe conducting the water to within a short distance of the wheels, then separating into two pipes, one of which would curve to one wheel, and the other to the other wheel, whereby the tendency to push the pipe in one direction, by reason of the curve to one wheel, would be overcome by the tendency to push the pipe in the other direction by reason of the opposite curve in the pipe to the other wheel.

The court said that while it was probably true that there was such a tendency, nevertheless the same

was not known, and it was not constructed for the purpose of producing such a result, but was merely an incidental result of the dividing of the pipe, said device being for no other purpose than that of supplying water to two different wheels. It very properly held that same could not be construed as an anticipation to the pivot jet nozzle with reverse curves.

On page 766, and as a part of the same paragraph which complainant's counsel have quoted, we find that the following language was used by the court: "In order to be patentable, a combination of elements must in their co-relation produce a different force, or effect, or result, from the sum of that which is produced by their separate parts," citing *Reckendorfer v. Faber*, 92 U. S. 437.

The case of *Burdett-Round Tree Mfg Co. v. Standard Plunger Elevator Co.*, 196 Fed., 43, pertains to the question of the entry of the human element in a combination claim. In this case the court had under consideration an improved electrical elevator, whereby a signal system for electric elevators was such as to enable a single person at the motor to control the movements of the elevator, while the combination claim covered a hoisting mechanism, means for controlling the same, means for operating and to start the car and to rest it automatically at any predetermined landing with a push button for each floor at which the car is to stop, a circuit for each push button and a signal actuated by the operator of each push button for signifying in advance of the starting of the car

the floors at which the car was desired to stop. While the human element was necessary to complete the operation of the combination based upon the signal so given, it was held that this would not defeat the combination claim as all of the elements pertained to bringing about the desired result of allowing the elevator to be operated and controlled from a given point known as one point control or at the motor.

In the case of *International Mausoleum Co. v. Seivert et al*, 213 Fed. 225, the court had under consideration upon a demurrer the validity of a patent claim covering a burial crypt, comprising a structure with a reception hallway series of catacombs erected therein and space from the walls thereof whereby an air passage is formed, said catacombs being provided with valve control ports at the rear end, which communicate with said air passage, said air passage being provided with an outlet at or near the top of the structure, also valve control ports at the front end of the catacombs, through which the air may be exhausted therefrom after the same are sealed. The question decided by the court was that on demurrer it could not be said that the claim did not cover a manufacture under the meaning of the patent law. There is certainly nothing in this case which can throw any light on the machine patent under consideration.

“In the case of *National Cash Register Co. v. American Cash Register Co.*, 53 Fed. 367 the court had under consideration the following claim; In a cash

registering apparatus a series of keys to designate certain amounts, combined with a drawer, the drawer holder D immediately connected with said keys, and the spring to throw the drawer open when released by the drawer holder, substantially as described."

The patentee was the first one to construct a cash register device in which the drawer would be opened by the operation of the keys and the court held the same to be a patentable combination.

Near the bottom of page 371, in commenting on the case of *Pickering v. McCullough*, 104 U. S., 310, the court uses the following language:

"If, instead of an extract, the whole opinion be read, in connection with the authorities which are cited in it, it may be readily perceived that the substance of the doctrine intended to be affirmed is that *a combination*, to be patentable, must produce a new and useful result, as the product of the combination, and not a mere aggregate of several results, each the complete result of one of the combined elements."

In the case of *Ohmer Fare Register Co. v. Ohmer et al*, 238 Fed 182:

The court had under consideration three patents. The first related to operating, or actuating mechanism, for a fare indicator. The second patent related to the registering device whereby the month, the day, the different trips, the number of the register and the fares collected were all properly recorded, being the first mechanism in which this result had been obtained.

The third patent related solely to means for identifying the person taking the statement from the register, the identifying means being a key bearing a distinct mark, as for instance, the conductor's number.

The device of the patent is such that when the key is out of the machine the operating parts are held by notches so that they can not be operated, and the insertion of the key releases the notches, unlocks the printing mechanism, and places the identifying number on the key in alignment with the figures or characters of the fare or other recording wheels, so that the impression of the figures or device on the identifying key is recorded therewith.

The matter of recording an identifying number was also new in this art. The first patent was held void for want of invention, and the second two were sustained.

Beginning with paragraph 2, page 186, of reported case.

After indicating that the exact arrangement of the devices was not found in the prior art, the court used the following language:

"We are cited no reference in the prior art, fully anticipating the patent in suit. But we are considering the scope of invention, not anticipation; and in such inquiry the question is one of fact, taking into account the entire prior art, whether the advance made in the given case amounts to invention or only mechanical skill. *Herman v. Youngstown Co.* (C. C. A. 6) 191 Fed. 579, 112 C. C. A. 185; *Ferro Concrete Co. v. Con-*

crete Steel Co. (C. C. A. 6) 206 Fed. 666, 668, 124 C. C. A. 466; Ft. Pitt Co. v. I. & M. Mfg. Co. (C. C. A. 6) 232 Fed. 871, 875, 147 C. C. A. 65. All elements of the prior art have a bearing upon the question of invention; it being unnecessary to a finding of lack of invention that every element be found in one embodiment. Zimmerman v. Machinery Co. (C. C. A. 6) 232 Fed. 866, 868, 147 C. C. A. 60; Keene v. New Idea Spreader Co. (C. C. A. 6) 231 Fed. 701, 708, 145 C. C. A. 587; Ft. Pitt Co. v. I. & M. Ffg. Co. (C. C. A. 6) *supra*, 232 Fed. at page 874, 147 C. C. A. 65.

“Defendants contend that plaintiff’s patent is confined to means for operating the sliding mechanism disclosed. But, passing this contention, and assuming that the narrow claims may involve invention, we are disposed to think, upon a consideration of the entire prior art adduced, that the claims in suit, if construed broadly enough to cover defendants’ mechanism, would be void for lack of invention. In reaching this conclusion we have not overlooked the consideration of commercial success. But, while public favor is to be considered where invention is in doubt, yet not only is it not otherwise important (Cincinnati Traction Co. v. Pope (C. C. A. 6) 210 Fed. 443, 449, 127 C. C. A. 175), but in the instant case the record does not show that the commercial success of plaintiff’s device is appreciably contributed to by the mechanism of the claims in suit. For all that appears in the record, the success may be due largely, if not entirely, to other features of invention or construction, including the devices of the other patents in suit.”

As a new element was introduced in each of the second and third patents, the court held each patent valid, adhering, however, to the rule as therein expressed, in deciding the validity of these claims, namely: That the elements so co-act that as a consequence of their union a new and useful result, and not a mere aggregation of several results follows:

That this case can not be considered as an authority in sustaining appellant's contentions in this case is indicated by the treatment which this case has had in frequent considerations by the court. The case is cited in the case of *Lemley v. Dobson-Evans Co.*, 243 Fed. 391, page 398, in substantiation of the proposition that the mere bringing together of old elements, or their equivalents, where each works out its own results, so as to only give the sum of the results of the elements instead of a product, which amounts to a new result, is nothing more than the expected ability of the skilled artisan and is not invention.

In the case of *Lemley v. Dobson-Evans Co. supra*, the court had under consideration U. S. Patent No. 819,461, issued May 1, 1906, to Schade for an improvement in a loose leaf binder which is illustrated on page 393 of the report. The binder being formed by a continuous wire hingedly connected to each side of a resilient arch shaped metal in the back of the binder, having off-set in the wire passing beyond the middle of the binder and then returning and forming the hooks, or rings, such as is common in loose leaf binders. At the time of Schade's invention loose leaf binders formed by two plates hinged together, and also

hingedly connected to the edge of an arch-shaped resilient back, and to which half rings were attached which would be held either closed or open by the spring effect of the resilient back, were upon the market. Blackmer and Robson had also invented a loose leaf binder by utilizing a continuous wire in which there was a slight off-set in the portion thereof which ran laterally with the binder, and between the back of the binder and a springlike piece of metal, the ends of this wire being formed in half eyelets, or rings, so as to be engaged or disengaged and held in place by the spring effect of the binder in the back and the strip of metal upon the off-set in the wire.

The court held that the state of the prior art was such that while no one of the prior devices would act as a complete anticipation of the Schade patent, the prior devices or their equivalents, selected from the various previous devices were sufficient to defeat the validity of the Schade patent.

Certainly the devices used in connection with these loose leaf binders as described and illustrated in this case, are no closer equivalent of each other than are the Morgan, Labadie, Ludford & Butters oil reservoirs provided in the side of the block, equivalents of the Gilchrist block side. shown on pages 154, 104, 44 and 164, Vol. 2, Transcript of Record Exhibits.

In view of these oil chambers which Gilchrist has conclusively presumed to have had before him at the time of applying for his patent, certainly no inventive genius could be displayed in the providing of a block side containing an interior oil reservoir integral there-

with. Likewise when we trace the function of each element of the Gilchrist claims we find not only the equivalent of the element but almost the exact duplicate of the element in the prior art performing exactly the same function. The Gilchrist device therefore discloses no new co-action of elements and no new results.

The case of Fare Register Co. v. Ohmer Co. *supra*, was next considered by the Circuit Court of Appeals of the Sixth Circuit in the case of General Manifold & Printing Co. v. Simple Account Sales Book Co. 246 Fed. 125, in which the case was again cited by the court as authority for the following proposition.

“From neither point of view did he do more than to take an existing combination and substitute for one element thereof a known equivalent. This is not invention.”

The case of Ohmer v. Ohmer, 238 Fed. 182, is again cited by the Circuit Court of Appeals of the Sixth Circuit in the case of J. H. Day Co. v. Mountain City Mill Co., 264 Fed. 963, 966, where the court had under consideration the question of invention in connection with a cracker cutting machine. Beginning with the bottom of page 965 the court uses the following language:

“The dominant fact is that, when Ward entered the field, Perky had already applied to the biscuit-cutting art the idea of moving cutters and material to be cut in unison, had reduced the idea to practice, and had dis-

closed to the public operative mechanism therefor. It clearly would not have been invention to apply to ordinary cracker cutting Perk's method of vertically operating knives carried by bolts moving in unison with the feed of the biscuit material. It seems equally clear that there was no invention in substituting for Perk's means of effecting unison of movement the means disclosed by Hovey for effecting such unison in an art containing so much analogy as that of cutting a sheet of plastic clay."

Citing *Ohmer v. Ohmer*, *supra*, with several other cases.

In thus tracing the history of the case of *Willard v. Union Tool Co.*, *supra*, and the various cases included in the quotation therefrom on pages 18 and 19 of appellant's brief, we find that it was not the intention of the courts to change the rules of law concerning claims for combinations or improvements in mechanical devices requiring a new mode of operation or a new co-action of the elements resulting in a new result which must be something more than a mere aggregation, or sum, of their individual functions before such combination can be said to have raised to the dignity of invention.

It is true that here and there we find decisions where the court has used unguarded language which might imply that inventions could be obtained by reason of the utility or superiority of the device without giving the intention which the law requires should be given as a test for patentable invention. However, a close ex-

amination of these cases and their history usually discloses that the error of the court has been an error as to the facts involved rather than an error as to the rule of law applicable thereto.

The cases in which the courts have been apparently unduly influenced by the question of the utility of an article or its commercial success without properly guarding their decisions concerning the application of the rules which should be applied for testing a patentable invention have been aptly classified as cases lying within the "twilight zone." Once in a while one of these cases finds its way to the United States Supreme Court and then it must stand a test of invention other than that based upon utility or commercial success, or the patent will fail.

The cases which counsel for appellant is relying upon in this connection are the "twilight zone" cases.

We find, for instance, that the case of Railroad Supply Co. v. Hart Steel Co., 222 Fed. 261, is one of the cases in which the court relied on the decisions just referred to. This case pertained to a patent for corrugated rail plates, or seats, and was decided by the Circuit Court of Appeals for the Seventh Judicial District.

The court reversed the decree of the District Court, holding the patent void and directed an order for an accounting on the claim of the first patent and to enter an injunction and order and accounting on claims of second and third patents. These same patents were again under consideration by the Circuit Court of

Appeals for the Sixth Judicial Circuit in the case of Railroad Supply Company v. Elyria Iron & Steel Co., 213 Fed., 789, and the Circuit Court of Appeals in this case came to the conclusion that the patents were void for lack of invention in view of the prior art. The case was taken to the Supreme Court of the United States on *writ of certiorari* and affirmed by the United States Supreme Court May 21, 1917, 244 U. S. 294, 61 Law Ed., page 1136.

The various cases cited pro and con by counsel in this case would be sufficient to require a long judicial vacation from work on the bench if the Court should thoroughly read and analyze each of these cases, but on page 1141 of Vol. 61, L. Ed. under the head, "*All the Claims in Suit are for Mechanical Aggregations and not for Patentable Combinations*" will be found a long list of prominent cases, which have been considered over again by the court, and are ample authority for holding that no such device as the Gilchrist block can be considered as a true combination which will pass the test of inventive genius in view of the prior state of the art.

By next tracing the case of New York Scaffolding Co. v. Whitney, 224 Fed. 452, which is found twice on page 19 of appellant's brief, we find a history of the same to be as follows:

The court had under consideration United States Patent No. 959,008, where an improved scaffolding supporting means issued May 24, 1910, to E. H. Hen-

derson. This scaffolding device consisted of a plurality of U shaped bars arranged in pairs, a cross-beam or put-log laid in and extending between each pair of said U shaped bars, a floor laid down upon said cross-beams, a drum rotatably supported between the upward extending side members of each of said U shaped bars and means of controlling the rotation of said drum. This resulted in a readily collapsable and easily adjustable scaffolding so that it could be easily moved from place to place by means of the drums being in the U shaped angle irons at each end of the put-log, the crank or operating device was not in the way of the operator upon the platform. The District Court had held this patent invalid for want of invention in view of the prior state of the art, but the Circuit Court of Appeals of the Eighth Circuit reversed the decision of the District Court. However, this same patent came up again for consideration in the case of New York Scaffolding Co. v. Lietel-Binney Construction Co., in the District Court for the Western District of Pennsylvania and District Judge Orr again declared the patent invalid for want of invention. This case was appealed to the Circuit Court of Appeals of the Third Circuit and affirmed in an opinion written by Judge Wooley. On a *writ of certiorari* from the U. S. Supreme Court the decree of the Circuit Court of Appeals for the Third Circuit, declaring the patent invalid for want of invention was affirmed November 8, 1920. Supreme Court Advance Sheets of December 1, 1920, page 28.

In the case of *Gas Machinery Co. v. United Gas Co.*, 228 Fed. 684, the court reviews a good many of the cases referred to in the quotation from *Willard v. Union Tool Co.*, used upon pages 18 and 19 of appellant's brief. Upon page 686 the court uses the following language:

"The authoritative cases are few which have considered the distinction between aggregations and combinations, except as it is complicated and confused by the effort to find the line between invention and mechanical skill. See *Walker on Patents*, Fourth Edition, 32 and cases cited. Rule of Aggregation is stated—properly as well as possible—in *McComber's Sixth Law of Secs. 42 and 51, Q. V.*:

"The distinction between an aggregation and a true combination is not always clear. The main test lies in an examination of the results—the function performed. If that result is the sum of the several actions of the elements, it is an aggregation; if it is the product of those actions—the action of one element so modifies the action of another that the resultary action differs from the sum of the separate actions—it is a true combination."

On page 691 of the last mentioned case the court uses the following language:

"The holding of the Circuit Court of Appeals for the Third Circuit in *Standard Co. v. Burdett Co.*, 197 Fed., 743, adopting the opinion in 196 Fed. 43, doubt-

less 'lies within the twilight zone' (196 Fed., 46); but assuming the patent there involved to have been rightly sustained, we think the conclusion rests on Judge McPherson's statement, 196 Fed., 46, that 'the result produced by the patent is a method of operation'; and though the claims seem also in the twilight zone between claims for mechanical combinations and claims for method, the stated object of the patent was 'to provide a signalling system.'

In the case of Gas Machinery Co. v. United Gas Improvement Co., *supra*, the court had under consideration a combination claim, which included an ajutage or device interpreting the rate of motion of the entering air blast along the flow pipe in a gas plant. The purpose of this device was to indicate to the person in charge of the plant when a sufficient amount of air had passed in so as to regulate what are termed the blows. The court held that this device was a mere indicator to the operator as to what the pressure was and had no co-action with any of the other parts of the plant and could not be the part of a combination in connection therewith.

Where appellant can find application for the statement which he has quoted from the case of Brown v. Zaupitz, 105 Fed. 244, in the record now before the Court, is more than I can understand, for the testimony of defendant's witnesses concerning the prior art which is not substantiated by patents, is well corroborated and established by exhibits which complainant's

own witnesses recognized and admitted were old in the prior art, and it is, therefore, needless in this case to take any exception whatever to the principles on this point as laid down in authorities cited by appellant.

Judge Bean's statement (R. 26) quoted by appellant as follows: "In reaching this conclusion, I am not unmindful of the presumption of the validity of the patent arising from its issue, or that the lubricating block manufactured by plaintiff has proved its superior utility in the logging business," certainly must give considerably more weight than what it otherwise might have, had Judge Bean arrived at his conclusion without giving due weight to the presumption of validity of the patent which arises from its issuance and to the presumption of invention which arises from the superior utility of an article. Had the prior art been indefinite and uncertain, appellant might then have asked this court for a careful consideration of the Gilchrist device, giving to it the benefit of the presumption just referred to. But the trial court after giving to defendant the benefit of all these presumptions has still been required to find a lack of invention and an exercise of nothing more than mere mechanical skill, for every element claimed in the Gilchrist combination is found in the prior art performing the same function in substantially the same manner. There is no new machine, no new mode of operation, no new result, and consequently no invention.

Taking appellant at his word, and the patentee at his word, as expressed in the language of his claim that his object is to provide a considerable quantity of lubricant and feed the same automatically and slowly upon the bearing pin of the pulley, and second to provide a pulley the bearing pin of which is adequately protected against dirt and dust, we find that each of these objects had been accomplished long before Gilchrist entered into the art.

On page 30 of appellant's brief it is contended that the questions of invention, as well as infringement, have often been determined by considering whether the defendant's device is more like that of the patent in suit than the alleged anticipations.

By referring to the cases cited under this heading, we find the language used is "mechanical equivalents" instead of invention. The application of this test to the present controversy can give little comfort to appellant, for we find that the interior integral reservoirs of the Ludford, LaBadie and Butters pulley block sides are far more strictly interior integral reservoirs than those found in the defendant's pulley block.

And as to all the other elements the prior art has disclosed elements performing the same function and producing the same results in identically the same way as they do in both the Gilchrist and the defendant's device.

In the case of *American v. Fiber* 90 U. S. 566, 23 L. Ed. 31, the court had under consideration the chemi-

cal process for the manufacture of paper fibers, and there is nothing in this case which can throw any light on the present controversy.

In the case of *Gordon v. Warder*, 150 U. S. 47, 37 Law Ed. 992, the court had under consideration a binding, or tying device in harvester machines, which was adjustable at the will of the operator so as to regulate the place where the bundle would be tied, thereby allowing the driver or operator, to have the bundle tied as nearly in the center as possible, even though there might be a variance in the height of the grain. The device was worked by a lever in the hand of the operator which caused the tying apparatus and the arm working in conjunction, or juxtaposition, therewith to move horizontally upon the shaft. The defendant's device was a fixed tyer, which was not adjustable and was held not to infringe, and I find nothing in this case which can throw any light on the Gilchrist-Mallory controversy.

In the case of *General Electric Co. v. Wagner Electric Mfg. Co.*, 130 Fed. 772, cited by appellant, the court was able to sustain the validity of this patent only after finding as is stated in the language on page 778:

"We have been unable to find in the prior art any single device or any sufficiently definite suggestion derivable from the various devices which sustain the contention of defendants that the patented improvement is merely the result of mechanical skill."

This same patent came up again for consideration in the case of General Electric Co. v. Allis-Chalmers Co. 197 Fed. 558, and in this case the court limited the patentee's invention to a transformer having two separate ventilating systems, independently controlled, one for cooling the coils and the other the core, which could not be found in the prior art, and as so limited, held that it had not been infringed by the defendant.

As to the cases cited on pages 42, 43 and 44 of appellant's brief, I feel that it will be unnecessary to give any detailed consideration, for there is no contention but what some competent evidence is required to overcome the presumption of validity which arises from issuance of the patent just the same as some competent evidence is required to overcome the presumption of the regularity of any other official act, and as is more fully considered under the heading in my brief, "Presumption a Mere Rule of Evidence." However, an examination of these cases will disclose the fact that the same rule of evidence applies in connection with patent matters as in other matters, and that if the circumstances are such as to throw doubt upon the patentee's testimony, or evidence, the same will be discounted and disregarded just as readily as the evidence of the defendant. This fact is well illustrated by the last case cited in appellant's brief on page 44, Clark Thread Co. v. Willimantic Co., 140 U. S. 488, 35 L. Edition 521. In this case the doubtful testimony which the court had under consideration was the testimony given for the purpose of sustaining the patent sued upon where the patentee was trying to fix the date of invention prior to that of a

British patent cited as an anticipation, but the court held that the evidence given for the purpose of sustaining this patent was not sufficient to disprove that the invention had been anticipated by the previous patent cited by the defendants, and the cause was remanded to the lower court with instructions to dismiss the bill of complaint.

In *Morton v. Llewellyn*, 164 Fed. 693-697, cited on page 60 of appellant's brief, the Court had under consideration the patentable novelty of a drainage and ventilating system for toilets, bathtubs, etc. Only one patent was set up as an anticipation, and the elements of that patent are not given, but on page 697 the Court uses the following language:

"A careful comparison of those exhibits with the patented fitting satisfies us that the only elements of novelty in the latter are the inclined deflectors within the drainage pipe and vent and the enlargement of the latter, neither of which elements do we find in the appellant's fitting. The latter with the exception of a change of angles and a shortening is exactly similar to Exhibits 1 and 2. It may be and probably is true that the deflectors and enlargements of the appellee's fittings and their compactness makes them more desirable, and no doubt accounts for the favor they are shown in the markets, but that circumstance is unimportant, since in our opinion the appellant is not shown to have infringed."

In the case of *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 144, cited by appellant on page 61 of his brief. The language of the court on page 143 should also be taken into consideration, which is as follows:

“While it is true that the mere fact that a device has gone into general use and has replaced other devices which had previously been employed for analogous uses does not establish in all cases that the latter device involves invention within the meaning of the patent laws, yet such a fact is always of importance and is entitled to weight when the question is whether the machine exhibits patentable invention.”

In the earlier devices for shelling corn, the wheels with projections revolved against the direction in which the corn entered. The patentee in this case changed the winged shaft so as to cause the wheels or projections to revolve in the same direction as the corn enters, and thus force the corn rapidly forward into the sheller, each ear being out of the way before the second ear came in, and thereby avoiding any chance of clogging.”

Near the top of page 144, the court used the following language:

“We also concur in the reasoning and conclusion of the court below affecting the novelty of the invention. While it is true that the device patented by Augustus Adams, the father of the present patentee, in May, 1866, was intended to effect the same purpose, and used likewise a revolving shaft with wings or protuberances, *yet the mode of operation was entirely different.*”

In the case of *Irwin v. Hasselman*, 97 Fed., 964, the court had under consideration the question of an infringement of an improvement in bookbinding. The claims as originally drawn covered "a book having leaves rendered flexible at a line parallel to and a short distance from the back, substantially as and for the purposes set forth." The patent office found this claim anticipated by other patents, and required an amendment of the claim whereby other elements were included. It was found by the court that the defendant used this element and on page 968 uses the following language:

"Had the patent been allowed on such claim, infringement would stand confessed by the answer, and the question of patentable novelty upon the showing of the prior art would alone remain for consideration; and on that inquiry the test of invention would not be of simplicity alone in the device, nor in the fact that like means may appear as an element in prior devices where the use is not analogous. There may be invention in applying a device which is either simple or old *where it is used in a new way, and accomplishes a new result.*"

And preceding this statement the court says:

"And the testimony is clear and uncontroverted that the books made by the appellee of which infringement is alleged are in every particular constructed in old and well-known methods, except that the leaves are creased as described in the first claim of this patent."

Appellee was, therefore, considered within his rights and the bill dismissed for want of equity.

Applying the reasoning in this case to the state of facts now before the courts, let us presume that Gilchrist first applied to the patent office for a patent in which the claim covered only a logging block or a pulley block having a side provided with an interior oil reservoir. This claim would immediately have been anticipated by the patents of Ludford, Labadie and Butters, saying nothing about the Morgan patent. All of the elements in appellant's combination, or block, in the exact combination as therein used, excepting his oil reservoir, were admittedly old by the complainant, so that by applying the test as laid down in the case of *Irwin v. Hasselman*, *supra*, the complainant's bill would necessarily need to be dismissed for want of equity.

National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. 693. On page 697 we find the following language:

"In 1892 85 per cent of these railroads, controlling 80 per cent of the cars using iron brakes, had adopted those made under these patents to Hien, and in 1898 more than one million brake beams constructed under these patents had been manufactured and sold. *These facts establish neither the novelty nor the patentability of his device*, but they certainly challenge admiration, and demand that the presumption of validity which supports his patents shall not be stricken down without careful consideration and cogent and convincing proof."

Hien combined, first, a hollow or tubular metallic beam; second, a metallic bar corresponding with the king post of a truss, called a "strut," provided with a slot for the reception of the brake lever, an eye at one end to receive the tension member, and a clamp at the other end to secure it to the compression member. Third, a metallic rod, corresponding to the truss rod of a truss, called the "tension member," provided with threads on each end to receive nuts. Fourth, plugs or caps to inclose the ends of the compression member, provided with holes for the passage through them of the ends of the tension member, with recessed nut seats with surfaces at right angles to the lines of the ends of the tension member, with circular shoulders a short distance from their inner ends which fit tightly upon the ends of the compression member and permit the caps to enter therein for a short distance only, and with lugs or projections which extend through the slots in the compression member and into notches in the brake head. Fifth, nuts screwed tightly upon the ends of the tension member to hold beam, caps, and brake head securely together. The claim read:

"The combination, in a brake beam, of a hollow beam, a strut, end plugs or caps, 8, and a truss rod, 3, which extends through the caps, 8, and is provided with nuts, substantially as and for the purposes specified."

On page 703 of the reported case, the Wabash brake beam was described by a witness as a trussed wooden brake beam in which the ends of a tension rod passed through the ends of the wooden brake beam and

through iron plates thereon and was secured in place by nuts screwed upon its threaded ends. And the court said:

“Unsupported oral testimony of a prior use is always open to suspicion and it cannot prevail over the legal presumption of validity which accompanies the patent, unless it is sufficient to establish such a use beyond a reasonable doubt. The testimony relative to the use of this Wabash beam is not of that character and it will not be further considered.” (Citing cases.)

For the same reason the evidence of use in 1884 and earlier of a double trussed wooden beam on the Burlington road must be disregarded.”

Consideration of the Westinghouse patent brake beam was dismissed by the Court as follows:

“It lacks the adjustability, compactness, and simplicity of construction which his brake beam exhibits, and whatever it has done in the past or may accomplish in the future has not been and cannot be brought about by this wooden brake beam by the mechanical means described and claimed in Hien’s combination, because it contains neither the single tension member with threaded ends passing through the ends of the compression member, nor nuts thereon securing it in place by means of which the tension of the structure, the resilience of the beam, and the coning of the shoes may be produced, adjusted, and maintained; and these are essential elements of the combination of the appellants.” (Page 705).

On page 707 the court uses the following language:

“The prior art discloses no combination of the elements of Hien’s brake beam in the way which he describes. In other words, the method of combination of the old devices which he presented was new. Nowhere in the history of the art can the tension member, with threaded ends passing through the ends of the hollow metallic compression member, and through caps thereon, secured in place by nuts on its ends, by the mere turning of which the rigidity of the structure, the resilience of the compression member, and the coning of the brake shoes to the tread of the wheels may be produced, adjusted and maintained, be found. Yet this is the principle of his invention, the mode of its operation, the peculiar combination of devices which distinguishes it from other brake beams.”

Near the bottom of page 707, the court uses the following language:

“It is true that the extensive use of a machine or combination which is clearly without novelty does not dispense with that statutory requirement, and that it will not alone sustain a patent. McClain v. Ortmyer, 141 U. S. 419, 428, 12 Sup. Ct. 76, 35 L. Ed. 800; Duer v. Lock Co., 149 U. S. 216, 223, 13 Sup. Ct. 850, 37 L. Ed. 707; Olin v. Timken, 155 U. S. 141, 155, 15 Sup. Ct. 49, 39 L. Ed. 100; Klein v. City of Seattle, 77 Fed. 200, 204, 23 C. C. A. 114, 118, 44 U. S. App., 741, 748.”

At the top of page 709 the court uses the following language:

“Again, since a function is not patentable, a combination of functions is not; nor is a combination of mechanical devices or elements and one of the functions of that combination. It is a combination of mechanical elements, and of such elements alone, that may be protected by the grant of a patent.”

In the latter part of this case are considered some alleged improvements which involved only mechanical skill in the mind of the court and could not be the foundation for a patent. For example, on page 719 two claims were considered in which the previous combination had been added to by introduction of a wedge which was inserted between the compression member, and the collar of the strut for the purpose of taking up any play, under the claim *that it is not a patent for a wedge but for the new combination of the wedge with the brake beam of Hien*, in consideration of which the court used the following language:

“But it is conclusive answer to this contention that there is no more invention in the combination of a wedge of the usual form, discharging its customary function of tightening the parts of a mechanical device, with Hien’s machine, than there is in the discovery of the wedge itself and its common use for this purpose. If this were not true, every combination of an old machine with a wedge, performing the function of tightening its parts, would constitute an invention.”

The testimony which has been introduced by the defendant in this case is fully as convincing and posi-

tive as the character of the testimony referred to on page 721 of the brake beam case, and which the court there held was such as to defeat the patent. Even if it were to be conceded that the Morgan patent did not fully anticipate the Gilchrist patent, the providing of the interior reservoir integral with the side would come within the language used by the court on page 723, as follows:

“There are some mechanical devices so obvious and appropriate for the performance of their accustomed functions that the common knowledge and experience of those unskilled in mechanics, to say nothing of those learned in the art, at once suggests their use when the results which they customarily attain are desired. * * * ”

“There can be neither discovery nor invention in applying a remedy so plain or in combining a contrivance so obvious with an old mechanical device which needs it.”

There was no great need for the oil reservoir block until skyline logging came in vogue, and it was the defendant, and not the complainant, who introduced the large skyline blocks with reservoirs in their sides and placed them up on the market long prior to the time complainant entered this field. (R. —).

In *National Machinery Corporation v. Benthall Machinery Co.*, 241 Fed. 72, on page 78 the following language is used:

"It is insisted by complainant that a new combination of old things may be patentable, and in support thereof cites the cases of *Loom Co. v. Higgins*, 105 U. S. 580; *Seymour v. Osborne*, 11 Wall. 516; "*The Barb Wire Fence Patent*," 143 U. S. 275, 12 Sup. Ct. 443; *Bates v. Coe*, 98 U. S. 31; *Hobbs v. Beach*, 180 U. S. 383; *National Hollow Brake Beam v. Interchangeable Brake Beam*, 106 Fed. 693."

"This rule is well established, but in the case upon which it relies the combination is new and the result of the combination of the old elements is also new. In the case at bar there is no cooperation between the elements; the throats having their sides meeting at an angle, a protected point is disclosed in Hazelton's patents and is, therefore, not new. Wedge-shaped throats are disclosed in the Hazelton patent No. 253,554, and the Scott patent No. 125,338 is also old. There being no cooperation between these functions, we have the result that each must act in the old way, the joint product being aggregation of the old results, which under the rule is not patentable."

In the case of *Diamond Patent Co. v. S. E. Carr Co.* 217 Fed. 400, this Court had under consideration a patent showcase comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt; each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates. The show-

case relied upon as defeating the validity of this patent under the head of prior analogous use in cases was one in which the felt had been cemented by a glue or cement which penetrated the entire felt, making it a hard substance, and clamps, bolts and screws had been used as in the older cases, so that there was no elasticity whatever, and the same were given up and abandoned as a failure, practically all of the cases so made having broken through vibration.

In the Gilchrist-Mallory controversy there is no doubt as to the function which the various elements referred to in the prior art were designed to perform, for they were not only in use as actual operative devices, but were also explained, described and illustrated in previous patent publications.

In the case of *Imhaeuser v. Buerk*, 101 U. S. 660, 25 L. Ed. 945, cited on page 69 of appellant's brief, there is found nothing which can be of service in arriving at a conclusion in this case, for the reason that all of the devices of the prior art were so substantially different from those involved in the combination that they could not be relied upon as anticipations.

On page 947 the Court uses the following language:

"They differ not only in construction, *but in the mode of operation*, and in almost every particular which gives value to the device as a time detector for watchmen, the foreign patent being much more cumbrous and inconvenient than that of the complainant."

In the case of *Griswold v. Harker et al.*, 62 Fed. 389, the Court had under consideration Patent No. 229,280 for an improvement in a waffle iron, so constructed that the hinge connecting the parts of the pan formed part of one of the pivots or journals on which the pan rotated, while the opposite pivot or journal was formed by the divided handle, so that the pan would open in the same plane with its axis of rotation

Nothing embodying this principle was shown in the prior art. On page 392 the Court says:

"None of the utensils described in these anticipating patents have such a hinge. Not one of them is provided with any hinge at all."

There is no contention but what a combination claim may be valid if it embodies a new element not heretofore found in the prior art, and if the combination of elements is such as to bring about a new mode of operation.

We find nothing in the case of *Leed & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 53 L. Ed. 805, which can throw any light on the present controversy. For it is true that a combination as an invention is a unit in contemplation of law. However, before a combination can be the subject of invention in an operative mechanical device, there must be either some change in the mode of operation from that disclosed in the prior art, or the introduction of a new element therein which in itself would be the subject of the invention as a separate element or article of manufacture.

The case of Gormully & J. Mfg. Co. v. Stanley Cycle Mfg. Co. et al., 90 Fed 279, merely contains the broad statement quoted on page 69 of appellant's brief, without in any way giving the facts on which it is based.

I do not take issue with this above statement. The finding of each of the separate elements may not necessarily defeat a combination claim, but if the mode of operation is found in the prior art, and each of the elements is found performing the same function in the prior art, the combination will be defeated.

In the case of Yestera v. Hardesty Mfg. Co., 166 Fed. 120-125, no light whatever is thrown upon the controversy here, as the question under consideration there by the Court was merely one of a method of arriving at the damages or profits recoverable after having determined there was an infringement.

In the case of Stebler v. Riverside Heights Orange Growers' Ass'n., 205 Fed. 735, and page 738 from which appellants quote in their brief, the Court has merely said:

"The invention, we think, was an important and distinct advance in the art, and is not anticipated by former patents. Those chiefly relied upon for this defense are the Ish patent, already referred to, the patent to Bailey and the one to Hutchins. Enough has already been said of the Ish machine to make it ap-

parent that as to it plaintiff's invention was a substantial improvement and not without patentable novelty."

That is correct. The mode of operation as shown in the description of the patent is entirely different from the mode of operation in complainant's patent. The court then goes on to say:

"It is not deemed necessary to describe in detail the Baily and Hutchins devices. They are not infringed by the plaintiff's claims. True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and, by combining them all, anticipate the inventive idea expressed in the Strain patent, but the combination constituting the invention is not found in any one of them."

After which reference is made to the opinion of this Court in the case of *Los Alamitos Sugar Co. et al v. Carroll*, 173 Fed. 280.

While the Bailey and Hutchins devices are not described in the report, I take for granted that they, too, had a different mode of operation or the court would not have passed them by with this slight reference, and then in turning to the case of *Los Alamitos Sugar Co. v. Carroll* for the purpose of determining just how far this Honorable Court went in that case on this question, we find that the Court distinctly indicated that the other devices of the prior art referred to had a different mode of operation. On page 285 we find the following language:

“Expert witnesses for the respective parties—Boyd and Bates—seem to agree in their opinion that the *principle of operation* of the Chisholm device is different from that of Carroll, and, without going into details, we think it sufficient to say that the Chisholm patent does not anticipate all of the elements found in the claims of the Carroll patent hereinbefore set out, and that it is not capable of being operated or used in the manner in which Carroll’s device was intended to be operated and used. Nor do any of the other patents relied upon provide a complete dumping apparatus *which will operate upon the principle of Carroll’s*. It is not sufficient to constitute anticipation that the devices relied upon might, by a process of modification, reorganization or *combination with each other, be made to accomplish the function performed by the device of the patent sued on*.

These statements show that this Honorable Court is in harmony with the rule as laid down in the Supreme Court and in the various other Circuits concerning *the necessity of looking to the mode of operation* in determining whether or not invention exists when the Court has under consideration a combination claim made up of elements which are old in the art.

In the case of *Johnson v. Railway Co.*, 33 Fed. 499, the Court had under consideration a patent in which the invention consisted in the combination of an oscillating platform with a movable frog or switch, the platform being arranged with a railroad track so

that it could be operated by the weight of the horses, or other animals, thereby moving the switch from one track to another. If a driver, approaching the platform from the direction towards which the free end of the switch points, desired to take the right hand track he had but to turn his horses towards the right; their weight upon that side of the platform would move the switch latterly, close the left-hand track, and direct the car upon the right-hand track. If, however, he wished to take the left-hand track, the natural turn of the horses in that direction would enable him to do so. In this manner, by simply directing the weight of the animals upon the proper side of the platform, the switch was operated, and held in the desired direction. The claim being the combination of an oscillating platform, arranged for operation by the weight of the draft animals of the car, with a switch, in the manner substantially as herein shown and described. It appears the prior art did disclose a locking platform; also disclosed horizontally moving switches, but none of the structures which show the platform show the switch, and none of those which show a switch show a platform for operation. On page 501 the Court says:

“No one previous to him had produced a practical horse-railroad switch which could be operated by the weight of the draft animals. Certainly no one had combined a tip-table with a horizontally moving switch-tongue.”

The principle, or mode of operation, of this com-

bination was, therefore, not disclosed by the prior art, and there was a new coaction of elements.

The first paragraph of the quotation shown on page 72 of appellant's brief appears to be appellant's construction of what the court said in the case of Forsyth v. Garlock while the second paragraph appears to have been selected from the case of International Telegraph Co. v. Kellogg Switchboard Co. The first paragraph is not an accurate quotation from the case of Forsyth v. Garlock in that the language is not qualified as it was by the Court. The language of the Court as found at the bottom of page 463 in the foregoing case is as follows:

"The respondents cite over forty patents alleged to either anticipate or narrow the art. Our general observation as to these is that the citation of so many patents by respondents in an infringement suit *sometimes tends*, as we have several times said, not so much to weaken complainant's position as to strengthen it by showing that the trade had long and persistently been seeking in vain for what the complainant finally accomplished."

The citations from the prior art in the foregoing case were found by the Court to be very remotely connected with the art under consideration, and it was by reason of the fact that they were not intended for a similar use that the Court failed to consider them as anticipations of the patent. Immediately following the quotation above given the Court goes on to say:

“So far as we do not further refer to these patents it will be because they are covered by what we have already stated as to their relation to other arts than that now before us; or because they are only a part of the history of the particular art involved here as explained by Pratt in the manner we have already stated. For example, Daft apparently had mainly in mind a material suitable for sheathing ships, as to which it is well known that at the time of his invention in 1860 ship builders were looking for a substitute cheaper than copper, then the standard sheathing. However this may be, he describes his invention as one for ‘improvements in coating iron.’ It was purely of a general nature in that broad art and it had no special adaptation to the narrow art which we have before us. While perhaps Forsyth might successfully be charged with infringing Daft, if Daft’s patent were in force in the United States, Daft did not anticipate Forsyth in the particulars to which Forsyth’s invention relates because Daft did not trouble himself about the peculiarities necessary to make a successful gasket.”

A like examination of the other patents referred to will disclose the fact that the citations which the Court had in mind were not citations which could have conveyed any knowledge to the skilled mechanic in the making of steam gaskets.

A similar examination of the citations which the Court had under consideration in the case of *International Telephone Mfg. Co. v. Kellogg*, 171 Fed. 651, indicates a similar situation.

Just following the words at the end of the quotation which counsel for appellants used, beginning with the last word on page 654, we find the following:

"Stromberg and Carlson (patent No. 580,434), prevented packing by the wedging and separating action of roughened electrodes, aided by elasticity of the plush circumferential wall. Stromberg-Carlson Tel. Mfg. Co. v. American Elec. Tel. Co., 127 Fed. 704. While the result, in one particular, was of the same general character, *the idea of means was totally different*. Nothing, of course, was taught respecting the granular carbon type by the earlier transmitters (Short, Berliner, and others) in which the electrodes were in direct contact."

Near the center of page 655 we find the following language:

"But neither the White patent nor anything else exhibited in the prior art would have told the mechanic why the changes ought to be made. The mechanic in Dean had first to be informed by the inventor in Dean."

We have no such situation with reference to the Gilchrist blocks. At the time Gilchrist made his application for patent it is conclusively presumed that the Morgan, Ludford, Labadie, and the Butters patents were all before him, each of which disclosed an interior reservoir in the side of the pulley block. The purpose of the reservoir in each of these pulley blocks was the same as the purpose of it in the Gilchrist pul-

ley blocks. The oil feeds from the reservoir by gravity through the pin and onto the bearing surface in the same way. It is the *inventor only who is protected* in his combination, *and not the mere mechanic* who combines old elements already well known in the art to perform their functions and without introducing any new mode of operation.

Were it not for the fact that the Collar-button Case involved an article of manufacture rather than an improved machine, and that the Court has so frequently held that the making in one piece that which was previously made in two is not invention, and the further fact that this particular article, a pulley-block side made in one piece was old in the prior art, the case of *Krementz v. Cottle* might then be considered as throwing some light upon the present controversy. The Court seemed to give considerable importance to the particular shape of the round hollow head and had treated the article largely as though it had under consideration a design patent. However, had there been a previous one-piece collar-button on the market, it would not have involved invention, and as stated in the case of *Herzog v. Keller & Co.*, 234 Fed. 85, near the bottom of page 86:

“The case must, however, be very rare in which the bare idea involves invention, to consolidate several members into one.”

The case of *Cimiotti v. American*, 115 Fed. 498, 198 U. S. 408, cited on page 78 of appellant's brief,

is clearly distinguishable from the Gilchrist-Mallory controversy. In the Ciniotti case the mode of operation of the device of the Lake and Covert patents referred to, as well as several of the elements, were different from those of the patents sued upon, and the opinion of the Supreme Court clearly indicates that if this old device had embodied the same mode of operation as that of the Sutton patent it would have defeated the Sutton patent.

As is set forth in another portion of this brief, it doesn't make any difference how old an article may be, or whether it is but a mere paper patent, patents are not granted to all persons who may have displayed inventive ability. It is only to the first inventor that the Government is authorized to grant a patent.

In the case of Waterbury Buckle Co. v. Aston, 183 Fed. 120, cited by appellant on page 75 of his brief, the Court had under consideration a patent for a rustless suspender buckle, calling for the combination with a frame having an upper and a lower side and an opening between the same, of a lever pivoted to the upper side of the frame in position to have its clamping edge co-act with the upper edge or top of the lower side of the frame, and a piece of webbing having its lower reach attached to the lower side of the frame and its upper reach pass from front to rear through the said opening and engaged by the clamping edge of the lever which deflects it approximately over the upper edge or top of the lower side of the frame.

While it is true that on page 122 the Court does use the language "that it seems necessary to examine only the LaChappelle patent, that being the nearest approach to the patent under consideration," there is nothing in the case to indicate that any of the elements of the patented buckle not shown by the LaChappelle patent were disclosed by any of the other citations, and in view of the numerous declarations of the courts to the effect that all of the prior art should be examined for the purpose of determining whether or not a claim disclosed invention, it must be presumed that none of these other devices contained any of the elements of the patented combination which were not disclosed by the LaChappelle patent.

In the case of *Kryptok Co. v. Stead Lens Co.*, 207 Fed. 95, cited on page 79 of appellant's brief, it is instructive to call attention to the fact that the quotations selected by appellant is based upon the decision in the case of *Loom Co. v. Higgins*, 105 U. S. 580.

The case of *oom Co. v. Higgins* is the leading case on this subject in the United States, and it is the one which is used as the authority for like statements of the Court in most all of the cases where it has been indicated that the invention is not overcome by the ability to find different elements of the device in previous devices in the prior art.

A thorough understanding of the case of *Loom Co. v. Higgins* will immediately dissipate any belief that a combination patent may be sustained if all its elements are found in the prior art, performing the

same function in a machine having the same mode of operation. It was the change in the mode of operation resulting from a new co-relation, or co-action, of parts which resulted in the construction of a loom with a far greater capacity by reason of the higher speed with which it could be operated that marked invention in that case.

It is interesting to note that in paragraph 6 on page 94 in the case of *Kryptok Co. v. Stead Lens Co.* the Court recognized the distinction between a product patent and a mechanical, or machine, patent, for the Court there uses the following language:

“This is a product patent case. The thing produced was clearly unknown before, and it is, therefore, immaterial that the separate features of the invention may be found in the prior art.”

However, an examination of the citations of the prior art in this case discloses the fact that there was nothing in the prior art to indicate that a bi-focal lens could be produced by the fusion of another piece of glass of different register in a recess provided in the main lens whereby the bi-focal lens is biaxial. The devices of the prior art referred to showed only lenses in which a small lens was fitted in the lower section of the main lens of the same thickness of the original lens, with their edges cemented together, or in which a small lens coming to a feather edge was cemented onto the regular lens, and lenses in which a colored piece of glass was welded to a transparent piece of glass, not for the purpose of obtaining a bi-focal lens, but for the purpose of protecting the eye against

light, it having theretofore been considered impossible to fuse upon the eyeglass an additional piece of glass in such a manner as to produce a bi-focal, biaxial lens.

There is nothing in this case which should cause the Court to disregard all the prior arts excepting the one patent which the complainant himself selects as the nearest to anticipating his device.

In *Underwood Typewriter Co. v. Elliott-Fisher Co.*, 165 Fed. 927 the Court had under consideration the Remington tabulator patent. The patent relied upon as an anticipation of the claims of this patent failed to show this combination or use of stopping devices. In fact, the Court was unable to tell just what sort of device or mechanism was intended from the description in the patent cited as an anticipation. In view of this situation the Court very properly refused to consider the cited patent as an anticipation of the Remington tabulator patent.

The case of *Badische Anilin & Soda Fabrik v. Kalle & Co. et al*, 104 Fed. 802, probably discloses a proper statement of law applicable to the facts involved in that case. The Court had under consideration a chemical formula for the preparation of dye-stuffs and it is quite probable that the publications referred to did not disclose sufficient information to operate as an anticipation of complainant's formula.

At any rate, I do not feel that a digression in the

field of chemistry, will prove of much assistance to the Court in determining this controversy.

Likewise, the quotation from *Loew Filter Co. et al v. German-American Filter Co.*, 164 Fed. 855-860, may be a proper statement of the law, but it is most strenuously insisted that the devices of the prior art as disclosed in this case are of such a nature that it does not require the exercise of any imaginative faculty in order to find that there was no room left for invention, at the time the Gilchrist device was brought upon the market.

In the case of *United States Fastener Co. v. Bradley*, 149 Fed. 222, cited by appellant on page 83 of his brief, the Court sustained a patent for a separable button, catch or glove fastener comprising an apertured washer and an eyelet having a shank of less diameter than the aperture of the washer, and having two enlargements securing it in the aperture of the washer and slitted lengthwise through the shank and enlargements as and for the purposes set forth. In the glove fasteners of the prior art the resilient member had usually been the head, although there were two devices in which the socket was slit so as to spread and receive the head and afterwards spring back upon the same. The manner of fastening these sockets to the material was such that the material was required to give with the socket and it was hard upon the material. The socket of the patent having a washer to sustain and hold it in place on

the shank of the eyelet made a much firmer device and it was so formed as to relieve the strain upon the material and was held to possess novelty and disclose patentable invention. However, in the very next case reported in this volume of *United States Fastener Co. v. Stahel et al*, page 225, the Court had under consideration the patent for a button, or snap fastener, in which the head or socket member, was the resilient member of the catch. The resilience of this head or socket member was brought about by making the same of metal, and in dish shape, so that the edges of the head bent over on itself and extended to form a flange that extended rearwardly and inwardly. On page 225 the Court says:

“It would, in my judgment, occur to any mechanic or person skilled in the art. It is plainly suggested in prior inventions in the art.”

After referring to previous statement and decision of Judge Coxe, the Court says:

“But this condition of the art does not warrant the upholding, as disclosing patentable novelty and utility, every device, not before used in the art. When a device made the subject of a claim is so plainly indicated in the prior art that one possessing ordinary skill therein will naturally see it and its construction and utility, we can hardly accredit him with inventive skill if he does see it, and puts it in form for use.”

In the case of *John Kitchen, Jr. v. Levison*, 188 Fed. 658, this Court had under consideration the

Levison patent to a manifold order book, comprising a double carbon sheet and a plurality of recording sheets, each recording sheet outside the stub being divided into a plurality not less than three of separable parts joined along the line of perforations, each part being not greater than the parts next it on the side towards the stub, and a carbon sheet extending the width of the whole of said parts, excepting the outermost, said recording sheets having stubs to which they are attached along lines of perforations, said stubs and one side of carbon sheet being all bound together to form a book, substantially as described.

The prior art did not disclose a combination of the carbon sheets bound in the book in connection with folded leaves whereby the one carbon sheet could be utilized for making all of the carbon copies. There were books in which loose carbons were used between the several copies of the order sheet, and also a book in which a double faced loose carbon was used between the second and third copies, the second copy being a transparent copy so that the carbon would show through it. The Court held that the patented device stood the test of invention, although the change from the prior art was a simple one.

The Court held that while the advancement was slight, the article was one of manifest utility and that it would give the patentee the benefit of its decision on the question of fact as to its constituting invention.

Inasmuch as counsel for appellant in this case was counsel for the defendant in the foregoing case, it is barely possible that the decision of this Honorable

Court in that case has encouraged him to believe that he may induce the Court to go even a little further than the courts have gone in the so-called "twilight zone" cases for the purpose of sustaining the Gilchrist patent.

Counsel for appellant in classifying the Morgan, Ludford and Labodie patents and the other publications as coming under the rule laid down in the cases cited on page 84 of his brief, has availed himself of a license for comparison and classification of such wonderful elasticity that I feel an appropriate answer to the same would be to boldly state that the Morgan, Ludford, Labadie, Gilley, Butters and all other patents and publications cited by defendant are wholly without the rule laid down in these cases, operate as a complete anticipation and show utter lack of invention, and then refer Your Honors to the various patents and publications introduced in evidence and request you to see the rule laid down by the reports in the Supreme Court library.

The Morgan, Ludford, Labadie, Gilley and Butters patents are not publications embodying indefinite descriptions concerning which there is doubt as to their meaning, or as to the time of publication, but on the contrary, are intelligible drawings and specifications of patents concerning the date of which there can be no doubt, and there is nothing vague or uncertain as to the mode of operation of the devices therein described. As to the other publications, they were in-

troduced principally for the purpose of corroborating the testimony of witnesses as to the time when the devices therein described were in existence. These publications and this testimony being well sustained by the introduction of the actual devices so described. Complainant's own witnesses, and even complainant's counsel, admitted the correctness and accuracy of this testimony and finally consented to stipulate that each of the devices was old in the prior art, excepting that Brother Peck as attorney for complainant refused to admit that an interior oil reservoir in one of the sides of a pulley block was old in the prior art, even in the face of the patents so introduced.

There is no such complicated or doubtful situation as was presented by the telephone cases referred to, but even in the telephone cases the decision cannot be considered as having the force which could have been attributed to it had there not been a dissenting opinion by Justices Bradley, Field and Hart.

In the case of *Seymour v. Osborne*, 78 U. S. 23, 11 Wall. 516, the Court had under consideration a patent for a harvester in which the grain fell upon a quadrant platform and was swept off by sweep rakes in quantities appropriate for binding, and at the rear of the harvester in such a position as to be out of the path of the harvester on the succeeding round or trip. Most of the devices referred to as part of the prior art were not publications but mere experimental devices described only by testimony which was uncertain both as to time and use. And as to these

prior publications, or devices, concerning which there was certainty, none of them embodied the self-raking device or the true quadrant platform, the nearest approach being a rectangular platform to which was attached an additional curved portion, which required the services of a man to rake the grain off of the platform by hand.

In the case of *Cohn v. U. S. Corset Co.*, 93 U. S. 366, 23 L. Ed. 907, while there was a dissenting opinion by Judge Clifford to the effect that the foreign patent was not sufficiently described to enable a person skilled in the art or science to make, construct and use the same, the prevailing opinion of the Court written by Justice Strong was to the effect that the English patent was sufficient to operate as an anticipation to the patent sued upon, and the patent sued upon was therefore declared invalid and the bill dismissed.

Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 421.

Had counsel for appellant added to the quotation which he has used on page 84 of his brief from page 421 of the foregoing case, the very next sentence, he would have disproved his own contentions that the statement from this case is apt. The very next sentence following that quoted by appellant is as follows:

“As hereinafter observed, a *process patent* can only be anticipated by a similar process. It is not

sufficient to show a piece of mechanism by which the process might have been performed."

It is a matter of common knowledge that a process which involves chemical actions upon the materials worked upon, might, with very slight changes, either enhance or entirely destroy the ultimate product, and yet the mere process itself may in no way indicate to the person what might be the effect of such a slight change.

But in a mechanical patent for an improvement upon a machine, by the introduction of an element having a well known function, the effect of the introduction of such elements is immediately apparent to the human eye, unless it is being combined with other elements or operative parts of the mechanism in such a way that they co-act one upon the other and introduce a new principle, or new mode of operation.

The barbed wire patent, 143 U. S. 275 was considered in the case of *Knapp v. Morss*, 150 U. S. 221, 37 L. Ed. 1059. In this case various other cases on the subject of a combination of old devices are well considered. The Court held that an adjustable wire dress form would even be anticipated and held void on account of the umbrella.

In the case of *Western Electric Co. v. Home Telephone Co. et al*, 85 Fed. 649, the Court had under consideration a patented device for an improvement in the telephone switchboard. The thing which the

patentee was attempting to accomplish was to effect a more perfect circuit between the connecting lines by reducing the resistance at the switchboard and giving as far as possible a perfect, unbroken circuit, and at the same time having such a switchboard as to enable the operator to test out the lines. It was thoroughly explained that a telephone circuit is a weak circuit, and that every connection or contact which is made necessary tends to reduce the efficiency of its qualities for carrying the human voice. The slight particles of dust, or other foreign materials, which lodge in the connections, tend to reduce the efficiency, thereby making it highly essential to have as few exposed contact points as possible. Near the bottom of page 654 we find the following language:

“But defendants’ witness Clark, responding to cross questions 48, 49 and 50, says he does not find in patents Nos. 292,866, 330,059, and 330,060, that, when two lines are connected together, without reference to the particular board upon which the connection is completed, there is a talking circuit which is free from all of the separable switch contacts of the spring-jack switches of the two lines thus connected, as such feature is exhibited in defendants’ system and in the Scribner patent No. 330,061 in suit. This witness was asked to distinguish and point out any differences that may exist between patents Nos. 292,866, 330,059, and 330,060, and, after detailing alleged differences, he states that he finds that the patent No. 292,866 is the same as the patent No. 330,061, the patent in suit, with certain exceptions, which he specifies. What-

ever, then, be the merit or demerit, or the accuracy or inaccuracy, of these statements and discussions, it remains that the patents mentioned do not, as they now exist, according to the witness, contain the invention covered by complainant's patent, but, on the contrary, that changes must be made in them before it is even pretended that they will show this invention."

This is as near as the reported case comes to explaining the likeness or differences between the patent sued upon and those of the prior art relied upon as anticipations. When we take the statement of defendants' witness, as above given by the Court, that he does not find in the prior patent means whereby the lines are connected together without reference to the particular board upon which the connection is completed so as to form a talking circuit which is free from all the separable switch contacts of the spring-jack switches of the two lines thus connected, which is the very object at which the patentee was striving, namely, to reduce the points of contact, and when we realize that the efficiency of a telephone system is dependent upon the reduction of the contacts and the perfection of the contacts, there is no reason to believe but what the Court was correct in the conclusion it came to in this case.

The dealing with an electrical current, or circuit, for telephone purposes, such as was under consideration in the foregoing case, is an art of such refinement that the distinction of the differences must be very closely drawn by the Court. But, in a pulley block,

where we are dealing with a mechanical construction, in which the function of each element is plain and obvious, and its function and known connection with the entire device, needs no explanation and requires no refined insight into the delicacies of its mechanism, it certainly cannot be said that the functions of these elements in the prior art are not obvious to the ordinary individual, and much more so to the skilled mechanic.

In the case of *Clough v. Barker*, 106 U. S. 175, referred to by counsel on page 85 of his brief, the Court had under consideration a patented gas jet, or burner, provided with perforations near its base, allowing the gas supply coming from the inner tube to the surrounding tube to be controlled, and so as to permit gas to come from the face of the tube, the purpose thereof being to control carburated gas from the burner to the point of combustion. The device relied upon as an anticipation was a gas burner in which an outer tube surrounded an inner tube having a slit in its side, the outer tube coming to a cone shape at the top and having the ordinary batwing burner opening. The purpose of the slit in the side was wholly for the purpose of controlling the amount, or supply, of gas that the burner took, without any reference to carburation of the same. The screwing down of outer tube would result in the pressing of the cone-shaped top of the outer tube, or burner, upon the upper and outer edge of the inner tube so as to close the slit and thereby cut down the supply of the gas flow. The screwing up of this

outer tube would allow the gas slit in the inner tube to spread and furnish a larger quantity of gas. There was no intention to control the gas supply at the base of the burner with the view of in any way furnishing carburated air or in any way changing the effect of the gas from its supply source to the tip. Any such result, if any existed, was merely incidental. The Court held this not to be an anticipation of the gas burner designed with perforations at its base, with means of controlling the supply at the base, so as to furnish the proper amount of carburated gas at the burner tip, it being found that the old slit gas burner, when in perfect working condition, had no discharge of gas near the base, and none was intended.

A comparison of this case with the devices now under consideration shows the inaptness of the citation. Gilchrist designates the object of his invention as follows:

“It is the object of this invention to provide a pulley which will contain a considerable quantity of lubricant and feed the same automatically and slowly upon the bearing pin of the pulley.”

This was certainly the express purpose of the oil reservoir in the side of the Butters' pulley block, the Labadie pulley block, the Ludford pulley block, the Gilley pulley block and the Morgan pulley block. Butters describes his improvement as relating to means to provide a lubricant for moving parts subject to strain that will be durable and not require frequent renewal,

so that the pulleys will not be liable to get dry or rusty, or be unduly subject to wear. What was provided in the Gilchrist pulley block which was not actually provided in the Butters pulley block? A like comparison with the other exhibits shows that the very object of the oil reservoir could be for no other purpose than to provide a considerable quantity of lubricant to feed automatically and slowly upon the bearing of the pulley block and give the same the exact advantages which were sought to be accomplished in the Gilchrist pulley block.

The description of the Morgan patent, referred to in this case, is certainly free from any ambiguity which would make it impossible for one skilled in the art of making pulley blocks to make this pulley block with an oil reservoir in the side, embodying the same law, or mode of operation, disclosed by the Gilchrist patent. The description of the Morgan patent is certainly as distinct and clear as the description of the English patent to John Henry Johnson, referred to in the foregoing case of *Cohn v. U. S. Corset Co.*, so that the rule laid down in that case could be admitted without detriment to the defendant in this suit concerning the effect which the Morgan patent and other exhibits have upon the validity of the Gilchrist patent.

The authorities hereinbefore considered are comprehensive and complete on the question of what constitutes the prior art and the necessity of testing the

question of invention by all that is found in the prior art. The testimony and exhibits introduced in the trial Court, and as shown by the record now in this Court, are of such a clear and decisive nature, and these exhibits and publications speak so strongly for themselves, that I feel it is unnecessary to give any consideration to the questions as treated and considered on pages 71 to 90 of appellant's brief.

Appellee's case is not dependent upon vague or ambiguous publications, nor upon uncertain testimony concerning the prior art. However, as stated by Justice Reed in the case of Railroad Supply Co. v. Elyria Iron Supply Co., 61 L. Ed. (U. S.) at page 1142:

"Prior devices described in letters patent, though not used practically, and needing alterations to adapt them to practical use, are anticipations."

(Citing a great number of cases.)

It is quite probable that much of the testimony of expert witnesses could be dispensed with. I believe I am in harmony with the theory that expert witnesses should be used sparingly. However, the expert witnesses were in Court and counsel for complainant probably occupied as much time in examining and cross examining these expert witnesses as did counsel for defendant.

However, the evidence, exhibits and publications of the defendant are of such a clear and decisive nature that they will speak for themselves no matter what may be said as to the constructions placed upon them by the experts.

The concluding cases cited by counsel on page 99 of his brief are inapt and not in point for the following reasons:

In the case of *Auto Vacuum Freezer Co. v. Sexton Co.*, 239 Fed. 398, the patentee was a pioneer and while he had created a simple device in the form of an ice cream freezer, the same had gone into extensive commercial use and is said to have created a new industry. There were no questions of prior use nor anticipations by prior patents or publications. It was simply a question as to whether or not the patentee as a pioneer had shown sufficient novelty and ingenuity in his alleged invention to be rewarded by the grant of a patent. Under such circumstances the public was receiving something new and was being deprived of nothing which had previously belong to it, and the Court was probably correct in sustaining the patent.

In the present case the appellant has created nothing new. He has not devised a new mode of operation nor a single new element to be embodied in a combination machine operating under an old mode of operation. He was preceded as to all by not only patents and publications but also by prior use, and he therefore stands more in the position of the patentee in the case of *Grinnell Washington Machine Co. v E. John Co.*, 247 U. S. 426, 62 L. Ed. 1196, who brought together the combination of the wringer and the washing machine operating as a unitary device. In fact, he has displayed much less invention than did the patentee in the last mentioned case, and in that case

the United States Supreme Court, speaking through Justice Day, used the following language:

“Phillips may have produced a more convenient and economical mechanism than others who preceded him, but superiority does not make an aggregation patentable. *Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co. supra.* The assemblage of the old elements and their operation in the manner indicated may save time, and the mechanism may meet with a readier sale than other similar devices, but these things may result from mechanical skill and commercial enterprise, and do not necessarily involve invention.”

The patent was, therefore, declared invalid for want of invention.

In the case of *Topliff v. Topliff*, 145 U. S. 156, the combination of the patent under consideration pertained to a spring equalizer whereby a transverse rods extending from the spring on one side of the carriage to the spring on the other side and having their axis in the links at the end of the springs, and arms set off or extending therefrom and, attached to the springs at each side in such a manner that if the load was placed on one side of the buggy the depression of the spring would turn the rod on its axis and cause an equal depression of the springs on the other side of the buggy.

The device relied upon as an anticipation of this patent was not intended as a spring equalizer and was not provided with an axis attached to the springs

so as to work as an equalizer, but on the contrary, the device comprised rods extending from one spring to the other in a manner and for the purpose of protecting the carriage and springs against the wracking or diagonal strains to the springs and buggy. The same could not operate as a spring equalizer of the nature in the patent under consideration without being reconstructed and modified for that purpose.

On the other hand, as to all of the oil reservoir blocks which the defendant introduced in this case, as well as the patents and publications, including the Morgan block, the very purpose of the oil reservoir provided in said blocks was the same as the purpose expressed by the appellant in his patent, as his purpose for providing the same, and these blocks embody the same mode of operation.

The case of *Klein v. Russell*, 19 Wall. 433, pertained to a process for treating lamb or sheep skins and is not sufficiently analogous to call for consideration in connection with this case.

The case of *Columbia Wire Rope Co. v. Kokomo*, 143 Fed. 116, is of no importance as an authority in this case for the reason that devices of the prior art are not explained and the fact was practically conceded by appellee's expert that the combination in the patent is both new and useful and within the objects of the patent law.

The case is devoted principally to the question of defendant's infringement. However, the case is of

some interest by reason of the fact that the modifications and differences existing between defendant's device and the complainant's device in that case were considerable and the defendant was held to have infringed.

Under the rule—"that which infringes if later would anticipate if earlier"—the case could be construed as an authority for showing that the appellant in this case had been anticipated.

The case of *Keystone v. Adams*, 151 U. S. 139, pertains to the corn sheller patent which has been heretofore considered. The patentee in this case was shown to have introduced a new mode of operation in his machine.

Appellant's title as an inventor in this case is not nearly as good as that of the owner of the Voightman patent No. 600,186, for fire-proof window, reported in 133 Fed. 934. In the last mentioned case the patentee had brought together an automatically closing sash consisting of the combination of a fire-proof casing, a fire-proof sash pivoted therein with a retaining chain having a fusible link so that when subjected to heat the fuse would melt and the window would automatically close. The patent was determined to cover a mere aggregation. On page 936 we find the case of *National Cash Register Co. v. American Cash Register Co.*, 53 Fed. 371 (cited on page 19 of appellant's brief), embodied in the following words:

“That a combination, to be patentable, must produce a new and useful result as the product of the combination, and not a mere aggregation of several results, each the complete result of one of the combined elements. (National Cash Register Co. v. American Cash Register Co., 53 Fed. 371, 3 C. C. A. 559).”

Expanded Metal Company v .Bradford, 214 U. S. 366:

This suit involves the patentability of a process and machine by which expanded metal, or what is sometimes termed “metal lath,” is made. Metal had previously been slit and then stretched so as to make openings. This process was slow and did not give perfect uniformity to the links or openings, and the stretching of the material for making the openings would shorten the sheet of metal in the direction in which the slits ran. The patented process and machine involved in this case stretched each link or side of the slit as soon as it was cut by pressing down the portion or strip, just after cutting, in a right angle direction from the plane of the sheet yet uncut. This process was much faster than any previous process, and the pressing down of each portion immediately after the cutting thereof, while the remainder of the sheet was still uncut, made each link or hole of exactly the same uniform shape and size and stretched each link to the same extent, so that the finished product would be uniform and would also retain the same width as the sheet from which it was made.

On page 379 there appears the following language of the court:

“If all that Golding did was to show a method of *simultaneous cutting* and stretching metal, the examiner was doubtless right in holding it to have been anticipated by the former inventions, notably the patent to Ohl, No. 475,700, and in a degree, in the previous patents to Golding and to Golding and Durkee.

“But the patent in suit embraced in the claim allowed, shows more than a mere method of making open meshes by simultaneously cutting and stretching metal. It shows a method by which the metal is first cut and stretched in the manner indicated to make the half diamond, and then a second operation, *co-ordinating with the first*, and completing the mesh by the manner in which it is performed in connection with the first. It is the result of the two operations combined which produces the new and useful result covered by the claim allowed in the Patent Office, and which, when read in connection with the specifications, shows substantial improvement in the art of making expanded metal work.”

Diamond Rubber Co. v. Consolidated Tire Co.,
220 U. S., 423:

In the case of Diamond Rubber Co. v. Consolidated Tire Co., 220 U. S., 423, the Court had under consideration a patented wheel, or tire, embodying a felly having a strip of metal or channel iron fitted thereto in such a way as to receive the rubber tire and retain it on the

wheel, but still allow the same to creep or spring from its fixed position, after which it would readily reseal in the channel of the felly.

This channel had a flat central portion and flange angling outwardly to each side of the felly. The tire was provided with wires running through the same so as to prevent the springing of the tire to such an extent as to come off the wheel. The inner surface of the tire was similar in shape to the channel iron in which it was seated, but angled inwardly from the flanges of the channel iron so that the angles of each side of the rubber tire formed at the point where the tire changed from an outward angle to an inward angle was below the edges of the flanges of the channel iron. It was this particular formation which gave to the tire its resealing capacity. The outwardly projecting flanges were such as to allow the tire to creep or spring to one side, after which it would immediately reseal itself by reason of the flanges of the channel converging toward each other in the direction of the hub of the wheel.

All previous rubber tires were either cemented fixedly to the fellys of the wheels or were attached in channels in which the flanges were inset, thereby forming clinchers which held the tires fixedly in place so that they were subject to greater damage by coming in contact with rocks or other obstructions on the road.

On page 443 appears the following language of the Court:

“The tire company gives a definition of the ‘something’ as tipping and resealing power. The rubber

company earnestly denies the existence of the power, and, as we have seen, the Court of Appeals for the sixth and second circuits divided in opinion on its existence. We think such power is possessed by the tire. This is shown by the evidence and was shown at the oral argument. *And it is the result of something more than each element acting separately. It is not the result alone of the iron channel with diverging sides, nor alone of the retaining bands or the rubber. They each have uses and perform them to an end different from the effect of either, and they must have been designed to such end, contrived to exactly produce it."*

While the foregoing case was sufficiently close so that two circuits had differed upon the question of fact as to whether or not there was a correlation which produced some new result so as to be something more than a mere sum of the separate functions of the elements of the combination, it was only after the appellate court had found upon the question of fact that there was a new result or mode of functioning by the co-action of the separate elements that it finally determined the patent to have validity.

It was the same application of law which runs through all of the cases, namely: Before the Court can find that a patented combination is valid, it must find as a question of fact that there is some new correlation between the elements, producing something more than a mere sum of the separate functions of elements found in the prior art.

ARGUMENT.

In a case of this nature it is always difficult to determine just how to arrange a brief so as to make it most useful to the Court. The number of legal questions which have been raised in this controversy, and which have been dealt with in this brief, are so numerous, the Court's time is so precious and the number of these various questions upon which the Court is undoubtedly well informed is so large, that I felt it advisable to treat in proper sub-divisions the principal legal questions under the head of "Points and Authorities," without intermingling therewith much of what can be strictly considered "Argument," or reference to the facts as disclosed by the record in this case.

The alphabetical index of cases and the topical index to points and authorities will enable the Court to quickly turn to those portions of the brief with which it may be most vitally concerned. However, I trust that the portion of this brief which is denominated "Argument" may also prove of some assistance.

In the first place, it should always be borne in mind that invention is a question of fact which must be determined by first taking into consideration the prior state of the art, both as to all patents and publications and as to all devices which have been in actual use, after which the question of invention is to be determined by the application of well established rules of law.

The order in which the rules of law are applied in a given case substantially affects the amount of work which may be required to finally arrive at a determination of the issues involved.

For example, if one were to study the patent without first giving due consideration to the prior state of the art he would necessarily need to consider whether or not certain devices or combinations were the result of the exercise of the inventive faculty or displayed a mere exercise of mechanical skill. These questions may be greatly reduced in number or wholly eliminated from consideration upon finding that like devices or combinations were part of the prior art.

Then again, it is not unusual to find a device so described in a patent specification as to cause one to feel that the same discloses true invention, but upon turning to the claims of the patent it may readily be seen that most of that which was considered as disclosing invention may have been recognized by the patentee to have been old in the prior art, or may have been dedicated to the public by not being properly covered by the claims as drawn. (See pages 23, 24, 27, 28, 108, 113, 114 and 115 of this brief).

In the process of applying rules and thereby eliminating questions which it may be found unnecessary to consider, the rule concerning the prima facie presumption of the validity of a patent by reason of its issuance and the rule that the commercial success of an article may some times be considered, are the very last rules which should be applied by the Court. They should never be resorted to unless, after applying all

of the other tests of invention, the Court still feels that the patent may disclose invention, and does not know which way to decide the question. It is then, and then only, that the Court is authorized to give any weight to these presumptions. (See pages 30 to 36 of this brief). These presumptions are mere rules of evidence which cannot usurp the judgment of the Court. (See page 33 of this brief). As is well stated in the quotation on page 34 of this brief, these presumptions "cannot be used to resolve the doubt as well as to create it, else every useful and successful thing would be patentable." On the contrary, as is shown on pages 19, 29, 108, 113, 114 and 115 of this brief, the Court should ever be alert to protect the rights of the public against patent monopoly, and within the language of *Atlantic Works v. Brady* (page 19 of this brief), should not assist speculative schemers "to watch the advancing wave of improvement and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts."

In this case any presumption which might otherwise have been indulged in to sustain the validity of the complainant's patents is wholly overcome and destroyed by the file wrappers of these patents, when read in the face of the prior state of the art. (See pages 30 to 33 of this brief).

In patent No. 977,613 the patentee has stated in the specification that he has invented a new and useful pulley block, the object of which invention, as

pointed out by the patentee is "to provide a pulley which will contain a considerable quantity of lubricant and feed the same, automatically and slowly, upon the bearing pin of the pulley" and also "to provide a pulley, the bearing pin of which is adequately protected against dirt and dust." (See lines 24 to 28 and 33 to 35, page 1, of specification).

By turning to pages 84 and 85 of this brief it will be found that a pulley-block is a simple machine, and further that the patent law makes a distinction between a machine and an improvement in a machine. It will also be found that "in the eye of the patent law a machine is an artificial organism governed by a permanent artificial rule of action," that "the unity of a machine also resides in the same rule of action," and that "whether composed of single organisms or of several subordinate organisms, as a machine it is a unit, and is destroyed whenever any change, addition, or withdrawal of its elements results in the alteration of its structural law," but that "while this law remains undisturbed, any such change, addition or subtraction is at the most an improvement on the old machine, however marked may be the effect produced upon its shape or usefulness."

It may be admitted that if the appellant herein was the first person to devise a pulley-block provided with a chamber for the holding of oil together with means for conveying said oil from the chamber to the bearing of the pulley, that he would have been the inventor of a new pulley-block, as there would have been a new mode of operation disclosed by the means

be based upon the invention of a new and useful pulley-block. (See first two quotations from *Griest Mfg. Co. v. Parsons*, 125 Fed. 116, 119, page 44 of this brief; quotations from *West Coast Safety Faucet Co. v. Jackson Brewing Co.*, and *Union Edge Setter Co. v. Keath*, page 53 of this brief; quotation from *Ft. Pitt Supply Co. v. Ireland & Matthews Mfg. Co.*, last paragraph, page 74 of this brief; quotations from *Union Paper Bag Machine Co. v. Murphy*, page 82 of this brief; quotation from *Smith v. Nichols*, pages 83 and 84 of this brief).

Claim 1 is the broadest of the three claims and contains all of the elements pertaining to the lubrication of the pulley block.

The Court is, therefore, immediately confronted with the question as to whether or not complainant's patent is not void upon its face as to everything, excepting one claim for a new and useful pulley block, for the reason that complainant has not complied with Sec. 4888 R. S., in that he has failed to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." (See page 18 of this brief, also authorities on pages 109, 110, 113, 114 and 115 of this brief).

In the case of *Seymour v. Osbourne*, 11 Wall. 516 (cited in appellant's brief, we find the following language on this subject:

"When the invention is an entire machine, the claim is sufficient if it is clearly co-extensive with the machine; and where the invention is a part of the

for lubricating the pulley-block; but the matter of adequately protecting the bearing pin of the pulley against dirt and dust could not be the subject of a patent for a new machine or a new pulley-block, as there would be no new mode of operation. However, it might be the subject of a patent for an improvement in a pulley-block (or machine), by reason of the new or added element of a dust guard, providing no such device could be found in the prior art, and provided, further, that the adding of such dust guard displayed something more than the mere development or improvement of the device such as would be provided by a mechanic skilled in the art upon finding from experience that difficulty was encountered by the way of dust and dirt getting into the bearing.

By now turning to the claims in issue as analyzed on pages 7, 8 and 9 of this brief, we find that there is no law or mode of operation set forth in any of these claims other than what may be found in the most ancient form of a simple pulley-block except that which pertains to the lubrication of the pulley block.

The same means are employed and the same mode of operation is utilized as to the lubrication of the pulley in each of the three claims in issue. As the same mode of operation is set forth in each of the three claims in issue, it is impossible for all three of these claims to be valid claims for a new and useful pulley-block and the patent, therefore, discloses upon its face that there can be but one claim which could

machine or manufacture, that part must be clearly indicated in the claim which covers it."

If each of the three claims in issue disclosed a new and useful pulley-block embodying a new mode of operation different from what could be found in the prior art or in either of the other claims, the language of these claims might be considered sufficient under the statute and the authorities cited. It would then be all of the elements of the pulley-block as a unitary device which the patentee would be claiming as his invention.

All of these claims seem to have been drawn upon the theory that it was only necessary to enumerate the separate elements of the combination and then leave it to the public to find out wherein the improvement had been made, but this is not the law and under the authorities hereinabove referred to the complainant cannot now ask the Court to reconstruct his claims for the purpose of giving them validity.

Now passing to the question as to whether or not any of the claims disclose a new and useful pulley-block (machine) and bearing in mind that the complete mode of operation is the same in each of these claims, and bearing in mind that the only thing upon the face of the claims themselves which could mark them as disclosing a new and useful pulley-block would be that of providing a chamber for the holding of lubricant which could be fed therefrom to the bearing pin, we may then turn to the prior art to see whether or not there is anything new in the mode of operation so disclosed in these claims.

By defendant's Exhibits C and D and the testimony of Mallory, Borquist, Geary, Taylor and Younie, referred to on page 2 of the "Statement of Facts," the evidence was undisputed and overwhelming to show that pulley-blocks provided with oil reservoirs in the form of elbows, elbow extension reservoirs and grease cups combined with all of the other elements disclosed in each of the three claims in issue had been generally manufactured, sold and used in the Pacific Northwest for at least three years prior to the time that the complainant applied for his patent, and that many of these pulley-blocks had been in general use since 1903.

By defendant's Exhibit KK it is shown that one Henry Smith obtained U. S. patent No. 115,248 in May, 1871, upon a pulley-block provided with a lubricant chamber, and that even in this patent Smith disclaims the invention of a self-lubricating pulley-block broadly.

Defendant's Exhibit 4C, being for U. S. patent No. 349,691 issued to H. Butters September 28, 1886, and defendant's Exhibit OO, being U. S. patent No. 390,341 issued to Brown October 2, 1888, each discloses a self-lubricating pulley block.

Defendant's Exhibit QQ also discloses that U. S. patent No. 513,067 was issued to James R. Labadie January 16, 1894, in which there is disclosed every element of each of the claims of complainant's patent No. 977,613 which are in issue, excepting as to the element of a detachable top which is shown to be considerably different in structure from that covered

by the Gilchrist claims. And after introduction of the various exhibits, including the patents set forth on pages 3 and 4 of this brief, the controversy was finally narrowed down to the single issue of whether or not the one element of the side provided with an interior oil chamber as described in the Gilchrist claims would be sufficient to give validity to the claims in appellant's patent.

As heretofore set forth, the circumstances are such that there could be no patent for a new pulley-block as the prior art discloses that the mode of operation described in the claims was old at the time of appellant's application for patent.

The appellant himself did not take the witness stand and there was, therefore, no showing which would carry the date of invention back prior to the date of the application for the patent.

In view of the fact that the patentee has claimed a new pulley-block, and in view of the laws hereinbefore referred to concerning the distinction between new devices and improved devices, and concerning the necessity of specifically setting forth the exact improvement where an improvement only is claimed, it is respectfully submitted that the Court cannot reconstruct the specifications and claims of appellant's patent for the purpose of giving it validity, and that the Court would be justified in declaring the patent No. 977,613 invalid upon this showing alone.

It is contended by counsel for appellant that the problem or task which the complainant had to solve

was that of providing a pulley-block which would withstand the strains to which it would be subjected in logging operations, and also provide an adequate chamber for containing a considerable quantity of lubricant and feed it upon the bearing pin of the pulley-block. It is then contended that the patentee solved this problem by providing a pulley-block with an interior oil chamber in one of its sides, cast in one integral piece in such a manner as to make a stronger side without using any more metal, and at the same time avoid the seepage of oil through sutures of the chamber.

Counsel for appellant then point to the commercial success of the article and argue that they have at least disclosed a doubtful situation, and that by reason of the issuance of the patent and the commercial success of the article, the Court should construe this doubt in appellant's favor and declare the patent valid.

Attention has heretofore been called to the fact that the specification of patent No. 977,613 indicates that the patentee claims to be the inventor of a new and useful pulley-block, and does not confine the claim of the invention to the improvement of a pulley-block. As has heretofore been stated, the claims also seem to have been drawn upon the theory that each of the claims covered a new pulley-block (or machine) as there is no attempt to point out the particular improvement.

If each of the claims in issue described a new and useful pulley-block, in the sense that a new mode of operation was therein set forth, the mere enumera-

tion of the various elements of the combination would be sufficient without particularly pointing out wherein the pulley-block had been improved. But as stated in Robinson on Patents, Vol. 1. page 296 (heretofore referred to) the law which requires particularity and distinctness in the claims of a patent applies with special force to claims for an improvement.

The contentions heretofore referred to which are advanced by appellant's counsel concerning the presumption of utility and invention from the commercial success of the device, would be asking the Court to disregard the well-established rules of law for testing the question of invention. It would be asking the Court not only to disregard the separate consideration of each of the claims but to disregard the claims entirely and take into consideration only the device as actually manufactured and placed upon the market.

One of the greatest dangers in giving any consideration whatever to the commercial success of an article, is that the Court may overlook the fact that it is something other than that which is covered by a claim of the patent which accounts for the commercial success of an article. It would be hard to find a better illustration than what is afforded by the contention of counsel for appellant in this very case. Counsel contend that the patentee solved the problem of providing a pulley-block with a side and oil chamber cast in one integral piece so as to withstand the strains and avoid the seeping of oil through sutures, but there is not one word in any of the claims to indicate that this was the subject of the grant in the

patent. Within the language of the case of *White v. Dunbar*, 119 U. S. 51, quoted from on page 72 of this brief, counsel for appellant would have the Court make out of the claim a "nose of wax" and then twist it even more than by first considering the claim as a claim for a new device and then as a claim for an improvement in an old device; counsel would have the Court not only make of the claim a "nose of wax" to be twisted and turned to suit the convenience of this case; they would also require the Court to sever entirely the "nose of wax," forget the claims of the patent, and place the "nose" upon the article as manufactured.

Consideration will now be given to each of the claims separately for the purpose of ascertaining just what exclusive rights each of the claims purports to grant to the patentee.

Taking up first Claim 1, we find the same to contain a mere enumeration of elements without reference to any particular improvement. Turning to the analysis of this claim as shown on page 8 of this brief, we find that elements 1, 3, 3a and 4 are elementary or simple elements. The Court will take judicial knowledge of the fact that each of these elements is old in the prior art and were contained in the most ancient and simple form of pulley functioning in the same manner.

There is no new mode of operation disclosed in this combination. The sides hold the bearing pin and hold the sheave in place. The bearing pin holds the sides

together and serves as an axis upon which the sheave turns, and the sheave is journaled for rotation upon this pin between the sides in the same manner that sheaves have always operated. The pulley-block as a unitary article performs but one function,—that of guiding or directing a line or cable, in exactly the same manner as the simplest form of pulley-block which was ever constructed.

The only points of distinction between this pulley-block and the most ancient and crude form of pulley-block which was ever manufactured, is that means have been provided for retaining a quantity of oil which will feed automatically upon the bearing pin. As has been previously shown, this was old in the prior art. The law of lubrication has in no way been changed from what is shown by the simplest form of an elbow oil reservoir from which oil would feed through an axial opening of the pin and thence through a radial opening to the bearing surface of the pin and sheave in the same manner as in defendant's Exhibits C and D and like pulley-blocks which are shown to have been in general use in the Pacific Northwest since 1903.

It therefore becomes certain that Claim 1 cannot describe a new and useful pulley-block, and can at best describe nothing more than an improvement in a pulley-block, by which improvement there has been no change in the mode or law of operation, but has merely been an improvement in one of the parts; but, as has been previously stated, there has been no claim for an improvement in one of its parts, and no such improvement has been particularly set forth.

For the purpose of argument only, let us take for granted that Claim 1 was intended as a claim for an

improvement in a pulley-block, instead of a claim for a new pulley-block, and by again examining the analysis of Claim 1, we find the only change of elements from that of the most ancient form of pulley-blocks to be in elements 2, 2a, 3b and 3c. Element 2 covers an interior oil chamber in one of the sides, but it does not cover this element broadly, in that it covers it only with the useless limitation or qualification of an inlet to said chamber adjacent the top of the block. This limitation may have been included by the patentee by reason of his familiarity with the elbow reservoir which was not much higher than its diameter, so that the opening to this reservoir, while being at the top of the reservoir, would not be adjacent the top of the block. However, the qualifications or limitations upon element 3, that of 3b—"having an axial opening communicating with the chamber"—and 3c—"and extending through the side wall of the pin"—are found duplicated exactly in the same relation to the other elements in defendant's Exhibit C and D as they are found in this claim. This leaves only element 2—"an interior oil chamber in one of the sides"—to be found in the prior art. This element is found more strictly within the definition of an interior oil chamber in the Labadie, Butters and Ludford patents, defendant's Exhibits QQ, 4C and 3D, than in appellant's own device.

Counsel for appellant answer these references by saying that all of the elements are not found combined in one single device. Appellee's answer to this objection is that it is not necessary to find all of the

elements in a single device of the prior art, unless the claim covers a new and distinctive machine embodying a new law or mode of operation; and even then it is not necessary to find all of the elements in a single device, for it required nothing more than mechanical skill on the part of one skilled in the particular art, to arrange the particular combination, having before him all of the devices of the prior art from which to make his selections. (See pages 53 to 59 of this brief.)

In addition to this claim, appellee contends that the Morgan and Nixon patent, defendant's Exhibits 3-O and BB, embodies all of the elements of Claim 1 in exactly the same combination, following exactly the same mode of operation, and performing exactly the same functions, so that the same may be said to read "letter perfect" upon Claim 1 of appellant's patent No. 977,613.

For the convenience of the Court, analysis of Claim 1 is again set forth, with the reference numerals of appellant's patent placed after each element, and immediately after these references to each of the elements is placed the reference to the like part in the Morgan patent.

Elements:	Gilchrist	Morgan
1. Sides	(1 & 2)	(A)
2. An interior oil chamber in one of the sides.....	(4)	(j ¹)
(a) an inlet to said cham- ber adjacent the top of the block	(5)	(j ²)
3. A bearing pin.....	(24)	(C)

- (a) terminally mounted in
the sides (18 & 19) (c¹ and c²)
- (b) and having an axial
opening communicating
with the chamber (2), (27) (shown but
not design-
ated by
letter.)
- (c) and extending through
the side wall of the pin. (28) (c³)
- 4. A sheave journaled for ro-
tation upon the pin be-
tween the sides..... (20) (E)

On the defendant's Exhibit BB each of the reference letters as used in the specification and drawings of the Morgan patent are placed upon the drawing in black ink, while on a line with each of these elements there is placed in red the figures which represent like parts of the Gilchrist device.

In each of these devices the oil is introduced into the chamber through an opening adjacent the top of the block and feeds from this chamber directly through an axial opening in the pin, and thence through a radial opening to the bearing surface of the pin by virtue of the law of gravity and the draw on the oil by the rotation of the sheave.

Counsel for appellant contend that as it is claimed the Morgan patent is the best reference the Court should not be called upon to consider any of the other references.

I am inclined to agree with counsel for complainant to this extent, namely: that a careful examination of the analysis given, together with defendant's Exhibit BB, and the proper application of the well established rules of law as set forth in this brief, should make it unnecessary for the Court to consider any of the other exhibits, as the law is well settled that the claim of the patent is the measure of the invention (see pages 23, 24, 27, 28, 108, 113, 114 and 115). It is only for the purpose of meeting the other objections made by counsel for appellant, which objections have no sound foundation in law, that it is deemed advisable to refer to some of the other exhibits introduced by defendant, by which it may be shown that even though the basis of counsels' theory is unsound, their objections are also fully met on their own unsound basis.

Counsel for appellant lay great emphasis upon the word "interior" and seem to feel that the oil chamber of the Morgan block is not an interior chamber, for the reason that the drawings indicate that the chamber is riveted to the side. There is nothing in the location of the chamber, either in the claims or the drawings of the Gilchrist patent, which makes it any more of an interior chamber than the chamber of the Morgan block, unless it is that the one is cast while the other is riveted, so that the one is interior in the sense that it is within one solid piece of metal while the other is within the enclosure formed by two pieces of metal being riveted together. That the oil chamber of the Gilchrist patent extends or protrudes beyond the normal

outer surface of the side is plainly shown by both Fig. 1 and Fig. 3 of the drawings, and as described by the express language of the specification. The chamber of the Morgan block does not extend any further beyond the normal side than the chamber of the Gilchrist block. It is right here that counsel for appellant would have the Court overlook the fact that the claim of the Gilchrist patent does not confine the oil chamber to a chamber being made in one integral casting formed within the side; a chamber of the same outlines and proportions riveted to the side would be within the claims of the Gilchrist patent as truly as would the chamber cast integrally with the side. Then again, there is nothing in the claims of the Morgan patent which confine the reservoir to one which is riveted to the side, and a side and reservoir formed of one integral piece would also read within the claims of the Morgan patent, as well as a block side with the chamber riveted thereon.

But even if the Court should follow the trail which counsel for appellant would so graciously blaze, it would still find obstructions which counsel are unable to remove, for if counsel were to ask the Court to disregard the Ludford, Labadie, Gilley and Butters patents, defendant's Exhibits 3-D, ZZ, QQ, 4-C, EE and CC, as disclosing block sides with interior oil chambers, it would be like asking the Court to partake of the fruit which it would find on the thistles growing beside the trail which counsel have thus blazed.

Having thus found that the mode of operation is the same in the Gilchrist pulley-block as in the Morgan

pulley block, can it be logically contended that a man skilled in the art of making pulley-blocks, and having before him all of these exhibits and having pointed out to him the weaknesses of each of these blocks, could not have made the Gilchrist combination without the exercise of inventive faculty?

Unfortunately, the appellant did not go upon the stand, and no opportunity was afforded to cross-examine him for the purpose of determining as to whether or not he had before him all of the devices of the prior art. We may, therefore, be charitable enough to say that the complainant may have thought that he was a true inventor and may have exercised the inventive quality. But this would not give validity to his patents. (See pages 107 and 108 of this brief.) Taking for granted that the patentee may have been unfortunate in some of the language which has been selected, the Court cannot be lenient with the complainant for this reason, as under the patent law he is conclusively presumed to have dedicated to the public all which is not claimed, (see pages 108 to 116 of this brief) and is conclusively presumed to have had before him all of the devices of the prior art (see pages 107 and 108 of this brief). The Court cannot reconstruct the claims for the patentee (see pages 23, 24, 27, 28, 108, 113, 114 and 115 of this brief).

Let us suppose that a logger came into a pulley-block factory with a pulley-block made according to the Morgan specification, a pulley-block made according to the Ludford specification, a pulley-block made ac-

cording to the Labadie specification, a pulley-block according to the Butters specification, and a pulley-block of the design disclosed by defendant's Exhibit I, and stated that he wished to have a new pulley-block designed embodying the best features of these four pulley-blocks; that he liked the general appearance and mode of operation of the Morgan block, but that the oil sometimes seeped through the sutures of the chamber, by reason of some of the rivets having been loosened; and that he liked the threaded and shouldered pin of the Labadie block and as used in defendant's Exhibit I; that no oil had ever leaked from the chamber of the Ludford, Butters or Labadie pulley-blocks; and that he would like to have a pulley-block retaining the mode of operation as disclosed in the Morgan block but embodying a side cast in one integral piece and containing the oil chamber within the same similar to that shown in the Ludford or Butters blocks, and provided with a pin such as is shown in the Labadie blocks, defendant's Exhibit CC, and in the block shown in defendant's Exhibit I. We will also suppose that all of these pulley-blocks had been made in this one factory. Under these circumstances, can it be logically contended that it would have required more than mechanical skill to have made a pulley-block embodying the general mode of lubrication as disclosed in the Morgan block, but changing the oil reservoir to one provided within a cast side and using a pin such as is used in the Labadie or Butters block and in the block shown in defendant's Exhibit I?

It is defendant's contention, first, that the side

with an interior oil chamber cast in one integral piece is not covered by the patent claim, and therefore cannot be considered by the Court under the rule hereinbefore stated,—“that the claim measures the invention”; (see pages 23, 24 and 28 of this brief); second, a side with an interior reservoir cast in one integral piece could not be the subject of invention, as it was old in the prior art and it does not involve invention to select and bring together in one combination old elements without changing the mode of operation; (see pages 40 to 52, and 60 to 62 of this brief); third, that even though the prior art did not disclose a side containing an oil reservoir cast in one integral piece, it could not be the subject of invention to cast this side in one piece; (see pages 62 to 71 of this brief).

Claim 1 may therefore be said to be invalid for the following distinct and independent reasons:

1. That said claim is invalid because its subject matter in view of the prior state of the art did not require the exercise of invention to produce it.

2. That it is not invention to bring together old devices into a machine without producing any new mode of operation. (See pages 40 to 52 of this brief.)

3. That the assemblage of elements enumerated in said claim is not patentable because it is an aggregation and not a true combination. (See pages 40 to 71 of this brief.)

4. That the assemblage of elements enumerated in said claim is wholly lacking in patentable novelty,

being anticipated both collectively and severally in the prior art.

5. That the assemblage of elements enumerated in said claim, even if it were a true combination, would not constitute a new machine in the eye of the patent law, but only an improvement of an old machine, and that as an attempt to define an alleged improvement of old machine the claim is void because it fails to identify any improvement as required by Sec. 4888, R. S. (See pages 71 to 85 and 113 to 116 of this brief.)

It is felt that the evidence as to the state of the prior art and the authorities heretofore referred to are such that the Court should not have the shadow of a doubt as to the invalidity of Claim 1.

Counsel for appellant have urged that there is that shadow of doubt, and it is on a shadow of a doubt that they hope to have the patent sustained, by asking the Court to declare it to be valid because the Patent Office has issued the patent, and because a block which has been manufactured by the patentee embodying some of the elements of the claims of the patent has become a commercial success. Counsel for appellant realize that their case is a weak one, and they are making a diligent effort to create a shadow of a doubt. That counsel themselves did not have a shadow of a doubt as to the invalidity of Claim 1 is indicated by the fact that upon commencing this suit Claim 1 was not included.

The evidence shows that appellant was furnished with a reference to the Morgan patent in 1915 and ap-

pellant's counsel evidently were convinced in their own minds that the Morgan patent was a complete anticipation of Claim 1.

Claims 4 and 5 are mere detailed limitations upon Claim 1. Claim 1 is the only claim concerning which it could be logically contended that defendant's pulley-blocks infringe, and counsel certainly would not have neglected to include Claim 1 as a basis for the suit in the first instance had they felt that there was any possibility of sustaining the claim.

It is logical to believe that, after preparation of this case for trial and becoming familiar with the fact that all the detailed limitations of Claims 4 and 5 were not embodied in the defendant's pulley-blocks, and that they were also anticipated by the prior art, counsel then came to the conclusion that there was nothing left upon which to base the validity of the patent, other than the commercial success of the article combined with the *prima facie* presumption of invention arising from the issuance of the patent itself; and that, having arrived at this conclusion, they decided to amend their complaint and include therein Claim 1 of patent No. 977,613; for, if they could convince the Court that the claims themselves should not measure the invention, and could keep uppermost in the mind of the Court their theory concerning the commercial success of oil reservoir blocks, it might be possible to have the Court declare the patent to be valid. Upon this theory Claim 1 could be included just as well as Claims 4 and 5.

I am in no way criticising counsel for their action in this respect; it was the logical thing to do; but it is worthy of consideration in that it indicates that complainant's counsel fully realize that all of the elements and functions of the Gilchrist patent were anticipated by the prior art and that they have given up hope of sustaining the patents unless the Court should measure the invention by something other than the claims themselves.

Counsel even introduced the file wrapper of patent No. 977,613 to show that this patent was granted by the Patent Office exactly as applied for without the citation of a single reference against it. Can it be that counsel expect the Court to believe that the Patent Office had considered the Morgan block, which reads letter perfect upon Claim 1 of this patent, and then allowed Claim 1 as drawn, without so much as a single reference to the Morgan patent? I cannot understand how such a presumption can be indulged in. The law is very well settled that when the file wrapper discloses that similar patents or devices of the prior art have not been cited, it must be considered that these prior devices and patents have been overlooked by the examiner, and within the language of the cases considered on pages 31 and 32 of this brief, this fact alone should be sufficient to destroy completely any *prima facie* presumption which might otherwise be indulged in by the Court as to the validity of the patents.

The commercial success of an article has never been considered a safe guide for the Court, (see pages 36 to 40 of this brief), but that phase of the case applies

equally as to all of the claims and will be taken up more fully after detailed discussion of each of the other claims.

Turning now to the analysis of Claim 4 on page 9 of this brief, it will be found that elements 1, 2, 2a, 3, 3b, 3c and 4 are all included in and covered by the analysis of Claim 1. Claim 4 is a mere restriction upon Claim 1, by reason of the limitations 1a, 5, 6 and 7, and the claim is therefore invalid for the reasons set forth below and numbered 1, 2, 3 and 5.

While Claim 1 does not state that the sides are parallel, the sides to all pulley-blocks, as shown by the prior art, are parallel.

Claim 4, therefore, embodies the following qualifications or limitations upon Claim 1, namely:

1a, which requires the parallel sides to have annular recesses in their adjacent faces,

3a, which requires the pins to be terminally threaded to engage the sides of the recessed portions thereof,

5, which requires the sheave to have oppositely disposed bosses adapted to fit closely but anti-frictionally in the recesses,

6, the pin having shoulders to engage the sides to prevent the same from binding upon the sheave, and

7, top removably connecting the sides above the sheave.

A block constructed with all the elements as set forth in Claim 4 would be used in exactly the same manner and would function exactly the same as a pulley-

block constructed as provided in Claim 1. The equivalents of all of these additional elements mentioned in Claim 4 would necessarily have to be used in Claim 1 in order to make a complete pulley-block, excepting that the block sides would not necessarily have to have annular recesses in their adjacent faces nor would they necessarily require oppositely disposed bosses unless there were annular recesses in the adjacent faces of the sides.

The effect of complainant's testimony concerning Claim 4 is merely to bolster up complainant's contention that a pulley-block having annular recesses in its sides and a sheave with oppositely disposed bosses adapted to fit closely therein is a better pulley-block as a longer bearing surface is thereby obtained, and a dust guard is provided to keep out dirt and dust, and that a removably connected top is more convenient; but none of the evidence tends to show that either of these elements operate any differently than they do in other pulley-blocks of the prior art, nor that there is any co-ordination or coaction induced between the elements so added by the presence of the remaining elements on the one hand nor between the remaining elements and the added elements on the other hand.

A few references will now be made to the prior art for the purpose of showing that each of these added elements or limitations was also old.

The block made by the Columbia Steel Works in 1907 and illustrated in defendant's Exhibit I contains the following elements of this claim: It has parallel sides with annular recesses in their adjacent faces and

as shown by the testimony (R. 59-63) the pin was terminally threaded to engage the sides in the recessed portions thereof; and the sheave was provided with oppositely disposed bosses adapted to fit closely but anti-frictionally in the recesses. In fact, it is advertised as the Dirt Proof Blocks. The pin has shoulders to engage the sides to prevent them from binding upon the sheave, and the top is removably connected with the sides above the sheave. The pulley-block, therefore, contains all of the additional elements or limitations mentioned in Claim 4 in the same combination, functioning in the same manner and producing the same result.

The only element which can possibly be considered as missing to prevent this block from being a complete embodiment of all of the elements in both Claims 1 and 4 is that there is no reservoir in the side of the block so that the capacity for holding oil is not so great in this block as it is in the Gilchrist block; but, as shown (R. 59-63) by the testimony, the pin has an axial opening and a cross-drill or hole from the axial opening to the bearing surface. A plug is placed in the end of the pin so that the pin itself acts as the oil reservoir and the oil feeds through the hole in the pin to the bearing surface in exactly the same way as in the Gilchrist block.

The block of the Vulcan Iron Works illustrated in defendant's Exhibit L, and explained (R. 59-63) by the testimony likewise embodies the same elements in the same combination.

Attention is also directed to defendant's Exhibits N and GG, explained (R. 59-63) in the testimony, also to the Labadie patent No. 513,067, defendant's Exhibit QQ; the Tousley patent No. 520,973, defendant's Exhibit RR; the Bouse patent No. 644,729, defendant's Exhibit TT; Gilchrist patent No. 765,475, defendant's Exhibit WW; King patent No. 786,790, defendant's Exhibit 3A; Opsal patent No. 806,562, defendant's Exhibit 3B; Lindsay patent No. 847,955, defendant's Exhibit 3F; Hammond patent No. 876,176, defendant's Exhibit 3H; Martin patent No. 942,274, defendant's Exhibit 3K, as well as the pins and block sides introduced as defendant's Exhibits 3U, 3V and 4D. None of the claims of complainant's patent include the element of a long hub or bearing, and this element cannot be read into the claim, (see page 24 and top of page 25 of this brief), but even if considered as included, the same would have been anticipated by the prior art.

Element 1 is modified in Claim 4 by 1a, requiring the parallel sides to have annular recesses in their adjacent faces, but the limitation 1a is further limited and restricted by element 5 of the claim, which provides for "oppositely disposed bosses upon the sheave, adapted to fit closely, but anti-frictionally in the recesses." This construction is not found in any of the defendant's pulley-blocks and under the rule of law applicable to such cases, namely, that each element of the combination must be considered as material thereto and cannot thereafter be abandoned by the patentee. (See pages 28 and 29 of this brief.) The

defendant does not infringe this claim. (See Walker on Patents, 5th Ed., Sec. 349, pages 433 and 434.)

Lines 33 to 35 of the specification of patent No. 977,613 read as follows:

“Another object of the invention is to provide a pulley, the bearing pin of which is adequately protected against dirt and dust.”

Again, the last paragraph of the specification reads “the parts 21”—denominated bosses, line 13, page 2,—“of the sheave 20 fit closely in recesses 17 of the sides of the block, and the bearing pin is so housed and protected that dirt will be prevented from accumulating about the bearing of the sheave, to interfere with the rotation thereof.”

It is evident, therefore, that the complimentary elements 1a and 5 of Claim 4 were intended to constitute a dust guard. The functional language of element 5, “adapted to fit closely, but anti-frictionally,” is a limitation which confines this element strictly to a dust guard and cannot now be repudiated by the patentee. (See page 28 of this brief.)

Although defendant does not employ the elements 1a and 5 of Claim 4 and cannot, therefore, infringe, since it is well established that the omission of one element, whether essential or not, of a combination patent covered by a claim, averts any charge of infringement based on that claim. (See pages 24 to 27 of this brief.) Nevertheless, we need only to turn to the prior art to find that there is no novelty or invention in the combination embodying this element.

The Court will find that each of the elements performs no function in the Gilchrist device which it does not perform in the other devices of the prior art.

Counsel for complainant lay great stress upon the point that in the pulley-blocks just referred to the interior oil reservoir in one integral cast side is not found in one device in combination with all of the elements set forth in Claim 4; but there is no co-action between the oil reservoir and the added elements found in Claim 4 which are not found in Claim 1, so that if Claim 1 were invalid Claim 4 must likewise be invalid, as being a mere aggregation of old elements lacking patentable novelty and invention. (See pages 40 to 61 of this brief.)

The annular recesses and oppositely disposed bosses of Claim 4 either with or without the oil chamber in the side perform but one function, that of a dust guard.

The auto-lubricating side performs exactly the same function whether used with or without a dust guard. The reservoir serves only to retain the oil and the side only as a supporting means for the pulley-block. The dust guard performs no other function than that of keeping the dirt out of the bearing of the sheave. It performs this function in exactly the same way whether the pulley-block is provided with an oil reservoir or is provided with no means whatever for automatic lubrication.

The added limitations in Claim 4 which are not found in Claim 1, may be disposed of as follows:

1: Elements 1a and 5 are not found in the same

relationship in any of the defendant's devices. This defeats the contention that this claim has been infringed. The patentee has restricted the use of these elements to that of a dust guard. The oppositely disposed bosses of the sheave as used in the Mallory block do not fit closely in the annular recesses of the sides, in that the outer surface of these cylindrical bosses are approximately parallel with the bearing pin and perpendicular to the plane of the sheave, whereas the annular recesses in the sides diverge outwardly so that the recesses and the bosses in no way tend to provide a dust guard.

2: The element 3a, which requires the pin to be terminally threaded to engage the sides in the recessed portions thereof or the equivalent of this element, is implied in Claim 1 as no other means are disclosed for holding the bearing pin in place. This exact style of pin is also shown in most all of the pulley-blocks just referred to as being part of the prior art.

3: Element 6, which limits the pin to one having shoulders to engage the sides to prevent the same from binding upon the sheave, is also included by implication in Claim 1 as no other means are afforded for spacing or keeping the sides in place. This style of pin is also found in most of the pulley-blocks just referred to.

4: While Claim 1 does not specifically require the top to be removably connected with the sides, this is the only kind of a top which is shown, and the prior

art discloses that tops removably connected with the sides have been in general use for many years. Most of the pulley-blocks illustrated in defendant's catalog of 1907, defendant's Exhibit B, have removably connected tops.

The claim is a mere aggregation of old elements, all of which are found in the prior art,, both separately and in combinations, performing exactly the same functions which they are called upon to perform by this claim. No new rule of action is produced by their assemblage in one machine, and the claim must therefore be declared invalid.

Within the rule of the case of Thatcher Heating Co. v. Burtis, 121 U. S. 293, (page 93 of this brief), and numerous other cases considered at pages 77 to 81, and 92 to 103 of this brief, even if the Gilchrist pulley-block should be admitted to be a commercial success and a better pulley-block than any which preceded it, this could not elevate it to the dignity of invention.

Turning now to the analysis of Claim 5 as shown on pages 11 to 13 of this brief, it will be found that this claim reverts to the form of Claim 1, defining more closely the old construction of the Morgan patent, defendant's Exhibit 3-O, but not being so broad a claim as that of the Morgan patent, in that it is restricted or narrowed by the limitations 4, 7, 8 and 9.

It is fatal to complainant's claim of infringement of Claim 5 that said claim includes the specific limitations of elements 7 and 8. Those limitations are "projections" on the block sides and a top "having spaced

lugs between which the projections are adapted to fit." While those limitations may be wholly unnecessary, the patentee cannot repudiate them (see page 28 of this brief), and by reason thereof the defendant does not infringe. (Walker on Patents, 5th Ed., Sec. 349.)

None of the defendant's pulley-blocks has a top with spaced lugs between which the projections of the sides are adapted to fit.

Elements 1, 2, 2a, 3, 5, 5a, 5b, 5c, 6, 8 and 9 are all contained within the elements of Claim 4.

Element 3a is a limitation by words only upon the same element in Claim 4 by stating that the opening communicates with a chamber adjacent the bottom thereof. However, the communication between the axial opening of the pin and the chamber would necessarily need to be near the bottom of the chamber in either claim in order to make the chamber of any value, as otherwise the oil could not flow from the chamber into the pin.

Element numbered 4 is also included within the elements of Claim 4, although the wording is different. Claim 4 states that the bearing pin is terminally threaded to engage the sides in the recessed portions thereof so each of the sides would necessarily have a threaded opening for engagement with this pin and the language of element 4, therefore, becomes meaningless as far as distinguishing this claim from Claim 4.

Elements 7 and 8a are mere limitations upon the method of attaching the removable top, which method of attachment of the top and the providing of the

lugs discloses nothing new or novel in the construction of pulley-blocks.

The references given to show the state of the prior art as pertaining to Claim 4 are equally applicable to Claim 5.

Practically every pulley-block displayed in the Mallory catalog of 1907, being defendant's Exhibit B, describes and illustrates a pulley-block with a removably connected top connecting with the sides, which sides are provided with lateral projections at their upper ends and the top is connected to the sides of the pulley-block by means of a pin passing through a hole in a lug upon the top and through the holes in the projections upon the sides.

If there is anything in this claim concerning the lateral projections at the upper ends of the sides and the top having spaced lugs between which the projections of the sides are adapted to fit, which is not disclosed in practically all of the blocks of the prior art and all the illustrations shown in the 1907 Mallory catalog, it is that the Gilchrist claim calls for the two lugs upon the top and one lug upon each side, whereas most of the blocks of the prior art and most of the illustrations in the catalog show that there are two lateral projecting lugs at the top of each side and only one lug on the top or shackle adapted to fit between the spaced lugs upon the sides.

Removably connected and hinged tops are conclusively shown to have been old in the prior art, and I challenge counsel to find a single one of them which

does not perform all of the functions as outlined in appellant's patent.

As to the bearing pin with shoulders, oil duct and threaded ends, it was conclusively shown that this style of pin has been used generally in the construction of logging blocks since the year 1903. The same style of pin is used in defendant's Exhibits C and D, in defendant's Exhibit CC and in defendant's Exhibit 3-H. Again I challenge counsel to show a single one of these devices of the prior art in which the pin does not co-operate with the top to hold the cheeks in alignment, co-operate with the sheave to provide long bearing surface for the long hub of the sheave, co-operate by its shoulders to prevent ends of sheave hub from coming into frictional contact with sides of blocks, co-operate with the side in which it is terminally mounted to hold sheave in operative position. As to Exhibits C, D, and all of the other devices of the prior art embodying an oil chamber, the pin also co-operates with the oil chamber by oil duct to feed oil to the bearing surface of the pin and sheave.

It has also been conclusively shown that sheaves with oppositely disposed bosses are old in the prior art. They are shown in the Labadie patent No. 513,-067, defendant's Exhibits QQ and CC, defendant's Exhibits GG, I, L and M, by the block side, defendant's Exhibit 3-R, by the pin, defendant's Exhibit 3-V, by the pulley-blocks illustrated in Mallory's 1907 catalog, defendant's Exhibit B, on pages 5, 6, 8 and 10.

By turning to the record of the Taylor testimony, it will be found that as far back as 1907 Mr. Taylor

manufactured the pulley - block illustrated by Figs. 85 on page 6 of the 1907 Mallory catalog, defendant's Exhibit B, and that the block side 3-R just referred to is one of the old block sides of this very pulley - block. The testimony of Mr. Taylor with reference to this pulley - block shows that the pins were terminally mounted or screwed into the sides of the block, that the sides had annular recesses, that the sheave had oppositely disposed bosses adapted to fit in the recesses, that the pin had an axial hole communicating with the bearing surface by a radial hole, that it was provided with a removably connected top which could be readily opened for the introduction or removal of the cable. Mr. Taylor also testifies to the making of the shackle or top, defendant's Exhibit 3-T, as far back as 1907. While this style of top is not used by defendant, it serves to show that there was nothing novel in the Gilchrist claim concerning a top with spaced lugs.

Pages 8, 9 and 10 of defendant's Exhibit B illustrate pulley-blocks which have the combination of oil reservoirs, cups or elbows, sides provided with annular recesses, and sheaves with oppositely disposed bosses, and by turning to the testimony of Mr. Mallory (R. 56 to 64) it is found that these pulley-blocks having oil reservoir elbows, sides with annular recesses, shoulder pins screwing into the sides, the pins being provided with an axial and radial hole by which there was a communication between the oil chamber and the bearing surface of the pin, were made as far back as 1902.

The oppositely disposed bosses fit no more closely

in the annular recesses of the sides in the pulley-blocks made by defendant, which complainant now contends infringe his patent, than did the bosses of the sheaves in the blocks which have just been considered. Complainant must, therefore, be bound by the rule of law laid down in the case of *Knapp v. Morss*, 150 U. S. 288, namely: "That which infringes if later would anticipate if earlier."

It should be noted that there is nothing in the language of the claims which in any way describes a long hub. A hub might be either long or short and still have oppositely disposed bosses adapted to fit in annular recesses of the sides. There is nothing in the language of the claims which confines the bosses of the sheave to what might be termed "knob bosses." The bosses might be constructed similar to those illustrated in defendant's Exhibit I and on pages 5 and 6 of defendant's Exhibition B, by having an annular recess in the side alone or in both the sheave and the side. In these particular illustrations, the bosses do extend out beyond the plane of the outer surface of the sheave, but they would still have remained bosses had they been shortened so as to be in line with the plane of the outer surface of the sheave periphery.

Again, I challenge counsel to find a single element or the function of a single element which was not old in the prior art.

We next come to the subdivision pertaining to the parallel sides, one of which is provided with an interior oil chamber. Counsel are very careful to consider the side and the oil chamber as one element.

But I challenge counsel to show wherein the interior oil chamber co-operates with any element to hold the sheave in operative position; or with the top to support the pulley; or with the removably hinged top to make it easier to place or remove the cable; or with the pin and removably connected top jointly to hold the sides parallel; or with the annular recesses of the sides to keep out the dirt from the pin. The only element with which the oil chamber co-operates is the oil duct by which the oil is fed from the reservoir to the pin, and the oil chamber performs exactly this same function whether in the side or without the side. It is clear that the question of supporting the pulley-block or the strengthening of it was not the task which the patentee sought to solve, as he provided but one side of his pulley-block with an interior oil chamber. To contend that the task which complainant sought to solve was that of making a stronger pulley-block would be as absurd as to say that a man might place one large link in a small chain and obtain a patent upon it for having strengthened the chain. The chain would be no stronger than its weakest link, and the pulley-block would be no stronger than its weakest side.

However, if counsel for appellant insist that there is merit in the contention that the oil reservoir within the side adds strength to the side, and that it should be considered in that connection, we have but to refer them to the Butters pulley-block, defendant's Exhibit 4C, the Labadie pulley-block, defendant's Exhibit CC, and to the Ludford pulley-block, defendant's Exhibit EE; but as has been heretofore indicated, the complain-

ant ascribed to the oil chamber a particular function, namely: "To provide a pulley which will contain a considerable quantity of lubricant and feed the same, automatically and slowly, upon the bearing pin of the pulley." As shown on page 28 of this brief by the case of *Masseth v. Larkin*, 111 Fed. 409, this ascription is a limitation of that claim and the patentee cannot now claim that this element is an improvement in any other respect.

Counsel for appellant seem to advance the theory that before the patent can be defeated it will be necessary to show all of the elements of the claim in a single device of the prior art. If appellant's theory in this respect were true, there would be no limit to the patents which could be issued to those who have contributed nothing new and useful to the art, and there would be no limit to the unjust monopolies which could thereby be obtained. All that would be necessary in order to obtain a patent would be to select and combine in one article well known elements of other articles of the prior art and with no change of function as a result of the combination obtain a patent thereon, which would thereafter prevent the use of these elements in any future combination, and thus result in depriving real inventors from the just fruits of their inventions.

By way of illustration—although pneumatic tires had long been used on bicycles and other vehicles, by the application of the theory advanced by complainant's counsel, the law would permit the maker of the first automobile to obtain a patent upon an automobile provided with pneumatic tires. There would need to be

nothing novel in the construction of the automobile, and the automobile might have no commercial value, but those who had thereafter perfected the automobile would thereby be subjected to heavy royalties for the use of pneumatic tires upon their automobiles. The public would thereby be unjustly taxed for the benefit of one who had contributed nothing new or useful to the art.

There is not a single element in any of the claims of patent No. 977,613 which cannot be found in the prior art performing exactly the same function. By again turning to the analysis of Claim 1 (page 8 of this brief) and examining each of the elements, it will be found that element 1 covers the sides of the pulley-block. It is plain that the sides in all pulley-blocks perform the same function, namely: that of supporting the sheave and affording means by connection with a top or shackle by which the block itself may be supported. This is the same function which sides of pulley-blocks have always performed.

The next element is that of an interior oil chamber in one of the sides, qualified by having an inlet adjacent the top of the block. As heretofore stated, the only function which this element performs is that of holding a supply of oil for lubricating the block. It in no way affects or changes the mode of operation, strength or efficiency of any of the other parts. All of the other elements are attached in a like manner and perform their functions in the same manner that they would perform them if this oil reservoir were lacking. There is nothing added to the functioning of the pulley-block, save and excepting that it provides a means for holding a

quantity of oil which may feed to the bearing of the sheave by gravity and the draw on the oil by the rotation of the sheave, in exactly the same way as in the Morgan block and as in defendant's Exhibits C and D.

Element 3, the bearing pin, is found in a greater portion of the blocks of the prior art in exactly the same formation and functioning exactly the same. The pin has no more than three functions in the Gilchrist blocks, and these three functions are found in defendant's Exhibits C and D and in other pulley-blocks of the prior art. These functions are, first, to provide a bearing surface upon which the sheave may rotate; second, to hold the sides of the pulley-block in their proper positions; and, third, to provide a means through which the oil for lubrication may be passed to the bearing surface. All three of these functions are found in the Morgan block and in defendant's Exhibits GG, CC, F, G, H, J, K, I, L, M, N, O, P, Q, R, TT, HH, 3-A, 3-B, 3-F, 3-K and 3-H.

The pins of all of these blocks are terminally mounted in the sides and the axial opening in each of the pins extends through the side wall of the pin so that the functioning of all of the parts pertaining to the lubrication of the pulley-block is substantially the same. Many of them, such as those used in connection with defendant's Exhibits C and D also communicate with the oil chamber or reservoir. A sheave journaled for rotation upon the pin between the sides is as old as the simple machine known as the pulley-block.

A like examination of each of the elements in the other claims makes it clear that there is nothing in any

of these claims resulting from the combination of elements which brings about any coaction or coordination between the elements which is not shown by the prior art. Nor is there any new result produced, for, as heretofore set forth, there is but one result which can be credited to any pulley-block, namely: that of supporting, guiding or directing a rope or line. A pulley-block consisting merely of sides, attached together either with or without a top, and having a sheave held in place by a bolt passing through the sides, will produce the same result. Any difference between this simplest of pulley-blocks and the most highly improved of pulley-blocks is not a difference of function, but rather a difference in durability or excellence of the article itself. When this excellence, durability or superiority of the article is brought about by combining elements which coordinate and coact differently from what may be found in the prior art, it may be the subject of an invention for an improvement; but the mere bringing together of old elements into one combination wherein there is no change in the functioning of the elements, and wherein there is no new result by reason of the coaction of the elements thus brought together, by which the result is no more than the mere sum of the separate functions, is but a mere aggregation and does not constitute invention.

The evidence discloses that all of the cast side pulley-blocks have been a commercial success, by reason of the fact that attractive designs could readily be made by using cast sides. Cast sides were in general use long before Gilchrist applied for his patent, and the

evidence shows that the defendant, who is the biggest dealer in logging blocks in the Pacific Northwest, carries 115 designs of pulley-blocks embodying an interior oil reservoir in the pin, or straight or elbow oil cups, whereas there are only 32 designs of pulley-blocks which have an oil reservoir in the side. (See R. 518 and 519 of the testimony.) The testimony further shows that the defendant has confined his oil reservoir side to the high lead and skyline blocks and still retains the oil elbow and oil cup for his smaller designs of pulley-blocks. There was no real demand for a pulley-block with an oil reservoir in the side until the skyline system of logging was adopted. It was the defendant who pioneered this system of logging in the Pacific Northwest. It was the defendant who first made large pulley-blocks for this purpose. The large, powerful donkey engine, the improved systems of logging, and the various other devices which have been taken up in the last few years have all entered into the question of making a commercial success of the oil reservoir pulley-block.

It is the attractiveness of these blocks, by reason of the artistic designs which have been worked out in the castings, together with their general utility, which has made the pulley-blocks with the auto-lubricating sides a commercial success. Defendant and some of the other manufacturers have apparently produced more attractive pulley-blocks than the complainant, by which reason they have created a greater demand for their own pulley-blocks than complainant has created for his. The complainant apparently makes all of his pulley-blocks

with the auto-lubricating side, whereas the defendant makes all of his smaller pulley-blocks with oil cups. Defendant testified that he keeps in touch with the demands of the logger and that he carries a well-balanced stock of the designs illustrated in his catalog, and as has heretofore been indicated, the greater percentage of defendant's pulley-blocks are still made without lubricating sides. This certainly does not indicate that the auto-lubricating side has driven the other pulley-blocks from the market, but it does indicate that it is something more than the mere auto-lubricating side which has made a commercial success of all of these pulley-blocks.

The finding of lack of novelty or invention, or want of infringement on the part of the defendant, would make it unnecessary for the Court to consider the question of estoppel.

However, the testimony shows that complainant was well aware of the fact that the defendant was going to considerable expense and was building up a trade for a skyline system of logging, in connection with which he had designed a large auto-lubricating block in which the oil reservoir was located in the side. The complainant made no complaint to the defendant with reference to this matter, but word came to the defendant indirectly that the complainant had stated that he considered defendant's blocks as an infringement of his patent, and that he intended to allow the defendant to continue the manufacture and sale of the same until such time as it would be worth while for the complain-

ant to bring an infringement suit against the defendant. (R. 54 and 65 to 70).

When this information reached the defendant, he immediately caused a search to be made in the patent office and obtained the legal opinions of attorneys in both Washington, D. C., and in Portland, Oregon, upon the question as to whether or not his line of blocks was infringing upon any patents, and especially upon any patents issued to the appellant herein. Upon receiving these opinions, he immediately communicated with the complainant, advising him of what he had heard, of the result of the search, and of the opinions which had been given to him by his attorneys, stating that he did not wish to infringe upon any one's rights and that he did not believe he was so infringing. Complainant was invited to take the matter up with defendant, and to examine the prior patents and the opinions of his attorneys. The complainant did not then state positively to the defendant that the defendant was infringing upon his line of blocks, but merely wrote to him that he had considered that the defendant's blocks were infringing upon his patents, that he would be pleased to examine the opinions and patents referred to; and the matter was finally left to rest until such time as the complainant could be in Portland to take the matter up with the defendant.

A little later on, a list of the prior patents was furnished to the complainant, which it was felt were complete anticipation of the Gilchrist patents. (R 54 and 65 to 70).

Shortly after this, complainant placed upon the open market pulley-blocks embodying all of the elements of the claims of patent No. 977,613, without marking thereon the patent date, in absolute disregard of the provisions of Sec. 4900, U. S. Revised Statutes. (R. 95 to 98).

Nothing further was heard from the complainant until just a short time prior to the commencement of this suit.

Certainly these facts were sufficient to justify the defendant in believing that if the complainant had ever thought his patent was valid he had come to the conclusion that the same was not valid and had made up his mind to abandon the same.

In view of the complainants actions in this respect, the general statements concerning his patents which were carried in advertisements published in "The Timberman" must be considered as mere "dealer's talk" for advertising purposes only, and cannot be considered as information directed to the defendant to charge him with knowledge that the complainant intended to hold the defendant as an infringer.

Estoppel by laches has been as fully established in this case as in the case of Vacuum Cleaner Co. v. Innovation Electric Co., considered beginning at page 116 of this brief.

By way of a summary of some of the points raised it may be stated:

1. It is contended that if the claims of the patent

constitute a mere aggregation of old elements, the claims are invalid for want of invention.

2. It is contended that where all of the elements of a combination claim are old, there must be some coaction of elements to save the claim from the charge of aggregation.

Counsel for appellant contend that coaction of elements is shown by showing that each element performs a useful purpose in the combination and by showing that a better article is produced which has become a commercial success; but it is the contention of appellee that the commercial success of an article alone can never elevate an operative device to the dignity of an invention. There must be some new coaction of elements, or some new mode of operation, by which a new and useful result or a new and distinctive machine is created, and even then there must be disclosed more than mere mechanical skill by one skilled in that particular art.

3. Appellee contends that coaction or "joint and co-operating action of old elements" to constitute a true combination within the meaning of the patent law requires more than the mere assembling in an operative device of elements selected from other devices. To be patentable there must be a new mode of operation, or a new effect of one or more elements upon one or more other elements of the combination. For example, a machine might be made up of nine elements no seven of which could be found in the same combination in any other device. The machine might be the best machine ever produced, yet if none

of the elements so combined could be found having some new operative effect upon some other element or elements different from what it could be found doing in some other device of the prior art, the machine would be the result of a mere aggregation of old elements and could not be the subject of an invention. No presumption of invention from the issuance of a patent nor from the commercial success of such a machine can ever raise such a device to the dignity of an invention. When the skilled mechanic looks at a machine and knows its law or mode of operation it does not require the exercise of the inventive faculty to replace poor parts with good parts, when he has on hand such good parts which have performed like functions in other machines. Neither does it involve the exercise of the inventive faculty to assemble a new machine by putting together the parts of other machines so that each of the parts performs its old function. (See Topical Index).

Counsel for appellant have cited a number of cases in their brief, but not one of these cases discloses the situation of a patent for a machine or operative device being held valid without the disclosure of a new mode of operation or the inclusion of an element or elements which cannot be found in the prior art. (See analysis of appellant's cases).

4. A new result within the meaning of the patent law calls for something more than a better machine. (See Topical Index).

5. Combined results are not patentable. (See Topical Index).

6. Introduction of one new element does not prove invention. (See Topical Index).

7. Casting side and oil chamber in one piece is, not invention. (See Topical Index). Counsel for appellant cite the case of *Krementz v. Cottle* to sustain their theory on this question, but the Court had under consideration in that case a collar button, an article of manufacture, not a machine. This case has been considered and distinguished in the case of *Computing Scale Co. of America v. Automatic Scale Co.*, 204 U. S. 609, 51 Law Ed. 650. See consideration of this very subject as to a one piece collar button in the later case of *Herzog v. Keller Co.*, 234 Fed. 86, pages 62 and 70 of this brief.

8. Selecting elements from other devices is not invention. (See Topical Index).

9. Patentee has not claimed a one piece cast side and cannot now claim that feature as an element of his invention as the claim measures the invention and cannot be enlarged by the specifications and all which has not been claimed has been dedicated to the public. (See Topical Index).

10. The patentee has, by his specifications, ascribed to his interior oil chamber the single function of containing a considerable quantity of lubricant and feeding the same automatically and slowly upon the bearing pin of the pulley. Neither the claims nor the specification state that the side and reservoir shall be in one piece nor that the same shall be a cast side and the claims cannot be reconstructed or broadened so as to cover a side and oil chamber cast in one integral

piece. (See *Masseth v. Larkin*, 111 Fed. 409, pages 23, 24, 27, 28, 108, 113, 114 and 115 of this brief).

11. The patents solve no problem and do not involve invention. (See Topical Index).

12. The scope of the inventions claimed cannot be broad enough to include defendants devices without reading upon devices of the prior art and defeating the claims under the rule, "that which would infringe if later, anticipates if earlier." (See Topical Index).

13. While the issuance of a patent and the commercial success of an article may sometimes be said to create "a prima facie presumption of invention and novelty," such a presumption is but "a mere rule of evidence," which "cannot be used to resolve the doubt as well as to create it"; "cannot usurp the province of the Court to declare what constitutes novelty" and has never been indulged in to give validity to a combination claim, having no new mode of operation, where all of its elements may be found either in combinations or separately in devices of the prior art performing the same function.

14. The file wrappers and contents, in view of the prior state of the art, destroy all presumptions of validity. (See Topical Index).

In one sense of the word there is a new result whenever there is a new assemblage of elements, but as disclosed by the authorities in this brief, this is not the new result which is required under the patent law to establish invention.

Having been taught the art of paraphrasing from complainant's brief in the trial court. I will now turn to the quotation from the case of *Thatcher Heating Co. v. Burtis*, 121 U. S. 293, and found on page 93 of this brief, and use that as my text:

"The new and improved result in the utility of a pulley-block cannot be said to be due to anything in the combination of elements which compose it, in any other sense than that it arises from bringing together old and well-known separate elements, which, when thus brought together, operate separately, each in its own old way.

"There is no specific quality of the result which cannot be definitely assigned to the independent action of a single element. There is therefore no patentable novelty in the aggregation of the several elements, considered in itself."

"The late Circuit Judge William K. Townsend, a most profound patent law jurist, has well stated at page 396 of *'Two Centuries Growth of American Law,'* that accordingly, 'it is now settled that the production of improvements reasonably certain to have been adopted in the development of a new branch of industry opened up by invention does not entitle the producer to a monopoly. The patent office, however, has generally issued a patent to any one who produced a device not before known, unless it was considered reasonably clear that such device did not involve invention. Therefore, in finding a remedy to the evils above stated, the courts have held invalid a large percentage of litigated patents. This doctrine of the

necessity of patentable invention as well as novelty has changed the whole phase of patent litigation. The question is no longer "is it new?" alone; but, "is it such as would have occurred to a skilled mechanic without the exercise of inventive genius?" The changes in the law on this subject make the history of patent law in the United States.' "

Boss Mfg. Co. v. Thomas, 182 Fed. 811-816.

The Gilchrist pulley-block may be a better pulley-block than the old pulley-block without an oil chamber, but defendant's auto-lubricating pulley-blocks and the auto-lubricating pulley-blocks made by various other manufacturers are also better than the old pulley-blocks without an oil chamber.

It would be unfair to the appellee, to other manufacturers and to the public to grant to appellant a monopoly in the manufacture of such a pulley-block.

In conclusion, I will take as my text for paraphrasing the language of the eminent patent jurist, Justice Bradley, as found in the case of *Atlantic Works v. Brady*, 107 U. S. 192:

"The process of development in pulley-blocks creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where

the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in its principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

Respectfully submitted,

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